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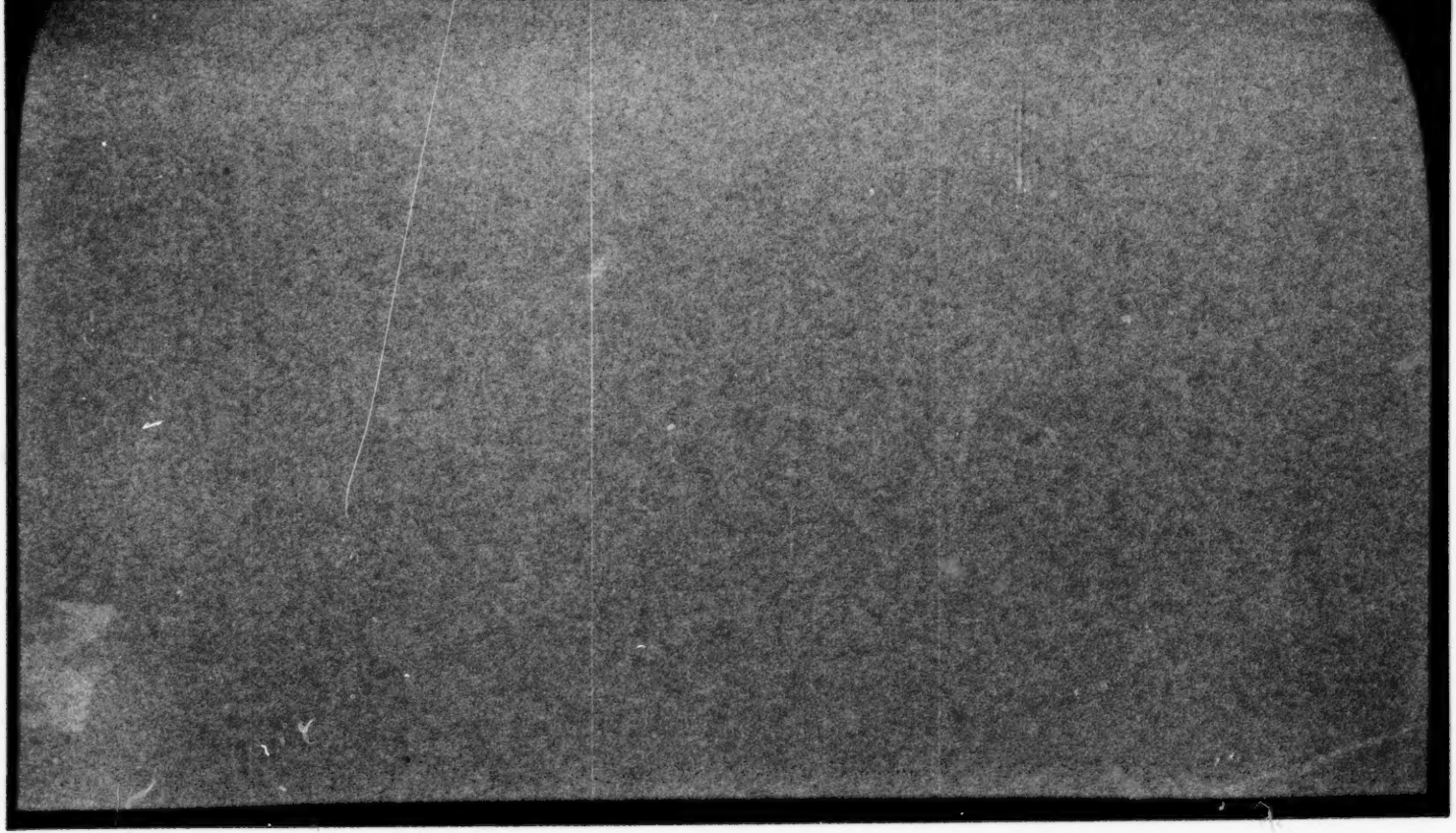

(32,536)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1927

No. 194

BARBER ASPHALT PAVING COMPANY, PETITIONER,

vs.

STANDARD ASPHALT & RUBBER COMPANY

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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[fol. 1]

IN UNITED STATES DISTRICT COURT, SOUTHERN DISTRICT OF ILLINOIS

In Equity

STANDARD ASPHALT & RUBBER COMPANY, a Corporation, Complainant,

vs.

BARBER ASPHALT PAVING COMPANY, a Corporation, Defendant

Bill for Infringement of Letters Patent Nos. 635,429 and 635,430.

BILL OF COMPLAINT—Filed January 30, 1915

To the Honorable the Judges of the United States District Court for the Southern District of Illinois, in chancery sitting:

Your orator, the Standard Asphalt & Rubber Company, a corporation, brings this, its Bill of Complaint, against the Barber Asphalt Paving Company, for infringement of United States Letters Patent Nos. 635,429 and 635,430, and says and avers as follows—

I

That your orator, the Standard Asphalt & Rubber Company, is a corporation organized and existing under and by virtue of the laws of the State of New Jersey, and having its principal office in the City of Chicago, State of Illinois, and its main works at Independence, Kansas; and that Barber Asphalt Paving Company, corporate defendant herein, is a corporation organized and existing under and by virtue of the laws of the State of West Virginia, and having a regular and established place of business in the City of Madison, State of Illinois, and has there an agent engaged in conducting said business.

II

That your orator is the owner of the entire right, title and interest in and to the said United States Letters Patent No. 635,429, on Process of Making Asphaltic Fluxes, dated October 24th, 1899, and United States Letters Patent No. 635,[fol. 2] 430, on Asphaltic Fluxes, dated October 24th, 1899, including any and all accrued rights of action on said patents, and that the said defendant, the Barber Asphalt Paving Company, in said Southern District of Illinois, to wit at its plant near Madison, Illinois, and elsewhere in the United States, unlawfully and illegally and without the consent of your orator, manufactured, used and sold products in infringement of said Letters Patent No. 635,429 and said Letters Patent No. 635,430, since the issuance of said Letters Patent and since the acquirement of title thereto by your orator, and within the six (6) years last past, and is now infringing and threatens to continue so to infringe each of said Letters Patent and to continually and unlawfully infringe the rights of your orator therein.

III

That heretofore and prior to the 21st day of February, 1898, George F. and George C. K. Culmer, then residents of Chicago, Illinois, were the original, first and joint inventors of certain new and useful improvements in process of making asphaltic flux and in asphaltic flux, not known or used by others in this country before their invention or discovery thereof, and which had not been patented or described in any printed publication in this or any foreign country before their invention or discovery thereof, or in public use or on sale in the United States for more than two years prior to their application for Letters Patent on said inventions.

That the said George F. and George C. K. Culmer, so being the inventors of said improvements in process of making asphaltic flux and in asphaltic flux, did make application in writing to the Commissioner of Patents in accordance with the then existing laws of the United States, and complied in all respects with said laws, and with the rules and regulations of the United States Patent Office, and thereafter, to wit on the 24th day of October, 1899, Letters Patent of the United States Nos. 635,429 and 635,430, were re-

spectively issued to George F. and George C. K. Culmer, as joint patentees, whereby there was granted to them, their heirs and assigns, for the term of seventeen (17) years from the date thereof, the full and exclusive right of making, using and vending to others to be used, the respective inventions described and claimed in said United States Letters Patent Nos. 635,429 and 635,430 respectively, as will appear from said original Letters Patent or duly certified copies thereof, in court to be produced. A copy of each of [fol. 3] said Letters Patent is hereto attached and marked "Exhibit A, No. 635,429" and "Exhibit B, No. 635,430."

IV

That subsequently to the issuance of said Letters Patent Nos. 635,429 and 635,430, your orator became and now is vested with entire right, title and interest in and to said Letters Patent Nos. 635,429 and 635,430, including any and all rights of action thereunder, for a good and valuable consideration by and through mesne assignments in writing, duly executed and delivered, and recorded in the Patent Office at Washington, D. C., as will fully appear by said assignments or duly certified copies thereof in court to be produced.

V

The inventions of said Letters Patent Nos. 635,429 and 635,430 are capable of conjoint use and have been conjointly used by said defendant.

VI

That said defendant has been duly notified in writing of infringement of said patents here in suit, and requested to cease such infringement, but declines so to do, and still continues to infringe, to the great and irreparable damage of your orator.

VII

That your orator has spent very large sums of money in developing and perfecting the inventions covered by said Letters Patent here in suit and is willing and able to supply any and all demands for products made under and in ac-

cordance with said patents at reasonable prices, and that your orator would be in exclusive enjoyment of its rights but for the infringing acts of this defendant and others.

VIII

That all of the commercial air blown asphalt made in the United States and Territories thereof, and since the date of the inventions here in suit are made in accordance with said Letters Patent Nos. 635,429 and 635,430, and as far as your orator is aware, the only commercial way of [fol. 4] manufacturing said asphalt is in accordance with said Letters Patent aforesaid.

IX

That your orator since the acquirement of said Letters Patent Nos. 635,429 and 635,430, marked all products made by it under and in accordance with said patents, with the word "Patented" and the date of grant of said Letters Patent, in accordance with the statute in such cases made and provided.

X

Your orator avers that the damages sustained by it, and the gains and profits accruing to said defendant by reason of the infringing acts committed and arising during the six (6) years last past and prior to the filing of this Bill of Complaint, will and do aggregate a very large sum of money, to-wit, the sum of at least Five Hundred Thousand Dollars ($500,000.00), for which your orator is entitled to an accounting and recovery.

XI

Your orator further shows unto your Honors that said Letters Patent Nos. 635,429 and 635,430, both have been the subject-matter of extended litigation in the Northern District of Illinois, Eastern Division, in the case of the above-named complainant against the American Asphaltum & Rubber Company, et al.; that a large number of depositions were taken by both sides, respectively, in said litigation; that the defendants made an exhaustive search of the prior

art and introduced in evidence a large amount of prior art; that eminent patent counsel were employed by the defendants in said cause; that after an exhaustive hearing on the merits, and at final hearing, both of the above Letters Patent Nos. 635,429 and 635,430 were sustained and the defendants therein found to infringe both patents; your orator averring that the process followed by the defendants in that cause, American Asphaltum & Rubber Company et al., and the product produced by such process, were substantially, if not identically the same as the process followed and the product manufactured and sold by the defendant in this suit, and herein proceeded against as an infringement.

That suit was also brought in the Northern District of Illinois, Eastern Division, by this complainant against the [fol. 5] Standard Oil Company of Indiana, for infringement of said Letters Patent aforesaid, and that said Standard Oil Company, realizing that said Letters Patent were valid and infringed by it, settled with this complainant for past damages and profits arising out of said infringement of the Letters Patent, and each of them, and took a license to practice each of said inventions in accordance with said Letters Patent Nos. 635,429 and 635,430, respectively, which license is still in full force and effect, and your orator is receiving great gains and profits therefrom.

That since the date of said decree against the American Asphaltum & Rubber Company et al., numerous other infringers have settled with your orator for past damages and profits arising out of the infringement of said Letters Patent aforesaid, and have taken licenses thereunder and are paying royalties under said Letters Patent to your orator, whereby your orator received and continues to receive great gains and profits from said royalties.

That the acts of this defendant, in wilfully and unlawfully infringing said Letters Patent and each of them, results not only to the great damage and injury to your orator, but also to the great damage and injury of its licensees who are paying royalties under said Letters Patent 635,429 and 635,430.

XII

Wherefore, your orator prays that the defendant may be decreed to make answer hereto, but not under oath (an-

swer under oath being hereby expressly waived), and to account for and pay over to your orator all accounts and profits realized by said defendant from the unlawful infringement of each of said Letters Patent, and also to pay over to your orator the damages which your orator has sustained by reason of said unlawful acts of this defendant, and that said damages may be increased three-fold in accordance with the statute and in the judgment of this Honorable Court as may seem reasonable, by reason of said unlawful acts of this defendant; and that said defendant, its officers, agents, servants, workmen and employes, and each of them, may be perpetually restrained from further infringement of said Letters Patent No. 635,429 and 635,430, and that a preliminary injunction restraining said defendant may be issued pending this suit; and that said defendant be compelled to pay all costs of this suit, and that [fols. 6 & 7] your orator may have such other relief as equity and the nature of the case may require.

Judah, Willard, Wolf & Reichman, Frank G. Belknap, Solicitors and of Counsel for Complainant.

Duly sworn to by William A. Leverich. Jurat omitted in printing.

[fol. 8] In United States District Court

[Title omitted]

Answer—Filed March 1, 1915

Now comes the Defendant, The Barber Asphalt Paving Company, and makes answer to the Bill of Complaint herein as follows:

1. The Defendant admits the allegations contained in paragraph numbered 1 of the Bill of Complaint.

2. The Defendant is not informed as to whether or not the Complainant is the owner of Letters Patent Nos. 635,429 and 635,430 in suit or of any rights therein, and therefore denies that the complainant is the owner of said patents or of any rights thereunder, and leaves the complainant to make such proof thereof as it may be advised is necessary. The defendant denies that it has anywhere

within the United States at any time used or sold products in infringement of said Letters Patent, and denies that it has infringed or threatens to infringe said Letters Patent or any rights of the complainant.

3. The Defendant furthermore, as an additional and independent defense, denies that it has at any time within the Southern District of Illinois used or sold products in infringement of said Letters Patent, and denies that it has within said district committed any acts of infringement of said patents, and avers that for this reason this court is without jurisdiction in the premises. By answering the other allegations of the Bill of Complaint the Defendant in no wise waives this defense to the jurisdiction.

4. The Defendant admits that Letters Patent of the United States Nos. 635,429 and 635,430 were issued on Oc- [fol. 9] tober 24, 1899, to George F. Culmer and George C. K. Culmer, but Defendant denies that said patents were issued upon applications made in due form of law, and denies that said patents were properly or legally issued, and denies that they conferred upon said George F. and George C. K. Culmer, or their heirs or assigns any rights whatever; and defendant denies that said George F. and George C. K. Culmer were the original or first inventors of the alleged improvements purported to be patented in said patents, and denies that they were jointly inventors thereof, and denies that said alleged improvements were not known or used by others in this country before their alleged inventions or discoveries thereof, and denies that said alleged improvements had not been patented or described in any printed publication in this or any foreign country before their alleged inventions or discoveries thereof, and denies that the same had not been in public use or on sale in the United States for more than two years prior to the filing of said applications, and avers that the same had been abandoned to the public and avers that said Letters Patent were and are wholly invalid and void.

5. Defendant has no knowledge as to whether there were any mesne assignments of the patents in suit to the Complainant, as is alleged in paragraph IV of the Bill of Complaint, and calls upon complainant to make such proof thereof as it may be advised is necessary.

6. Defendant has no knowledge as to whether the said Letters Patent Nos. 635,429 or 635,430 are capable of conjoint use and denies that they have been conjointly used by the Defendant.

7. Defendant admits the receipt of the letter mentioned in paragraph VI of the Bill of Complaint, but denies that it has infringed said patents or any rights of the Complainant, and denies that the Complainant has sustained any damages by its acts.

8. Defendant denies that it has committed any infringing acts, but has no knowledge as to the other allegations contained in paragraph numbered VII of the Bill of Complaint, and calls upon the Complainant to make such proof thereof as it may be advised is necessary.

9. Defendant denies that all of the commercial air-blown asphalt made in the United States and territories thereof since the date of the alleged inventions purported to be covered by the patents in suit has been made under or in accordance with said patents, and denies that the only com- [fol. 10] mercial way of manufacturing said asphalt is in accordance with said patents.

10. Defendant has no knowledge as to whether the Complainant has marked products made by it in accordance with said patents with the numbers and dates of the patents, and calls upon the Complainant to make such proof thereof as it may be advised is necessary.

11. Defendant denies that it has infringed said patents or any rights of the Complainant, and denies that the Complainant has sustained any damages by its acts, and denies that any gains or profits have accrued to Defendant by reason of any infringing acts.

12. Defendant admits that a decision was rendered by Judge Kohlsaat in the District Court of the United States for the Northern District of Illinois, Eastern Division, in a suit brought by this Complainant against the American Asphaltum & Rubber Company, et al., in which, after obviously serious doubt, the court held the patents in suit valid and infringed by the American Asphaltum & Rubber Company. Defendant denies, however, that in said case there was made an adequate presentation of the prior art and

avers that the evidence on which the decision was based was in large part erroneous and misleading. Defendant further denies that it has practiced any process or made any product similar to the process and product of the American Asphaltum & Rubber Company involved in said litigation. Defendant denies that any of its acts have caused any damage or injury to the Complainant or to any of its licensees, if any, under said patents. As to the other allegations contained in paragraph numbered XI of the Bill of Complaint, the Defendant has no knowledge, and calls upon Complainant to make such proof thereof as it may be advised is necessary.

13. Further answering, Defendant avers that the alleged inventions and improvements described and claimed as new in said Letters Patent, and every material and substantial part thereof, did not exhibit or embody any substantial variations or changes from what belonged to the state of the art as it existed at the time of the alleged origination or discovery thereof, and did not then involve the exercise of the inventive faculty or constitute the subject matter of invention proper to be secured by the grant of Letters Patent within the meaning and intent of the statutes of the United States relating to the grant of patents for inventions.

14. Further answering, Defendant avers that said alleged inventions, and every material and substantial part thereof, [fol. 11] had been in public use and on sale in this country for more than two years before the application for said patents were filed, and had been abandoned to the public.

15. Further answering, Defendant avers that said Letters Patent to Culmer Nos. 635,429 and 635,430 were and are wholly invalid and void because the alleged inventions, improvements or discoveries purported to be patented therein, and every substantial and material part thereof were published, described and patented prior to the alleged inventions or discoveries thereof by said George F. and George C. K. Culmer or more than two years prior to their applications for said Letters Patent in and by the following specified Letters Patent of the United States and foreign countries, to wit:

Letters Patent of the United States

No. 169,189, dated October 26, 1875, William C. Parker.
No. 178,061, dated May 30, 1876, Walter P. Jenney.
No. 178,154, dated May 30, 1876, Walter P. Jenny.
No. 222,408, dated December 9, 1879, Edward C. Kattell.
No. 236,995, dated January 25, 1881, Edward J. De Smedt.
No. 237,662, dated February 8, 1881, Edward J. De Smedt.
No. 239,466, dated March 29, 1881, Edward J. De Smedt.
No. 379,080, dated March 6, 1888, Robert J. Wilson.
No. 435,198, dated August 26, 1890, Robert Alexander.
No. 452,761, dated May 19, 1891, Frederick Salathe.
No. 452,763, dated May 19, 1891, Frederick Salathe.
No. 452,764, dated May 19, 1891, Frederick Salathe.
No. 468,867, dated February 16, 1892, Jesse A. Dubbs.
No. 480,235, dated August 21, 1892, Jesse A. Dubbs.
No. 524,130, dated August 7, 1894, Francis X. Byerley.
No. 547,294, dated October 1, 1895, Frederick Salathe.
No. 547,295, dated October 1, 1895, Frederick Salathe.
No. 564,341, dated July 21, 1896, Frederick Salathe.

Letters Patent of Great Britain

No. 1,710 of 1866, Lake.
No. 2,339 of 1876, Newton.
No. 2,295 of 1879, Plummerer.
No. 2,077 of 1882, Bell.
No. 12,806 of 1884, Imray.
No. 7,742 of 1893, Besford & Pesford.

Letters Patent of Canada

No. 35,117, dated October 2, 1890, Sparrow, et al.

[fol. 12] Letters Patent of Germany

No. 3,577, dated May 8, 1878, Jenney.
No. 4,706, dated September 7, 1878, Schraeder, et al.
No. 39,952, dated October 7, 1886, Schull, et al.

Letters Patent of France

No. 113,217, dated June 7, 1876, Jenney.
No. 144,951, dated October 28, 1881, Rohart.

Letters Patent of Belgium

No. 62,755 of 1883, Rave and Annez.

and in and by the following publications:

American Chemical Journal, Vol. 18, No. 2, pp. 141-150, published by Ira Remsen at Baltimore, Md. in February 1896, and in and by certain other Letters Patent and publications not now known to the Defendant, but which when ascertained the Defendant prays may be made a part of this answer by amendment thereto.

16. Further answering, the Defendant avers upon information and belief that said Letters Patent to Culmer Nos. 635,429 and 635,430 were and are wholly invalid and void because the said George F. and George C. K. Culmer were not the original and first inventors or discoverers of the alleged inventions, improvements or discoveries purported to be patented therein, or of any substantial or material part thereof, but that the same and every substantial and material part thereof were prior to the said alleged inventions thereof by said Culmer and Culmer invented by and known and used by others in this country, to wit:

Francis X. Byerley, Deceased, at Cleveland, Ohio.

Francis A. Byerley, of and at Cleveland, Ohio.

Byerley & Sons, of and at Cleveland, Ohio.

Frederick Salathe, of Santa Monica, California, at Santa Paula, California; Cline, Texas; and elsewhere.

Mission Transfer Company, of and at Santa Paula, California.

Union Oil Company, of San Francisco, California, at Santa Paula, California, and elsewhere.

Litho Carbon Company, of and at Cline, Texas, and elsewhere.

Jesse A. Dubbs, of Los Angeles, California, at Pittsburgh, Pennsylvania, and elsewhere.

Atlantic Refining Company, of and at Philadelphia, Pennsylvania.

[fol. 13] Melvin W. Beardsley, of Santa Barbara, California, at Santa Paula, California.

Edward J. DeSmedt, of and at Washington, D. C.

Grove Refining Company, of and at Buffalo, New York, and elsewhere.

Western Electric Company, of and at Chicago, Illinois, and elsewhere.

American Electric Works, of and at Providence, Rhode Island, and elsewhere.

Washburn & Moen, of and at Worcester, Massachusetts, and elsewhere.

17. Further answering, the Defendant avers that all products sold or used by the Defendant have been openly sold on the market for a long period of years and the Complainant has been at all times familiar with all of such products, and that if Defendant has infringed any right of the Complainant by the manufacturers use or sale of any such product (which this Defendant denies), the Complainant has wilfully neglected to assert its rights and has acquiesced in such alleged infringement and by reason of its acquiescence and neglect and laches in the premises, has forfeited all rights to an injunction or accounting, as prayed for in the Bill of Complaint, or to any relief in equity.

18. Defendant further avers that if the Complainant has any cause of action against it (which it denies), the same is barred by Section 4921 of the Revised Statutes of the United States as amended, insofar as said alleged cause of action is based or founded upon any acts or doings of this Defendant prior to January 14, 1909.

19. Defendant further avers that the description in said Letters Patent Nos. 635,429 and 635,430 of the alleged inventions or improvements set forth therein is not in such full, clear and exact terms as to enable any person skilled in the art to which it relates, or with which it is most nearly connected, to make or use the product therein referred to, and avers that the claims of said Letters Patent are not distinct, and do not particularly point out or distinctly claim the part or improvement which said George F. Culmer and George C. K. Culmer claim as their invention or discovery, or the part or improvement, if any, which they were entitled to claim as their invention or discovery, as required by the statute in such case made and provided.

Wherefore the Defendant prays that it be hence dis-
[fol. 14] charged, with its reasonable costs in this behalf most wrongfully sustained.

Barber Asphalt Co., by Avery D. Andrews, Vice President. Stuart Brown, Logan Hay, John Creighton, Solicitors for Defendant. Fraley & Paul, Of Counsel for Defendant.

[fols. 15-1214] In United States District Court

[Title omitted]

Amendment to Answer—Filed June 12, 1915

Defendant amends its Answer in the above case by adding as paragraph 20 the following:

"20. Defendant further avers upon information and belief that said Letters Patent Nos. 635,429 and 635,430 as granted under date of October 24, 1899, to George F. and George C. K. Culmer, were and are wholly invalid and void because the said George F. and George C. K. Culmer were not the original and first inventors or discoverers of the alleged inventions or improvements purported to be patented therein, but that the said George F. and George C. K. Culmer surreptitiously and unjustly obtainted the said patents for that which was in fact invented by one Francis X. Byerley of Cleveland, Ohio, who was using reasonable diligence in adapting and perfecting the same at said Cleveland, Ohio, as evidenced by the patent of August 7, 1894, for the Manufacture of Asphalt, etc., from Petroleum, and as also evidenced by the practice of the said Francis X. Byerley, in the manufacture and sale of asphaltic products as carried on by him in Cleveland, Ohio, both prior to and subsequent to the date of his Patent."

Fraley & Paul, Of Counsel for Defendant.

[fol. 1215] In United States District Court

[Title omitted]

Opinion on Issues of Validity, etc.—Filed January 17, 1917

The bill charges infringement of two patents, #635,429 and #635,430, known as the Culmer patents; the one describes a process; the other, the product derived therefrom.

The process consists in violently agitating with air petroleum residuum, while the latter is heated to a relatively low temperature, resulting in an asphaltic product more or less solid and practically without loss; that is to say, the volume and specific gravity of the liquid being substantially the same as the volume and specific gravity of the resulting product.

It is admitted by defendant that its process is identical with that of complainant so that the real controversy here is as to the validity of the Culmer patents. The defenses are:

1st. That complainant has not shown a clear title to the Culmer patents.

2nd. Anticipation by the Byerly patent and prior invention by Byerly.

[fol. 1216] The attack upon complainant's title is collateral only, the defendant not seeking to connect itself in any way with the title to the Culmer patents.

On July 14th, 1899, the Culmers had made an agreement with parties called the Byrd syndicate for the repayment of $30,000 furnished by the syndicate in connection with the Culmer patents. Later, on December 14, 1899, the Culmers assigned the patents to the Guardian Trust Company. The assignment was not to secure a debt, but for a temporary purpose and specifically states that it was "subject in all respects to the terms of the agreement of July 14, 1899."

The assignment also provides, "It not being the intention of this agreement to interfere with the right of disposition of said patented process on the part of the parties of the first part," (the Culmers).

The two agreements must be considered together, for the second specifically includes the first and without the first the second is meaningless.

I am of opinion that, notwithstanding the assignment, the legal and equitable title to the patents remained in the Culmers.

The record of proceedings in Guardian Trust Co., Trustee vs. Culmer, begun in the U. S. Court in Chicago, January 1901, is significant. The pleadings and the result of the suit convince me that the assignment was a temporary pledge and that it had been discharged. It is therefore held that the legal and equitable title to the Culmer patents is in the complainant company.

The case was mainly fought out on the joint defense of anticipation and prior invention by Byerly. The language of both Byerly and Culmer patents is clear and unmistakable. Byerly describes a process of distillation; Culmer, a process of oxidation at relatively low temperature and without distillation. Byerly's process involves a heavy loss of material and Culmer's process involves practically no loss of material. Byerly's process takes away the lighter oils. Culmer's process retains those oils.

In the Patent Office, the Byerly patent was cited against Culmer's application and the distinction made at that time was satisfactory to the department. The proof here verifies that distinction.

The further defense is that regardless of his patent, what Byerly actually did constituted prior invention and use. So far as the proof of such prior invention by the elder Byerly rests in the memory of his two sons, Francis and Josiah [fol. 1217] Byerly, it is not sufficient to sustain the defense, and the record of certain still books of the father, produced in evidence by the son Francis, is against rather than in favor of the contention that the elder Byerly was the original inventor of the process described in Culmer's patent. Indeed, the most convincing proof on the subject of prior invention is that contained in the still books which are now for the first time known in the litigation.

Much time and consideration have been given to the various cases cited by counsel for defendant in which the Byerly or Culmer patents, or both, have been involved. Harmony of decision is highly desirable and all courts seek

to preserve such harmony, but those decrees were all based upon different records and the decree here must be based upon the record made here.

The equities are found to be with the complainant. Counsel for complainant may submit form of decree.

Humphrey.

[File endorsement omitted.]

In United States District Court

[Title omitted]

Decree—Filed February 20, 1917

This cause having been heard upon final hearing on the Bill of Complaint, Answer and Testimony taken and filed herein, on behalf of both parties, and after oral argument, and briefs filed by both parties, and thereupon after due proceedings, and the Court being fully advised, it is

Ordered, Adjudged and Decreed, as follows:

1. That Letters Patent of the United States, No. 635,429, granted October 24, 1899 to George F. and George C. K. Culmer, for new and useful improvements in Process of [fol. 1218] Making Asphaltic Flux, and Letters Patent of the United States, No. 635,430, granted October 24, 1899, to George F. and George C. K. Culmer for new and useful improvements in Asphaltic Flux, were each good and valid Letters Patent; and that the said George F. and George C. K. Culmer were the original first and joint inventors of the respective inventions described and claimed in said Letters Patent respectively.

2. That the plaintiff, the Standard Asphalt & Rubber Company is the lawful owner of and entitled to the exclusive right, title and interest in and to each of said Patents and in and to each of said inventions and products respectively described and claimed therein and in and to all claims for past damages and profits arising from the infringement of said letters patent or either of them, and was the owner of such exclusive rights at the time of the filing

of this Bill and for six years prior thereto, and continued to be and now is the sole owner of such rights.

3. That said defendant, Barber Asphalt Paving Company, has violated the exclusive rights of the plaintiff in and to said letters patent and each of them and has infringed each of said letters patent in the manufacture of its asphaltic products at its plants at Madison, Illinois, and also in Maurer, New Jersey, and also has infringed the product patent No. 635,430 in the sale of its product manufactured under and in accordance with said patent in the United States and Territories thereof.

4. That said plaintiff does recover of the defendant the gains and profits made by said defendant and the damages sustained by the plaintiff arising out of said acts of infringement by said defendant.

5. That said defendant after due notice in writing by the plaintiff that it was infringing each of said letters patent, continued to infringe the same in violation of the plaintiff's rights thereunder; that plaintiff has always marked its goods made under and in accordance with each of said letters patent with the word "Patented," in accordance with the Statutes in such cases made and provided.

6. That it be and is hereby further ordered, adjudged, and decreed that this cause be and the same hereby is referred to Bluford Wilson of Springfield, Illinois, as Master to take testimony and to ascertain and to report to the Court together with all evidence taken the amount of such gains and profits made by the defendant, the Barber Asphalt Paving Company, and the damages sustained by the plaintiff by reason of such infringing acts of the defendant; [fols. 1219-4654] and the officers, agents, workmen and employees of the defendant be and are hereby directed and required to attend before said Master from time to time, as he may direct, and to produce before him such books, vouchers, papers and documents as relate to the matters at issue and as the Master may direct, and submit to such oral examination and make and file such written accounts as the Master may from time to time require, and that the plaintiff shall be at liberty to examine said books, vouchers,

papers and documents, as said Master shall order and direct.

7. That the plaintiff, the Standard Asphalt & Rubber Company, recover of the defendant, the Barber Asphalt Paving Company, its costs and disbursements in this suit to be duly taxed, and that the question of increased damages be reserved until the coming in of the Master's report.

Signed at Chicago, Illinois, this 20th day of Feby., 1917.

Humphrey, J.

[File endorsement omitted.]

[fol. 4655] In United States District Court

[Title omitted]

Opinion Confirming Master's Report—Filed March 13, 1924

The plaintiff filed three exceptions to the Master's Report, which will hereafter be considered.

Defendant filed seventy-six exceptions. These exceptions go to the whole report and relate to the method by which the Master proceeded to reach his conclusions, as well as the conclusions reached. Upon submission it was complained that the Master had disposed of the innumerable questions involved by "wholesale" instead of analyzing them and disposing of them at "retail." In its printed brief and argument, defendant submits its argument in support of its exceptions by general argument, but does not attempt to take up its exceptions seriatum beyond its detailed effort to show that, with very slight exceptions, all of the Master's conclusions and findings were wrong.

Therefor, we will endeavor to consider the Master's findings, conclusions and recommendations as they may appropriately fall within three subdivisions:

A. The patents in suit, their proper interpretation and the general rules applicable to the stating of the account.

B. Has the plaintiff maintained the burden cast upon it by the law of establishing that there were gains and profits attributable to the manufacture, use and sale of the infringing products?

C. Alleged errors of the Master as to the detailed profits [fol. 4656] of defendant and deductions drawn therefrom by certain other circumstances.

A.

When this cause was before the Court upon its merits (240 Fed., 750) the Culmer patents here involved, Nos. 635,429 and 635,430, the former a process, the latter a product patent, were, upon the hearing, found not anticipated, valid and infringed by the defendant. It was admitted that the defendant's process was identical with that of the complainant, so that the validity of the patents was directly passed upon. Two defenses were interposed. First, that plaintiff here lacked title to the Culmer patents; second, anticipation by the Byerly patent and prior invention by Byerly. Both of these defenses were resolved against the defendant. Defendant claimed to have been operating for years under the Byerly patent, though it was admitted in the record that its process was the same as plaintiff's process. Judge Humphrey, in discussing the difference between the Byerly and the Culmer patents, said (715):

"The language of both Byerly and Culmer patents is clear and unmistakable. Byerly describes a process of distillation; Culmer, a process of oxidation at relatively low temperature and without distillation. Byerly's process involves a heavy loss of material and Culmer's process involves practically no loss of material. Byerly's process takes away the lighter oils. Culmer's process retains those oils. In the Patent Office the Byerly patent was cited against Culmer's application, and the distinction made at that time was satisfactory to the Department. The proof here verifies the distinction."

Culmer patent (635,430; p. 3, ll. 99 to 114) provides:

"Fluxes produced by blowing a batch for a given number of hours—say at 380 degrees Fahrenheit—will impart a medium melting point to the final compound obtained in the admixture of the resultant flux with a selected base. If the flux be derived, e. g., at 300 degrees Fahrenheit, the melting point becomes relatively low. On the contrary if the batch be blown at a higher degree, e. g., 450 degrees Fahrenheit—the melting point is also advanced. Working

at 450 degrees Fahrenheit demands an increased injection of air particularly if continued for any considerable length of time, the object being to detain in an oxidized base, such constituents as might otherwise pass out in material diminuation of the volume of the batch."

[fol. 4657] A claim of said patent is as follows:

"A black, semi-solid, asphaltic flux devoid of pitch, the same consisting of dehydrated and oxidized petroleum residuum nearly alike in volume and specific gravity, with the original residuum, but markedly higher in its content of asphaltene and lower in petrolene that the residuum from which it was derived and possessing the characteristics of a product obtained by prolonged exposure of petroleum residuum to a heat below pitch-forming temperature, e. g., below 500° Fahrenheit, under copious injection of air to transform the mass without material distillation, substantially as described."

In describing the process (635,429) Judge Humphrey, upon the hearing on the merits, described it in the following language:

"The process consists in violently agitating with air petroleum residuum, while the latter is heated to a relatively low temperature, resulting in an asphaltic product more or less solid and practically without loss; that is to say, the volume and specific gravity of the liquid being substantially the same as the volume and the specific gravity of the resulting product."

In a proper interpretation of the patent, the distinguishing features of Byerly and Culmer are very decided, Byerly's being a process of distillation, while Culmer's is one of oxidation at low temperature and without distillation. But upon the hearing it was admitted that the accused process was identical with that of the plaintiff.

An effort was made at the hearing upon the merits to limit the operation of Culmer's patents to a process not operable with effect below a temperature of 380° Fahrenheit. But there is no such limitation in the patent, and, indeed, its strong feature is that it effects an oxidation that is extremely economical and valuable in the industry, with practically no loss in the volume of the ingredients used.

While the process in which the defendant claims some rights, and which it interposed as a defense, was one of distillation, involving waste and expense, and without any corresponding degree of serviceability.

Upon the hearing on the merits, as well as upon the hearing before the Master while stating the account, the practices of the defendant in its plants, particularly at Madison, Illinois, were shown to be very largely a series of low temperature operations, and this fact has been regarded as a defense. Nice distinctions were detailed by defendant's [fol. 4658] chemists as between an air-blown process and an air-agitated process, in an effort to relieve the defendant from any responsibility for accounting for any of its air-blown or air-agitated products, made at temperatures at and below 380 Fahrenheit. The use of the process at the lower temperatures was found to be infringement and the Master properly held that the air-agitated products produced by the lower temperatures were infringing products and to be considered within the account.

The process and its use within the life of the patent being the property of the plaintiff, it is entitled to the protection of the law. From one who presumed to use it without leave or license, plaintiff is entitled to recover the gains and profits incident to such illegal and unlawful use.

It is a cardinal rule of patent law that, where a patent produces but a part of the profits, the plaintiff may recover only such part of the profits as the patent produces, and the defendant may have credit for the remainder, and this rule holds good in cases where the patented part is so connected with other essential parts of the machine, that if removed and nothing substituted in its place, what remains will not be a complete or workable machine, as well as in cases where the patented portion is separable, and when separated leaves the remainder a complete workable machine. Westinghouse v. Wagner, 225 U. S. 604, 32 Sup. Ct. Rp. 691; Dowagiac v. Minnesota, 235 U. S. 641, 35 Sup. Ct. Rep. 221; Herman v. Youngstown Co. 216 Fed. 607; Dunn v. Standard Co. 204 Fed. 617; Robbins v. Illinois Watch Co., 81 Fed. 958.

The Westinghouse case, supra, has been given very clear and extensive interpretation by the Circuit Court of Appeals for this Circuit. In The Computing Scale Co. v. To-

ledo Computing Scale Co., 279 Fed. 648-673, Judge Baker, who wrote the opinion, said:

"And the first fruits of the Westinghouse decision should be this: If a manufacturer, knowing of a patent, decides to chance an unlicensed use, he should realize that he may be caught by a final decree on the merits and be ordered to respond accordingly; and, so realizing, he should be held to the duty of keeping separate and accurate records of all his infringing acts; and, on his failure to keep such records, the court, in measuring the damages on account of such trespasses, should resolve all doubts against him."

Under Rule 63 it was the duty of the defendant to file a schedule of his gains and profits upon reference of the cause to the Master, when so ordered, as was done in this case.

[fol. 4659] If a defendant, his struggles over the merits being at an end, states his profits from the records, the complainant should be compelled to accept the statement as the measure of the money decree, unless he is prepared forthwith to prove either (1) that the account was falsely stated, or (2) that the profits, if truly stated, are not an adequate measure of complainant's damages. If the first ground is sustained, the Chancellor, either directly or through the Master, might well appoint and qualify a competent and disinterested accountant to cure the defendant's default, and the report of the accountant should stand unless promptly impeached for fraud or gross inaccuracy. If the complainant should take the second ground, he might well be required to prove the value of the appropriated property as other such issues are tried by the opinion testimony of experts qualified to speak on the value of the invention. And neither "established royalty" nor "reasonable royalty," as evidence of the value of the invention, would be necessarily the limit of value, for an infringer should not be allowed the profit which a licensee justly expects.

If a defendant satisfactorily states his profits from the infringing device, but contends that only a part thereof is attributable to the invention, he might well be required to allege in his account, taken as a verified pleading, the

grounds on which he claims apportionment of profits, and his proofs should be limited to the averments. The Computing Scale Co. v. Toledo Computing Scale Co., 279 Fed. 649.

A contention arises in this record as to whether the raw materials used in defendant's infringing operations should be charged at their market value when so unlawfully used, or at their cost to the defendant. In finding the value of raw material used by an infringer of a process patent, for the purpose of ascertaining his profits, the cost of such material to the defendant, and not its value at the time of its use, is to be taken. Byerly v. Sun Co., 226 Fed. 759. To adopt any other rule would lead to confusion and injustice. The fact that the infringer might have applied the same raw materials to some legitimate use, or resold them on the market at the time of their use for more than it cost him, cannot be given consideration. Had the infringer so used his raw materials, in such a case, the profit would have been his and would not be involved in an accounting. By using his materials in the infringing operation, with the hope and anticipation of reaping greater profits than he would have reaped otherwise, it is but sound to require the [fol. 4660] infringer to make restitution of the profits so gained.

Defendant earnestly complains that the Master, in his interpretation of the patent in suit, erred in two substantial points, in holding that when the defendant subjected its paving materials to air-agitation it used the air "at the same temperature and in the same quantities as in the patented process"; that he overlooked the most vital factor of all; that the patent in suit states that the particular result is obtained after a long period of blowing—the first ten or twelve hours producing practically no result, and claims only the result after such "prolonged exposure." An examination of the record and the proofs as to the facts discloses the contrary; that is, that he placed the same construction upon the patents as was applied by the Court upon the merits' hearing, and the same as was placed upon them, undoubtedly, by defendant's expert when he cast his original account, even though that account later proved to be highly inaccurate in other respects.

B. Has the plaintiff maintained the burden cast upon it by the law and established that there were gains and profits attributable to the manufacture, use and sale of the infringing products?

Under new Equity Rule 63, the burden rests upon the defendant, when so ordered, to file its schedule of gains and profits incident to its infringing operations. Defendant, through its assistant auditor, Mr. Deitlin, prepared its schedule in obedience to an order therefor issued by the Master. This account showed a net loss to defendant of $810,206.02. Later, this loss was voluntarily reduced by Mr. Deitlin to $484,862.31. Later, upon analysis of a hypothetical case, involving the questions here involved, on cross-examination, the deficit was reduced to $54,175.12.

The coming in of a schedule showing such a tremendous loss in an apparently successful business enterprise, would have been almost sufficient evidence to warrant the Master himself in appointing an accountant to state the account from the defendant's books. It was unnecessary for him to do so for the reason that the plaintiff provided a very high grade expert accountant, N. G. Chambers, to perform the service. Plaintiff's accountant went into the books, documents and files of the defendant and made a careful and accurate account, which was reported, and the immense {fol. 4661} record in this case which followed was the result of the defendant's effort to disprove and discredit the account of plaintiff's expert, Mr. Chambers, and to sustain the account of its own expert, Mr. Deitlin.

Deitlin's account (Exhibit C) was defendant's schedule of gains and profits. His Exhibit S is the amended schedule, in which defendant's net loss was placed at $484,862.31. Chambers' account became plaintiff's Exhibit A. Both of these experts, strangely, are agreed as to one item, to-wit: That there was a manufacturing profit upon all air-blown products of the defendant in the sum of $656,886.10. To the manufacturing profit so stated, Chambers adds the sum of $672,341.17, arising, as he claims from raw materials, raising the total adjusted manufacturing profit to $1,329,227.27, in favor of the plaintiff. The defendant, figuring from the same source, conceded (Dietlin's Exhibit S) a

total adjusted manufacturing profit of $830,247.74, a difference between the accounts of $298,979.53.

The great conflict between the parties to this accounting arises by reason of the deductions allowed and claimed. Defendant's schedule (Deitlin's Exhibits C and S) are verified. They show a difference of almost $300,000 below the adjusted manufacturing profit shown by Chambers' Exhibit A. Exhibit C makes a showing under oath of a loss on infringing operations of $810,206.02; restated, also under oath, and reduced by Deitlin to $484,862.31, showing a discrepancy between the two sworn exhibits of Deitlin of $325,343.71. Upon the cross-examination of Chambers by defendant, that witness demonstrated, to the satisfaction of the Master, that, according to Deitlin's own figures, the remaining loss shown by Exhibit S, $481,862.31, should be reduced to $54,175.12. In the light of these wide discrepancies, involving immense sums, it was but natural that the Master should have regarded that the credibility of Deitlin as a witness and the evidentiary weight of his schedules (Exhibit C and S) were seriously affected.

Before stating this account, the defendant was ordered by the master to state the total cost to the defendant of the infringing products, to which he (defendant) answered: "Owing to the extreme difficulty of separating the selling cost as between infringing and non-infringing products this question cannot be answered."

The next inquiry was as to the total profit made by the defendant on all manufactured, used and sold infringing [fol. 4662] asphaltic products. Defendant answered that this, too, could not be given, for the same reason. So, it is clear, from this admission of the defendant, that neither the total cost nor the total profit arising out of the manufacture, use and sale of the infringing asphaltic products could be ascertained.

Upon this fact, which is not controverted, the Master was warranted in finding that Deitlin "was reduced to and free to approximate at will over the whole field of figures covered by the general books of the defendant, to pick and choose and speculate and explain on this basis or that as might appear most plausible and just. Thus, the radical and hopeless differences in the conclusions of the expert

accountants for the respective parties was never reconciled, but rather widened."

There is a wide variance between the parties as to just what products infringed and what did not, and it is thoroughly apparent that the entire position of the defendant is based upon the testimony of Mr. Forrest, defendant's chief chemist, as just to what products infringed and what did not, it being his theory that only about 40% of the products of the fire stills infringed plaintiff's patents, and he limited the operation of the patents by his construction. Mr. Forrest's views upon that subject were thoroughly discredited by competent witnesses. And the Master was warranted in so finding.

Upon the coming in of the two accounts, defendant's Exhibit C, by Mr. Deitlin, with all of its apparent infirmities, and plaintiff's Exhibit A, Mr. Chambers' account, it became well established, and there was ample evidence upon which the Master might find that there were gains and profits attributable to the manufacture, use and sale of the infringing products, and, that the plaintiff had sustained the burden cast upon it by the law. This, in spite of the wide range that was then apparent as to the allowance of credits and deductions to the defendant under accounting rules.

C. Alleged Errors of the Master as to the Total Profits of Defendant and Deductions Drawn Therefrom by Certain Other Circumstances.

Much of the voluminous record in this case was accumulated by defendant's efforts to show that it was entitled to a large number of very substantial credits and deductions, on the one hand, and the efforts on behalf of the plaintiff to explain away defendant's positions in regard to these several items. The burden of this labor was incident to the [fol. 4663] fixed policy of the defendant in conducting its business and keeping its accounts so as to completely intermingle the costs and profits of the infringing and non-infringing operations and products of its plants, together with the fact that many of the substantial accounts for which defendant claims it is entitled to deductions, were based upon speculation and found little or no support therefor in the system of bookkeeping of the defendant.

Defendant's Alleged Non-Infringing Products

Defendant contends that its saturations, Choctaw roofings, stone surface coatings, asphaltic block cement and road asphalt were all beyond question of infringement, and the deductions claimed for those branches of production should have been allowed by the Master.

It is contended that nowhere in the record is there any showing that defendant's saturations infringed the patent in suit, and this, notwithstanding the fact that defendant's witness Balfour, superintendent of the plant at Maurer, on cross examination, explained that any air used in manufacturing saturations was entirely for agitation and that the temperature at which saturations were made was usually about 350°. It is also shown that defendant's chief chemist, Forrest, worte the formula for the production of these various products; that he was a witness in a suit involving the Culmer patents as early as 1908, and it becomes apparent that defendant's position as to these products is due to what has heretofore been said about a misconception of the patent in suit by Mr. Forrest.

Defendant's witnesses O'Neill, a stillsman, Fowler, general manager and formerly general superintendent, and superintendent Balfour, all testified to the use of air in the making of saturations, the latter testifying that the temperature at which the still was heated in making saturations was approximately 350° to 400°. There is an abundance of evidence in the record to sustain the holding that in the manufacture of saturations the defendant was using air throughout the period of the account, with air compressors working at their full capacity. In this connection, it might be observed that any saturations which were used were used in connection with other materials which were air blown within the provisions of the patent in suit.

The contention of defendant that its Choctaw roof coatings were non infringing products, is not borne out by the [fol. 4664] record. It is claimed that it was impossible to make an air blown asphalt using Choctaw, i. e., Grahamite. The oil refinery still records, and the testimony of witness Frazier (Acc. Rec. 3209-3211) show that Choctaw was used in the manufacture of air-blown mineral rubber at the oil refinery, and Harry Culmer testified, in rebuttal for the

plaintiff, he, personally, had made air-blown asphalt from Choctaw. Mr. Forrest testified that Choctaw was used in original formula 566, and that it has always been an air-blown product.

Mr. Fowler testified that while the materials entering into the manufacture of roof coatings prior to November, 1916, and during the entire period of the account, were not always the same, yet they were all air-blown compounds.

The claim that all witnesses agreed that stone surface coatings never was an air-blown compound is not borne out by the record. Kirschbraun, Cross and Culmer all testified that air-blown asphalt was used for material of stone surface coatings. One witness, Dr. Cross, stated that stone surface coatings would not be possible except for the existence of air-blown asphalts, and it was the advent into the industry of air-blown asphalts that resulted in building up the mineral or stone surface type of roofing. The production records of defendant also tend to sustain this position.

Asphalt Block and Road Asphalt.

The Master was warranted in finding that asphalt block cement was made by the infringing process. Defendant's witnesses, Forrest, Balfour and Fowler, do not deny this fact, although they distinguish in this instance between air-blowing and air-agitation, and the refinement of the witness Forrest as to the difference. The Master is well sustained by the evidence with reference to his holding as to this particular one of defendant's products.

As to the road asphalt. The evidence was not so clear as to sustain the recovery of profits therefrom as in the other items hereinabove referred to and the Master found against the position of the plaintiff as to it.

Should Asphalts Go Into the Account at Their Cost or Market Value?

We have heretofore pointed out, and it is in harmony with authority and reason, that the raw materials entering into the infringing product should go into the account at [fol. 4665] their cost to the defendant in stating an account such as the one here involved and not at their selling or market value at the time of their use.

When the defendant attempted to comply with the order of the Master, it filed its account in debit and credit form, under Rule 63. This schedule (Exhibit C) put all of the asphalts used into the account at an artificial book profit value. Accountant Chambers attacked the unwarranted method of stating the account and defendant's expert Deitlin then changed the defendant's schedule from his artificial book profit price to an alleged market price. In the light of the fact that the defendant deliberately entered into the infringing business in roofing and miscellaneous compounds, for the purpose of affording an outlet for its natural asphalts, it is entirely proper to charge the defendant with the entire profit incident to this adventure in the use of its materials in its trespasses upon plaintiff's property.

The Choctaw Loss

Defendant owned all of the stock of the Choctaw Asphalt Company, which owned leases and mined a natural asphalt, known by the name of "Choctaw," in Oklahoma. The mine became unproductive, was abandoned and the leasehold surrendered to the Government. On January 13, 1913, defendant charged this loss off by entering on its ledger a credit to Choctaw Asphalt deposit for depreciation, amounting to $145,497.37. In defendant's schedule it attempted to spread this loss over the entire tonnage extracted from the mine, and its accountant Deitlin endeavored to increase the cost of the Choctaw actually used in the products entering into this account by $62,678.64. To allow this deduction in favor of the defendant would be to permit it to charge the plaintiff herein with the loss of a mine which it had deliberately abandoned because the enterprise had become unprofitable. To do so would be inequitable and unjust.

Discounts

Defendant asks the Court to sustain its 64th exception to the Master's report and to allow a credit of $88,842.50 for discounts, alleged to have been allowed by the Sales Department. It cannot be successfully contended, and is not, but that an infringer would be entitled to a credit such as the [fol. 4666] one requested here, if it could be established with

reasonable accuracy. This is one of the items which the Master found against the defendant because of the fundamental fact that defendant so kept its own books that it was impossible to ascertain with reasonable approximation, what the discounts on the infringing products actually were. Here, again, the shifting position of defendant's expert in defendant's account is apparent.

In the original schedule, Mr. Deitlin put in his account an arbitrary deduction not based on anything in defendant's books at all, and, then, in his amended account (Exhibit S), abandoned this theory and based his estimate not on anything shown in the books, but upon the recollection of certain of defendant's witnesses as to the percentage of customers taking discounts and not taking discounts.

Defendant, by counsel in the progress of the hearings, asked permission to substitute an accurate calculation as to what the discounts really were, if its expert and his assistants could find some feasible method of actually determining the accounts. No offer of substitution was made.

In Exhibit C, Deitlin took off arbitrarily two per cent of the entire sales to cover the discounts and collection expense, totaling $118,618.75. In Exhibit S this theory of ascertainment was abandoned and the other method just referred to adopted.

Exhibit S takes a deduction of $88,842.52 for discounts and the sum of $66,629.68 for collection expenses, making a total of $175,112.20, raising the claim contained in Exhibit C $69,000. Plaintiff's expert Chambers, in analyzing these several items, clearly demonstrates that Deitlin first adopted an arbitrary hypothesis and then by the adding of presumption upon assumption, by reason of the recollection of certain individual salesmen, made the deduction. He testified positively and rationally that the item is not ascertainable by any reasonable method from defendant's books.

What has just been said with reference to the claim for discounts may also be said with equal force as to the item of $86,269.50, claimed for collection expenses, and comes clearly within the holding of the Circuit Court of Appeals for this Circuit, in The Computing Scale Co. v. Toledo Computing Scale Co., supra:

If a manufacturer, knowing of a patent, decides to chance an unlicensed use, he will be held to the duty of keeping [fol. 4667] separate and accurate records of all his infringing acts, and on his failure to keep such records all doubts should be resolved against him."

Selling and Collection Expenses

A very substantial disagreement exists between the accounts cast by plaintiff's accountant and that of the defendant. These items are as follows:

	Plaintiff's account	Defendant's account
(a) Traveling salesmen's salaries and expenses	$195,175 34	$270,424 29
(b) General sales agents' and clerks' salaries and expenses	94,347 87	133,672 95
(c) Credit and collection expenses		86,269 68
	$289,523 21	$490,366 92

Here is a discrepancy of more than $200,000 between the two accounts on these items.

As to the first two items, Plaintiff's accountant Chambers apportioned the salaries and expenses of salesmen of the defendant's Sales Department in this manner: He ascertained definitely from defendant's books the total amount of money received from the sales of both the non-infringing and infringing products, and then apportioned the salesmen's salaries and expenses on the proportion that the total amount of sales of the infringing products bore to the non-infringing products.

Defendant's accountant Deitlin, in his first sworn report (Exhibit C) adopted an arbitrary method which was indefensible and was abandoned, when he submitted his amended schedule (Exhibit S). In Exhibit C the entire amount of salesmen's salaries and expenses were charged to the infringing products and nothing to the non-infringing products, on the ground that the latter practically sold themselves. This conclusion was at complete variance with the testimony of defendant's chief clerk of the Sales De-

partment, Mr. O'Neill. Defendant's assistant sales manager, Mr. Cavey, also detailed the loss of sales of many millions of pounds of Gilsonite in one instance to a com-[fol. 4668] petitior as early as 1912; that the advent of the Mexican and Texas oils had a very depressing effect upon the sales of Gilsonite, one of the non-infringing products.

It was contended that the number of sales should have been a controlling factor, and yet the evidence shows that of the sales for 1913 there were 2722 roofing orders and 215 orders for non-infringing natural asphalts coming through the Chicago office. However, the witness Trosky testified that 1394 of the roofing orders emanating from that source in the year 1913 went to one customer alone. So that the number of orders was not a controlling element, by any means, and the Court is not prepared to say that in determining the evidentiary value of the contending accounts upon this subject that the Master was not warranted in the conclusion which he reached.

As to the item of credit and collection expenses, for which the defendant seeks a credit of $86,262.68. The witness Chambers found no such an account in defendant's books, yet, defendant's accountant, in his Exhibit S, makes an arbitrary apportionment of all credit and collection expenses in his own peculiar way. He first deducted 10% of the expenses of the treasurer's department and then assumed that of the balance of 90% only 25% should go to road and paving and 75% should be charged against the sales department, and deducted 10% of the latter amount for the non-infringing roofing and miscellaneous compounds. This charge is wholly arbitrary and is supported by no evidence in the record beyond Deitlin's explanation of how he did it.

This item alone comes clearly within the rule announced in The Computing Scale Co. v. Toledo Computing Scale Co., supra. The 65th exception cannot be sustained.

Advertising

Defendant complains earnestly of the Master's holding in allowing the defendant a deduction of $161,000 for the item of advertising. The total deduction sought by the defendant is $404,036.41. There was some confusion in casting the account on the part of both accountants for the

plaintiff and defendant. Later, it developed that the substantial facts contained in the advertisements were not true. The catch line of the advertising featured "Trinidad Lake Asphalt," while the name "Genasco Ready Roofings" was [fol. 4669] strongly featured. At first it was the impression, not only of the advertising manager of the defendant, but also of the accountants, that "Genasco Ready Roofings" was manufactured from Trinidad Lake natural asphalt. It developed, however, that there was little or no Trinidad Lake natural asphalt contained in the so-called "Genasco Ready Roofings." The names "Trinidad" and "Genasco" were worked into a circular trade-mark and printed upon the Western Hemisphere as a background; the word "Genasco" being coined from the first letters of the words in the name of the General Asphalt Company. The name and trade-mark were the property of the General Asphalt Company, and the only part of the advertising that referred to the infringing products were the words "Ready Roofings," in the manufacture of which the patented process was used. This advertising, undoubtedly, had a strong influence in popularizing the abbreviation of the name of the present corporation, the General Asphalt Company, which owned and controlled the Barber Asphalt Paving Company, the defendant herein. It, through other companies, owned and controlled the Trinidad Lake from which the supply of natural asphalt is obtained, and, therefore, it must not be overlooked that the substantial parts of the advertising were directed to the popularizing of the name and the property really of the defendant or the company of which the defendant was a subsidiary.

In so far as this advertising promoted the sales of ready roofing in which the infringing product was used, it may have promoted sales from which the gains and profits are herein sought to be recovered. It was by no means the aim of the advertising to popularize the product of plaintiff's patents. And also, it is true the story told by the advertising was untrue and unfair to the public, yet, it may have had some effect in the promotion of sales of the infringing products.

In the light of these considerations and the evidence in the record, and the fact that before the hearings before the Master were started, the patents had expired and the de-

fendant had the lawful right to use its trade-mark and advertise the merits of natural asphalts, together with the use of products made according to the provisions of the Culmer patents, the more substantial effect of the advertising inured to the permanent benefit of the defendant, or the [fol. 4670] company of which it is a subsidiary, the Court believes that the apportionment made by the Master is the best that could be made.

Interest on Investment

By its 43rd exception defendant complains because the Master allowed it a deduction of only $206,287.76 as interest on invested capital. Defendant's computation of this item, credit for which is sought, fixes the amount of interest at $342,553.29. The Master found that there was an agreement between the experts that if the interest item is to be allowed there should be deducted the sum which the Master did allow. This finding is very earnestly challenged by the defendant. That discrepancy between the accountants upon this item was, undoubtedly, considered by the Master and due consideration given to the claim of deduction sought by the defendant.

On the item of interest on accounts receivable, plaintiff's accountant found $12,370.66, while defendant's accountant placed it at the sum of $84,830.95. The fairness of the allowance of the Master in this regard is evidenced by the fact that he considered the sum suggested by plaintiff's accountant in the light that defendant's books show no item of interest on accounts receivable, nor do they show the total accounts receivable for roofing and miscellaneous compounds at any given time. Defendant's expert's method of ascertaining this item arbitrarily for the present purpose did not appeal to the Master, and the burden was clearly upon the defendant to ascertain the item, and if there is any question about the correctness of the findings, it is due to the fact that the defendant did not segregate the infringing and non infringing products as to this item so that it could be definitely ascertained. The chief differences, however, between the two accountants upon this item was due to the fact that defendant sought an interest allowance upon its investment in the oil refinery, the power plant, maintenance equipment, transportation

and other parts of the plant which in the nature of things could only render partial service to the roofing and miscellaneous compound activities.

The Master was warranted in adopting the view of the accountant Chambers, that there was no basis on which one could ascertain the percentage of the power plant, maintenance equipment transportation, etc., which should be charged to the roofing and miscellaneous compounds, and [fol. 4671] separate them from those properly chargeable to the other activities in the plant.

As to the oil refinery. The allowance in that regard was properly disregarded, for the double reason that during a large portion of the accounting period there was no oil refinery in existence and it was not a necessary adjunct to the roofing and miscellaneous compound business.

The exception of the defendant as to this finding cannot be sustained.

Apportionment Between Infringing and Non Infringing Products

Defendant asks the Court to specifically find that of any profits which the account, as finally stated, may show were earned by defendant's roofing and miscellaneous compound business, not more than 13½% was attributable to the blown compound included therein. This contention is upon the theory "that defendant's infringing roofings consist of a number of parts which do not infringe, combined with one part which does. The upper coating of the roofing consists of a combination of non-infringing natural asphalt with an infringing blown oil. This coating is applied to one or more layers of saturated felt which contains no blown oil or other infringing product. The lower coating of the roofing, if there be one, usually contains no infringing material."

The trouble with this contention is that the premise is incorrect and the Master so found upon the great weight of the evidence. Two very eminent asphalt experts, Mr. Kirschbraun and Dr. Walter M. Cross, recognized and admitted as eminent in their profession, testified on behalf of plaintiff that the modern roofing materials of the class here involved would not be possible except for the existence of these air-blown products.

Profits on Asphalt Block Cement.

Defendant complains earnestly as to the allowance of profit by the Master upon defendant's manufacture of asphalt block cement, in the sum of $119,739.41, claiming that the manner in which this item was ascertained is wholly indefensible and that plaintiff's expert presented no rational grounds for the allowance of the claim.

[fol. 4672] It was shown by a clear preponderance of the evidence that asphalt block cement was an air-blown product. It was not sold in the open market, but used by the defendant company in its paving operations. The defendant, upon the hearing before the Master, refused to submit any different account, or, in fact, any account at all upon the items of asphalt block cement and road asphalt. If the method of reaching this account, and the account itself, were wholly untenable, it would have been very easy for the defendant to prove that fact to the Master by the production of its own books, which were in its possession, and which it declined to submit. The account as cast by Mr. Chambers was undoubtedly the best that could be cast under the circumstances, and comes clearly within the rule announced in The Computing Scale Co. v. Toledo Computing Scale Co., supra, as does, also, the allowance for profits on Bermudez asphalt, made in fire stills,—$47,814.62.

Exceptions 36, 37 and 38 cannot be sustained.

Reports of the General Asphalt Company

Upon the hearing, the plaintiff was permitted to offer in evidence the reports of the officers and directors of the General Asphalt Company to the stockholders and investors in the company, which were published annually during the period covered by the accounting in this case. These reports were prepared from the books, which had been carefully audited by a competent and credible auditing company, and were the company's representations to its stockholders and investors, and the public generally, as to the business and operations of the General Asphalt Company. The General Asphalt Company is the parent company, or, rather, the Barber Asphalt Company is the chief operating subsidiary of the General Asphalt Company. The reports, when read together, show a substantial growing success in

the business of roofings and asphaltic compounds. It shows the general purpose of engaging in that line of business and gives a very glowing description of the achievements of the company. And it is charged by the defendant that a great deal of the report of the Master in this case was made up from excerpts from those annual reports and that his conclusions were based upon facts elicited from them. The Court does not understand this to be the fact, as shown by the report of the Master, which is so bitterly complained of by the defendant.

[fol. 4673] In this case, upon being ordered so to do, it was the duty of the defendant to state its account. It did so. It stated an account which was so unreasonable as to destroy its credibility. More than that, the maker of the schedule immediately amended it, reducing the losses which he had reported from the branch of defendant's business covered by the accounting, almost $400,000.00, and, later, it was demonstrated that even a more substantial sum should have been taken from that loss figure by the cross-examination of the author *if* the statement itself.

These facts are quite glaring, when considered in the light of the official reports of the company, made annually, showing a highly prosperous condition, a growing business, one that was especially serviceable to the defendant by reason of the fact that it filled in a portion of the year when defendant's other business was at a stand-still.

The Master did give consideration to the reports of the General Asphalt Company, but he did this by way of testing the credibility of defendant's chief witness, Mr. Deitlin, and the weight of the schedule of gains and profits which he had submitted on behalf of the defendant. For the latter limited purpose, the Court is of the opinion, the evidence was properly admitted and considered. Of course, the Master would not be permitted to state an account such as the one here involved, from sources such as the general reports, but where a great organization, such as the General Asphalt Company, the owner of defendant here, permits its books to be examined for the purpose of showing gains and profits generally, and then particularly shows great strides and great successes along the lines involved in this investigation, at a time when no litigation is pending, there is every reason why the full truth should be shown. When

facts are elicited under these circumstances by an expert accountant, whose credibility cannot be questioned, it is entirely right and proper to consider such documents as showing a general condition; especially, when another statement is submitted under the stress of litigation, which tends to disprove a substantial part of the material represen-a-tions made in the public documents, printed and circulated by defendant.

Here, the burden was clearly upon the plaintiff in the first instance to show that there had been gains and profits arising out of the infringing operations of the defendant.

Upon the coming in of defendant's schedule of gains and [fol. 4674] profits, showing a loss of more than $800,000.00, due to the infringing operations involved in this case, the plaintiff employed the services of an accountant, connected with one of the best and most reputable concerns in the country. He was given defendant's schedule and was permitted to examine most of defendant's books, and made a report, which shows an entirely contrary result from that disclosed by the statement of defendant.

The Master considered these two reports of the contending accountants. To one he justly accorded a high degree of credibility. To the other he felt its weight as evidence was seriously affected by several things, among which are the following: The credibility of the author of defendant's account, Mr. Deitlin, was seriously impaired by his own admission as to the manner in which he made his figures and reached his conclusions. The clear and positive testimony of Mr. Chambers destroyed the value of a large portion of Mr. Deitlin's report.

Then, again, it was shown that much of Mr. Deitlin's report was based upon an ineffectual attempt to limit the operation of plaintiff's patents and to throw the infringing element of defendant's business into a relatively small portion thereof. By means of these calculations, based upon what might be called misinformation, furnished by defendant's Mr. Forrest, the value of defendant's schedule was again most seriously affected.

Again, from the manner and method of its conception it was sought to minimize or reduce the value of plaintiff's patents and the extent of the service which they had rendered the defendant in building up an entirely new and

prosperous branch of its business. By this method, defendant's expert was able to show that there had been used of plaintiff's patented product not to exceed 8,500 tons.

The Court feels that the plaintiff made this showing and that the Master was warranted from the facts in this case in finding that the defendant was a willful infringer. It is not beyond the realm of reasonable deduction to find from the evidence in this record that the defendant held its alleged rights under the Byerly patents very largely as a precaution against prosecution for trespasses upon the property of the plaintiff, to-wit: the Culmer patents.

There is considerable evidence in the record tending to show that since the date of the organization of the General [fol. 4675] Asphalt Company, during which time it has been contended, by the defendant, that it was operating under the Byerly patents, the Byerly process was not used, but rather the Culmer process. As early as 1908, defendant's chief chemist was a witness in litigation involving the two patents and two processes.

In the light of this situation, the Court feels that plaintiff's expert made a sincere, fair effort to get at the truth from defendant's books and such aids as were at hand. Of course, it is not absolutely accurate. Much of it had to be appropriately deduced from rational premises.

The advertising, for a portion of which the Master allowed a deduction in the account in this cause, and of which the plaintiff complains, the Court believes was fairly allowed.

The exceptions of the plaintiff as to the refusal of the Master to allow it profits on the road asphalt, made in steam stills, presents considerable merit, and, yet, there was throughout all of the evidence upon that phase of the case some question as to whether or not the plaintiff was entitled to such profits.

The Court has reached the conclusion, that, on the whole, the Master has probably reached the fairest adjustment possible in the light of all of the facts and circumstances in this case, considering, of course, the failure of the defendant to so keep its books as to show accurately the profit or loss of its infringing operations and to keep separate accounts between its infringing and non-infringing products, in failing to be able to show the cost of materials entering

into the infringing process and, also, failing to keep a report showing the gains and profits upon the infringing operations.

Therefore, the exceptions of the plaintiff to the Master's report will be overruled; all of the exceptions of the defendant to the Master's report will be overruled; the Master's report will be approved and a decree may be prepared in conformity therewith.

[fol. 4676] In United States District Court

[Title omitted]

Decree—Filed April 30, 1924

This cause coming on to be further heard at this term on the exceptions filed by plaintiff and by defendant respectively to the Master's Report filed herein on January 6, 1921, and the same having been argued by counsel, and the Court being fully advised in the premises, and upon consideration thereof,

It is ordered, adjudged and decreed as follows:

1. That the exceptions of the plaintiff, Standard Asphalt and Rubber Company, and of the defendant, Barber Asphalt Paving Company, respectively, to the report of Bluford Wilson, Esq., Master in Chancery in this Court, to whom, by the decree of this Court made and entered in this cause on the 20th day of February, 1917, this cause was referred, with instructions to take and state an account of the gains and profits made by the defendant, and to ascertain and assess the damages sustained by the plaintiff by reason of the infringing acts of, and the infringement by, the defendant of the Letters Patent Numbers 635429 and 635430 of the United States of America, and report thereon to the Court, which said report made by said Master was by said Master heretofore filed herein on the 6th day of January, 1921, be, and said exceptions of said plaintiff and of said defendant, respectively, are, hereby overruled and denied.

[fols. 4677-4683] 2. That the said report be, and hereby is approved and confirmed.

3. That the plaintiff, Standard Asphalt and Rubber Company, is entitled to have and recover of and from the defendant, Barber Asphalt Paving Company, the gains and profits made by the defendant by reason of said infringement by the defendant of said Letters Patent, as the same are ascertained and found in and by said report, in the sum of Six Hundred and Fifty Thousand and Forty-four dollars and eighty-three cents ($650,044.83), with interest thereon from the sixth day of January, 1921, the date of the filing in this Court of the said report, at the rate of five per cent (5%) per annum, together with plaintiff's costs and disbursements herein incurred to be taxed.

4. That the plaintiff, Standard Asphalt and Rubber Company, do have and recover of and from the defendant, Barber Asphalt Paving Company, the sum of Six Hundred and Fifty Thousand and Forty-four dollars and eighty-three cents ($650,044.83) together with interest thereon from January 6th, 1921, until paid, and do have and recover of and from the defendant the costs and disbursements of the plaintiff incurred in this cause, to be taxed, and that plaintiff have execution therefor.

Louis FitzHenry, Judge.

[fols. 4684-4872] In United States District Court

[Title omitted]

Order Allowing Appeal—July 1, 1924

This cause came on to be heard at this term and after hearing counsel and after consideration thereof, it is

Ordered as follows, viz:

That an appeal to the United States Circuit Court of Appeals for the Seventh Circuit from the decree of this court entered and filed herein, April 30, 1924, be, and the same is, hereby allowed, and that so much of the transcript of the record herein as is necessary and essential to a proper presentation thereof be forthwith transmitted to said United States Circuit Court of Appeals, and it is further

Ordered that a supersedeas bond be filed in the sum of Eight Hundred Fifty Thousand Dollars ($850,000.00) as provided by law, and

It is further ordered that upon filing said bond and its approval by the Court this order shall operate as a supersedeas and the clerk is directed to stay further proceedings in this cause.

Louis FitzHenry, Judge.

[fol. 4873] In United States District Court

Precipe for Transcript of Record

To the Honorable S. T. Burnett, Clerk of Said Court:

Please prepare a transcript of the record in the above entitled cause for use on appeal, including therein copies of the following:

Bill of Complaint;
Chancery Subpœna;
Answer;
Entry of Appearance for Plaintiff;
Amendment to Answer;
Bill of Particulars;
Order of September 15, 1915;
Affidavit of Henry M. Paul, Jr.;
Motion to fix date for hearing;
Certificate of Evidence, consisting of printed pages 24 to 1215, inclusive, pages 1222 to 4591 inclusive, and the following exhibits:

Plaintiff's Exhibits A B and C and Schedules 1 to 21 inclusive,
Plaintiff's Exhibit D amended and schedules 22 and 23,
Plaintiff's Exhibit E,
Plaintiff's Exhibit F,
Plaintiff's Exhibit M-11,
Choctaw Memorandum,
Memorandum-Tank Steamers,
Losses of the Trinidad Lake Petroleum Company from the abandonment of wells,
The Uintah Railway Co.

Inter-Office correspondence Barber Asphalt Paving Co. of July 5, 1917,

[fol. 4874] Relationship of B. A. P. and affiliated companies whose products are involved in patent action, Standard vs. Barber,

Chamber's cross-examination No. 1,

Special Customers to whom discount and terms were offered,

Plaintiff's Exhibit form of asphalt contract,

Memorandum in reference to Question 230 and 231,

Memorandum in reference to Question 352,

Memorandum in reference to Question 574,

Memorandum in reference to Question 636,

Memorandum in reference to Question 672,

Memorandum in reference to Question 678,

Fowler's Statements,

Forrest's Formulae,

Published Articles by C. H. Forerst requested by Mr. Belknap,

Memorandum of Statements made by Employees of the Barber Asphalt Paving Company at Madison. Dated February 18, 1918;

Defendant's Exhibits D, E, F, G, H, I, J, K, L;

Defendant's Exhibit Supplement to Exhibits C and D;

Defendant's Exhibit Supplement to Exhibits E to K;

Defendant's Exhibit Supplement to Exhibit L;

Defendant's Exhibit List of Larger Chicago Gilsonite Sales;

Defendant's Exhibit S;

Defendant's Supplemental to Exhibit S;

Defendant's Exhibit T;

Defendant's Exhibit U;

Chamber's Rebuttal Schedule 13a;

Chamber's Rebuttal Schedule 13b;

Chamber's Rebuttal Schedule 22;

Chamber's Rebuttal Schedule 24;

Defendant's Exhibit Deitlin's Computation of percentage of Genasco Roofing containing Trinidad;

Opinion filed on Jan. 17, 1917;

Decree of Feb. 20, 1917;

Master's Report;

Exception to Master's Report by Plaintiff;

Order extending time for defendant to file exceptions to Master's Report;
Defendant's Exceptions to Master's Report;
Motion for a new reference;
[fol. 4875] Memorandum filed Mar. 13, 1924;
Decree filed April 30, 1924;
Petition for appeal;
Assignments of error;
Prayer for reversal;
Order allowing appeal;
Appeal Bond;
Citation;
Copy of this praecipe.

Henry N. Paul, Brown, Hay and Stephens, Solicitors for Defendant.

To: A. F. Reichmann, F. L. Belknap, Allen & Converse, Counsel for Complainant:

You are hereby notified that we have this day filed with S. T. Burnett, Clerk, a copy of the foregoing praecipe for record.

Henry N. Paul, Brown, Hay and Stephens, Counsel for Defendant.

Received copy of the above notice this 24 day of April, A. D. 1925.

Walter M. Allen, Counsel for Complainant.

[fol. 4876] Clerk's certificate to foregoing transcript omitted in printing.

[fol. 4877] In United States District Court

Orders Extending Time

Thursday July 31st, 1924

[Titles omitted]

And now on this 31st day of July, A. D. 1924, comes the defendant herein by R. Allen Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that

the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit, be, and the same is hereby extended for a period of thirty days to and including August 30th, 1924.

Saturday August 30th, 1924

And now on this 30th day of August A. D. 1924, comes the defendant herein by R. Allen Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit, be, and the same is hereby extended for a period of sixty days to and including September 29th, A. D. 1924.

[fol. 4878] Monday, September 29th, 1924

And now on this 29th day of September A. D. 1924, comes the defendant herein by R. Allen Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the seventh Circuit be, and the same is hereby extended for a period of ninety days, to and including October 29th, A. D. 1924.

Wednesday, October 29th, 1924

And now on this 29th day of October A. D. 1924, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit, be, and the same is hereby extended for a period of one hundred twenty, days to and including November 28th, A. D. 1924.

[fol. 4879] Friday November 28th, 1924

And now on this 28th day of November A. D. 1924, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that

the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit, be and the same is hereby extended for a period of one hundred fifty days to and including December 28th, A. D. 1924.

Saturday December 27th, 1924

And now on this 27th day of December A. D. 1924, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh [fol. 4880] Circuit, be, and the same is hereby extended for a period of one hundred eighty days to and including January 27th, A. D. 1925.

Tuesday January 27th, 1925

And now on this 27th day of January A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of two hundred ten days to and including February 27th A. D. 1925.

Thursday February 26th, 1925

And now on this 26th day of February A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that [fol. 4881] the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of two hundred forty days to and including March 28th, A. D. 1925.

Saturday March 28th, 1925

And now on this 28th day of March A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in

the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of two hundred seventy days to and including April 27th, A. D. 1925.

Monday April 27th, 1925

And now on this 27th day of April A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its [fol. 4882] solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of three hundred days to and including May 27th A. D. 1925.

Wednesday May 27th, 1925

And now on this 27th day of May A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of three hundred thirty days to and including June 26th A. D. 1925.

Friday, June 26th, 1925

And now on this 26th day of June A. D. 1925, comes the defendant herein by R. Allan Stephens, Esq., one of its [fol. 4883] solicitors and on his motion, it is ordered by the court that the time for filing the transcript of record in said case in the United States Circuit Court of Appeals for the Seventh Circuit be, and the same is hereby extended for a period of three hundred sixty days to and including July 26th, A. D. 1925.

Clerk's certificate to foregoing orders omitted in printing.

[fols. 4884-4912] Citation in usual form showing service on Walter M. Allen, filed July 8, 1924, omitted in printing.

[fol. 4913] In United States District Court

[Title omitted]

ORDER RE TRANSCRIPT—March 30, 1926

This cause came on to be heard upon the motion of the Barber Asphalt Paving Company filed herein on March 18, 1926, and upon the order of the Circuit Court of Appeals entered on January 29, 1926, certified copy of which is attached to said motion, and thereupon the said Barber Asphalt Paving Company, by its solicitors, Henry N. Paul and Logan Hay, presents to the Court the certified transcript of the record of this cause heretofore certified to the Circuit Court of Appeals and remitted by it on January 29, 1926, under the order of the Circuit Court of Appeals hereinabove referred to, and requests the Court to append its certificate of evidence to that part of the record which sets forth the testimony and other proceedings had and taken before this Court on the trial of said cause, and for such further amendment, correction or amplification as the District Court may see fit to make respecting the certification of the record, and also respecting the certification of certain printed copies of the specifications and drawings of four (4) United States patents as filed with the Accounting Master which are appended to the printed transcript in this case (pages 4885 to 4907). And said Standard Asphalt and Rubber Company having been duly notified and appearing herein by A. F. Reichmann and Walter M. Allen, its counsel, appearing specially, solely and only for the purpose of challenging the power and jurisdiction of the Court to entertain the motion herein and to grant the relief herein prayed;

And the Court having heard the testimony of James M. Purcell, the official reported who transcribed the testimony heard before the Honorable J. Otis Humphrey, deceased, and William J. Snyders, deputy clerk of this Court, finds: [fol. 4914] 1. That the sixteen volumes filed herein, one thereof on September 29, 1916, and fifteen thereof filed on January 17, 1917, together with the exhibits referred to therein and attached thereto, said volumes and exhibits being the testimony filed herein as referred to in the decree entered by Humphrey, Judge, February 20, 1917 and copies of which said volumes and exhibits are set forth at pages 24 to 1577, inclusive, of the printed transcript of record

heretofore certified by the Clerk of this Court on June 29, 1925, are the full, true and complete transcript of all the proceedings had upon the hearing of this cause before the late Judge J. Otis Humphrey, including all the oral testimony, depositions, stipulations and exhibits which were introduced in evidence on the said hearing, and

2. That the instrument bearing on the cover in pencil the following: "Standard v. Barber, Defendant's Ex., Prior Art patents, O. K. F. L. Belknap," containing among other things copies of the specifications forming part of Letters patent Nos. 227945, 435198, 512,348 and 512949, was filed by Bluford Wilson, Special Mastery in Chancery in this cause, with his report herein, and that said instrument contains the exhibits referred to on pages 3757, 3758, 3762 and 3764 inclusive, 3786 and 3788 inclusive, 3795 and 3796 inclusive, 3925 and 3936 inclusive wherein reference is made to letters Patent of the above numbers of the printed transcript of record as certified by the Clerk of this Court, and was considered by this Court upon final hearing of this cause as exhibits reported by said Master in Chancery.

The Court therefore directs the Clerk of this Court to transcribe the said instrument described as: "Standard v. Barber, Defendant's Ex., Prior Art Patents, O. K. F. L. Belknap," by a supplemental transcript, to be certified to the Circuit Court of Appeals as part of the record of appeal in this cause.

And upon request of the said Defendant, the said Barber Asphalt Paving Company, the Court hereby directs that all the testimony in this cause be reproduced in the exact words of the witnesses, and not in narrative form.

And the Clerk of this Court is further directed to amend the transcript of record returned to this Court under the said order of the Circuit Court of Appeals, by adding thereto any file marks appearing upon the original stenographer's transcript of the proceedings at the trial as [fols. 4915-4958] filed by the district judge and referred to by him in his interlocutory decree of February 20, 1917.

And pages 24 to 4872 inclusive of the transcript of record heretofore certified by the Clerk of this Court on June 29, 1925, amended and supplemented as herein directed, are hereby approved as a true, complete and properly prepared

statement of the evidence (including testimony and exhibits therein referred to and the stipulation of the parties) in the above entitled cause.

And the Clerk of this Court is further directed to append to the original transcript of record herein a transcript of the order redocketing this cause in this court, the motion of Barber Asphalt Paving Company filed herein on March 18, 1926, and this order and thereupon to further certify said transcript of record and return the same to the Circuit Court of Appeals for the Seventh Circuit.

(Signed) Louis FitzHenry, Judge.

Indorsed, Filed March 30, 1926, S. T. Burnett, Clerk.

DEFENDANT'S EX.

Prior Art Patents

STANDARD

v.

BARBER

O. K. F. L. Belknap.

[fols. 4959 & 4960] Clerk's certificate D. C. U. S. to foregoing transcript omitted in printing.

[fols. 4961 & 4964] Clerk's certificate U. S. C. C. A. to foregoing transcript omitted in printing.

[fol. 4965] IN UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

No. 3614

BARBER ASPHALT PAVING COMPANY, Appellant,

vs.

STANDARD ASPHALT & RUBBER COMPANY, Appellee

MOTION FOR SEPARATE HEARINGS—Filed November 3, 1925

Now comes the Barber Asphalt Paving Company, appellant in the above entitled cause, and respectfully shows to the Court that prior to the interlocutory decision of the District Court holding the patents in suit valid and infringed said letters patent had expired, wherefore no injunctional decree was ordered which could be appealed from, and that the cause was referred to a Master for an accounting of profits and damages arising out of defendant's alleged infringement and further proceedings were had before the Master and in the District Court; all of which proceedings and holdings assigned as errors are before this Court upon the present appeal:

Wherefore, this appellant prays the court to separate and divide the argument on the issues of its said appeal, and to separately hear and decide the issues of title, validity of the patents in suit and the infringement by appellant before further hearing and deciding (should further decision be necessary) the issues decided during and subsequent to the reference of the cause to a Master to take an account of profits and damages arising out of appellant's alleged infringement of the Patents in suit.

Rector, Hibben, Davis & Macauley, Solicitors for Appellant.

[File endorsement omitted.]

[fol. 4966] In United States Circuit Court of Appeals

[Title omitted]

Notice of Objections and Motion to Strike—Filed November 9, 1925

To Messrs. Rector, Hibben, Davis & Macauley, Attorneys for Appellant:

Please take notice that on Monday, November 9, 1925, at 10 o'clock A. M., on the hearing of motion of Appellant to separate and divide the argument in the above entitled cause, etc., before the United States Circuit Court of Appeals for the Seventh Circuit at Chambers, in the Federal Building, we shall appear and present the annexed objections of Appellee to said motion and also the annexed motion of Appellee to strike from the purported transcript of record in said cause certain purported proceedings and evidence and testimony appearing in said purported transcript, in accordance with and upon the grounds set forth in said annexed motion; at which time and place you may be present if you see fit.

A. F. Reichmann, Frank L. Belknap, Walter M. Allen, Solicitors for Standard Asphalt & Rubber Company, Appellee.

Received a copy of the above notice and copies of the said motion and objections, this 7th day of November, 1925, at 12:45 P. M.

S. E. Hibben, Attorney for Appellant.

[fol. 4967] In United States Circuit Court of Appeals

[Title omitted]

Motion to Strike—Filed November 9, 1925

Comes now Standard Asphalt & Rubber Company, Appellee in the above entitled cause, by A. F. Reichmann, Frank L. Belknap and Walter M. Allen, its solicitors, and moves

the Court to strike from the purported transcript of the record filed herein all purported proceedings, and the purported evidence and testimony purporting to have been had and taken on the trial of said cause before said District Court, on the issues of plaintiff's title to the patents therein sued upon, and of the validity of said patents, and of the infringement thereof by defendant, as the same appears in a purported transcript of the record filed herein, from pages 18 to 1577 of said purported transcript of the record, for the following reasons, and upon the following grounds, to wit:

1. The decree of the District Court adjudicating and decreeing the title of the patents in suit in plaintiff, and the validity of said patents, and the infringement thereof by appellant, was entered on February 20, 1917, as appears on pages 1217 to 1219 inclusive of the purported transcript of the record filed herein, and no appeal was ever prayed or taken from said decree within the time fixed and limited by law, and because and in consequence thereof said decree became final and conclusive, and is not now the subject matter of appeal and review by this Court.

2. The petition of defendant for appeal filed in the office of the Clerk of said District Court on July 1, 1924, and the prayer of defendant for the reversal of the decree, appear-[fol. 4968] ing on pages 4678 and 4679 of the purported transcript of the record filed herein, prayed an appeal from, and reversal of, the decree of said District Court of April 30, 1924, appearing on page 4676 of said purported transcript, overruling the exceptions to the Master's Report filed therein, and approving and confirming said Master's Report and entering judgment in favor of plaintiff and against defendant in the sum of $650,044.83, together with interest thereon from January 6, 1921, until paid, and the costs and disbursements of plaintiff, and said prayer for appeal and for reversal of decree did not pray, or operate to pray, an appeal from, or reversal of, the decree of February 20, 1917, and because and in consequence thereof an appeal from said decree of February 20, 1917, has never been prayed, taken or perfected, and said decree is now final and conclusive, and not the subject matter of appeal to, or review by, this Court.

3. The purported transcript of the record filed in said cause shows that the purported evidence and testimony purporting to have been taken on the trial of said cause before the District Court was not approved by the Court or Judge before whom said cause was tried and was not signed, certified to or authenticated by said Court or Judge, and was never filed with such approvel, certification or authentication in the office of the Clerk of said District Court, and never became a part of the record in said cause for the purposes of the appeal herein; all as required by Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof, said purported proceedings, evidence and testimony should be stricken from the said purported transcript of record and disregarded and not considered by this Court, and because and in consequence thereof also the decree of said District Court entered on February 20, 1917, appearing on page 1217 of said purported transcript of record, and said purported proceedings, evidence and testimony, is not subject to review by this Court.

Wherefore, appellee prays that said purported proceedings, evidence and testimony be stricken from the purported transcript of the record filed herein, and that the Court do not consider or review the same, or said decree of said District Court of February 20, 1917.

A. F. Reichmann, Frank L. Belknap and Walter M. Allen, Solicitors for Appellee.

[fol. 4969] In United States Circuit Court of Appeals

[Title omitted]

Objections to Motion for Separate Hearings—Filed November 9, 1925

Comes now Standard Asphalt & Rubber Company, Appellee, in response to the notice of motion to appellant to separate and divide the argument on the issues of said appeal and to separately hear and decide the issues of title and validity of the patents in suit, and infringement, etc.,

and shows to the Court here the following reasons why said motion should be denied and overruled:

1. The decree of the District Court adjudicating and decreeing the title of the patents in suit in plaintiff, and the validity of said patents, and the infringement thereof by appellant, was entered on February 20, 1917, as appears on pages 1217 to 1219 inclusive of the purported transcript of the record filed herein, and no appeal was ever prayed or taken from said decree within the time fixed and limited by law, and because and in consequence thereof said decree became final and conclusive, and is not now the subject matter of appeal and review by this Court.

2. The petition of defendant for appeal filed in the office of the Clerk of said District Court on July 1, 1924, and the prayer of defendant for the reversal of the decree, appearing on pages 4678 and 4679 of the purported transcript of the record filed herein, prayed an appeal from, and reversal of, the decree of said District Court of April 30, 1924, appearing on page 4676 of said purported transcript, overruling the exceptions to the Master's Report filed therein, and approving and confirming said Master's Re-[fol. 4970] port and entering judgment in favor of plaintiff and against defendant in the sum of $650,044.83, together with interest thereon from January 6, 1921, until paid, and the costs and disbursements of plaintiff, and said prayer for appeal and for reversal of decree did not pray, or operate to pray, an appeal from, or reversal of, the decree of February 20, 1917, and because and in consequence thereof an appeal from said decree of February 20, 1917, has never been prayed, taken or perfected, and said decree is now final and conclusive, and not the subject matter of appeal to, or review by, this Court.

3. The purported transcript of the record filed in said cause shows that the purported evidence and testimony purporting to have been taken on the trial of said cause before the District Court was not approved by the Court or Judge before whom said cause was tried and was not signed, certified to or authenticated by said Court or Judge, and was never filed with such approval, certification or authentication in the office of the Clerk of said District Court, and never became a part of the record in said cause

for the purposes of the appeal herein; all as required by Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof said purported evidence and testimony should be stricken from the said purported transcript of record and disregarded and not considered by this Court, and because and in consequence thereof also the decree of said District Court entered on February 20, 1917, appearing on page 1217 of said purported transcript of record, and said purported evidence and testimony, is not subject to review by this Court.

4. The purported evidence appearing in the purported transcript of the record filed herein is not stated in simple and condensed form and the purported testimony of witnesses is not stated in narrative form, but on the contrary thereof, said purported evidence and testimony is set forth in full, all contrary to Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof all of said evidence and testimony should be stricken from the purported transcript of the record in said cause and disregarded by this Court.

5. No reason or ground for said motion is shown in support of said motion, nor is it made to appear why said issues cannot and should not be presented and argued separately in the brief and argument of Appellant on the whole case, so that this Court may consider and review said cause in [fol. 4971] the order suggested by Appellant, and thereby accomplish the end suggested by Appellant.

6. The decree appealed from in this cause was entered on April 30, 1924, and the purported transcript of record therein was not filed in the office of the Clerk of this Court until July 3, 1925, and because and in consequence thereof the appeal and hearing of this cause has been long and unduly delayed and Appellee thereby injured and the granting of said motion may further unduly and injuriously delay the final determination and disposition of this case in this Court in the event that the decree of the District Court of February 20, 1917 should be reviewed by this Court, and upon such review should be affirmed, for in that, upon such affirmance, further time would be asked and necessary to file further and additional briefs on the part of both

Appellant and Appellee on the issues of the accounting in said cause.

7. The saving of expense to Appellant in the preparation and printing and filing of its brief and argument herein in support of its appeal is not sufficient or proper ground for said motion.

Wherefore, appellee says said motion of appellant should be denied and overruled.

A. F. Reichmann, Frank L. Belknap and Walter M. Allen, Solicitors for Appellee.

[File endorsement omitted.]

[fols. 4972-4977] In United States Circuit Court of Appeals

[Title omitted]

Order Denying Motion for Separate Hearings—November 9, 1925

Now this day come the parties by their counsel, and counsel for appellant presents a motion to separate and divide the argument on the issues raised on this appeal, and the court having heard the same, it is now here ordered that this motion be, and the same is hereby denied.

It is further ordered that the brief for appellant on the questions of title validity and infringement be filed as required by the rules of this court, and that the brief of appellant on the question of accounting be filed ten (10) days thereafter.

It is further ordered that the brief for appellee on the questions of title, validity and infringement be filed thirty (30) days after the filing of appellant's brief on those questions, and brief for appellee on accounting forty-five (45) days after the filing of brief for appellant on this question, the reply briefs for appellant to be filed within fifteen (15) days from the date of filing appellee's briefs.

It is further ordered that this cause be placed on the calendar of the January Session of the October Term, 1925,

and that the motion of appellee to strike portions of the record be, and the same is hereby continued to the hearing on the merits of this cause.

[fol. 4978] In United States Circuit Court of Appeals

[Title omitted]

Motion for Order Remitting Certified Transcript of Record to District Court for Permitting Certificate of Evidence—Filed January 4, 1926

Now comes The Barber Asphalt Paving Company, Appellant, in the above entitled cause by Henry N. Paul and John B. Macauley, its solicitors, and moves the Court for an order remitting the certified transcript of the record in this case as filed herein on July 3, 1925, to the District Court for the purpose of permitting said Court to append its Certificate of Evidence to that part of the record which sets forth the testimony and other evidence and proceedings had and taken before the said District Court on the trial of said cause constituting pages 24 to 1215 and also pages 1223 to 1577 of the printed record, as it has been certified to this Court by the Clerk of said Court under the seal of said Court; and to direct that, when said Certificate of Evidence has been signed by the Judge of the Court, said transcript be forthwith returned to this Court with the same force and effect as though said Certificate of Evidence duly signed had formed part of the transcript, as originally filed in this Court; and that meanwhile this Court retain jurisdiction of this appeal, which is not dismissed hereby, nor by any acts to be taken in accordance herewith, and this cause hold its place upon the argument list of the Court, and that the orders heretofore made in this Court for the filing of briefs, preparatory to the argument of the cause, remain in force notwithstanding the granting of this remittitur; all for the following reasons and upon the following grounds to wit:

1. The interlocutory decree of this Court, adjudicating the issues of the trial, and awarding an accounting before a [fol. 4979] master, was made by the Hon. J. O. Humphrey,

Judge, on January 17, 1917, but the patents in suit having expired, no injunction was ordered, and consequently no appeal could then be taken to this Court from such interlocutory decree.

2. The Master's report was filed January 6, 1921. He certifies in his report (p. 3594) that "no unnecessary time was lost in the presentation of the facts of the case." Exception to the Master's report were filed and were argued before the Court on May 2, 1921. The opinion of the Court dismissing the exceptions to the Master's report and confirming the report and its findings, was filed March 14, 1924, and the final decree in this cause was entered thereupon on April 30, 1924. Defendant's appeal was promptly taken and duly allowed July 1, 1924.

3. Until July 1, 1924, there was no Appellant, and accordingly, no one upon whom Rule 75 of the Supreme Court Equity Rules cast the duty of condensing the evidence as taken at the trial. In the meantime, on June 14, 1918, Judge Humphrey died, and in view of the nature of the controversies at the trial, and the conflicting views of the parties upon many points, it was not feasible to attempt to settle a condensed statement of the evidence before a Judge not thoroughly familiar with the trial of the cause, and accordingly, it was deemed best to ask the Clerk of the Court to certify the stenographer's notes of the testimony and proceedings at the trial as already filed of record in the cause.

From said notes it appears (p. 25) that counsel for both sides agreed with Judge Humphrey in open court at the outset of the trial that the reporter's transcript should be "accepted as true and correct unless error clearly appears."

4. At the time of the filing of the præcipe directing the Clerk of the District Court which parts of the record should be certified for use on appeal, Rule 14 of this Court (adopted October 6, 1925) had not been adopted, and Appellant's counsel were not aware of any requirement that the stenographer's notes of testimony at the trial should be "signed by the Judge who tried the cause." Nevertheless, in said præcipe, the Clerk of the District Court was requested to return to this Court a "Certificate of Evidence," consist-

ing of the printed pages of the record and exhibits therein referred to; but whether owing to uncertainty as to the requirement for a Judge's signature, or owing to the fact of the death of the Judge before whom the cause was tried, no certificate was signed by the Court or transmitted by the Clerk in obedience to the præcipe.

[fol. 4980] 5. A printed copy of the record in this cause as certified to this Court was served upon Appellee's counsel on April 24, 1925, but no exception was taken by Appellee's counsel to the omission of the Judge's certificate, nor was it in any way called to the attention of Appellant's counsel, nor known to them, until November 7, 1925, when there was served upon the solicitors for Appellant a notice of a motion to strike from the transcript of the record in this cause all that appears from pages 18 to 1577 of the transcript for the following reasons inter alia to wit: that the transcript shows that the "evidence and testimony taken at the trial before the District Court was not approved by the Court or Judge before whom said cause was tried, and was not signed, certified to or authenticated by said Court or Judge, and was never filed with such approval, certification or authentication in the office of the Clerk of the said District Court, and never became a part of the record in said cause for the purposes of the appeal herein."

6. At the hearing of this motion, on November 9, 1925, this Court ordered that the motion be continued and set for argument at the time of the argument of the appeal, which it is understood will be some time in April 1926.

7. This motion, and the grounds upon which it rests, were a surprise to Appellant's solicitors. They believe that a proper certification of the testimony and evidence may be had if this Court will permit and direct the transcript of the record now on file herein to be remitted to the District Court for this purpose.

It will not be possible, nor would it ever have been possible, to comply literally with Rule 14, because the Judge who tried the cause had died before the appeal was allowed; but it is believed that substantial compliance may be had by requesting the present Judge of said District Court to

sign a sufficient certificate that the stenographer's transcript is true and complete, and therefore approved by the Court or Judge which appears to be all that is required by Rule 75 of the equity rules of the Supreme Court.

It is believed that the remission of the transcript, and the securing of such certificate and its return to this Court, will be a matter of such short time as to in no wise delay the argument of this appeal.

8. For the complete preservation of Appellant's rights, it is requested that the order to be made by this Court expressly provide that the Certificate of Evidence and the entire transcript, when returned, be received and filed [fol. 4981] herein with the same force and effect as though it had been filed on July 3, 1925, being the date of the receipt of the original transcript.

Henry N. Paul, John B. Macauley.

[File endorsement omitted.]

In United States Circuit Court of Appeals

[Title omitted]

Order Setting Hearing—January 8, 1926

Now this day comes Mr. John B. Macauley and Mr. Henry N. Paul, Counsel for Appellant, and present a motion that the transcript of record filed in this cause be remitted to the District Court of the United States for the Southern District of Illinois, Southern Division, for the purpose of having appended to same a certificate of evidence.

It is now here ordered that the hearing on this motion be, and the same is hereby set down for January 29, 1926.

It is further ordered that the appellant may file a brief on [fol. 4982] said motion within seven (7) days from this date, and that appellee may file a reply thereto within seven (7) days thereafter.

IN UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

STIPULATION RE EXTENSION OF TIME—Filed January 9, 1927

It is hereby stipulated and agreed by and between counsel for the respective parties in the above entitled cause that the time of the appellant for the filing of its brief upon appellant's motion for an order remitting the certified copy of transcript of record to the District Court for permitting certificate of evidence, which motion is now set for hearing on January 29, 1926, be extended to the morning of Monday, January 18th, and that the time of appellee for filing its brief upon such motion be extended to Tuesday, January 26th, the time of said hearing remaining unchanged; and that an order of the Court be entered in accordance with this stipulation.

John B. Macauley, Solicitor for Appellant. Judah, Willard, Wolf & Reichmann, Solicitors for Appellee.

Chicago, Illinois, January 9, 1926.

Order as per Stipulation. Alschuler.

[File endorsement omitted.]

[fol. 4983] IN UNITED STATES CIRCUIT COURT OF APPEALS

ORDER EXTENDING TIME

[Title omitted]

Saturday, January 9, 1926.

Upon the filing of a stipulation of counsel, it is ordered that the time for filing brief for appellant on motion to remit the record in this cause to the District Court be, and the same is hereby extended to January 18, 1926, and that the time for appellee to file a brief in reply thereto, be, and the same is hereby extended to January 26, 1926.

[fol. 4984] Saturday, January 16, 1926.

On motion of counsel for appellee, it is ordered that the time for filing brief for appellee in this cause on the questions of title, validity and infringement be, and the same is hereby extended to and including February 15, 1926.

IN UNITED STATES CIRCUIT COURT OF APPEALS

ADDITION TO NOTICE AND MOTION

And afterwards, to wit: On the eighteenth day of January, 1926, there was filed in the office of the clerk of this court twenty printed copies of the Notice and Motion heretofore filed in this cause on January 4, 1926, and in addition to said Notice and Motion said printed copies contained the following:

On January 8, 1926, when the foregoing Motion was presented to the Court, it was ordered that Counsel should file Briefs thereupon, the Motion to be heard on January 29, 1926, at 9.30 A. M.

Appellant's Counsel now gives notice that at said hearing we shall move to add to the Motion on page 2, line 12, after the words "under the seal of said Court," the following words,—

"and for such further amendment, correction or amplifi-[fol. 4985] cation as the District Judge, may upon his attention being brought to the matter, see fit to make respecting the certification of the record; and also to enable the Clerk to add to the certified transcript a certified copy of the file marks upon the original stenographer's transcript of the proceedings at the trial as filed by the District Judge and referred to by him in his interlocutory decree of February 20, 1917; and also to obtain certification of certain printed copies of the specifications and drawings of four U. S. Patents as filed with the accounting master which are appended to the printed transcript in this case" (pages 4885 to 4907).

IN UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

ORDER REMITTING TRANSCRIPT—January 29, 1926

Upon the presentation of the motion for an order remitting the certified transcript of record in this cause to the District Court of the United States for the Southern District of Illinois, Southern Division, for the purpose of per-
[fol. 4986] mitting said court to append its certificate of evidence to that part of the record which sets forth the testimony and other evidence and proceedings had and taken before the said District Court on the trial of said cause, it is ordered by the court that this motion be, and the same is hereby granted.

It is further ordered that the clerk of this court be directed to remit the certified transcript of the record in this case to the District Court of the United States for the Southern District of Illinois, Southern Division, for the purpose of presenting to said court appellant's request that the court append its certificate of evidence to that part of the record which sets forth the testimony and other proceedings had and taken before the said District Court on the trial of said cause; and for such further amendment, correction or amplification as the District Judge may, upon his attention being brought to the matter, see fit to make respecting the certification of the record; and also to enable the clerk to add to the certified transcript a certified copy of the file marks upon the original stenographer's transcript of the proceedings at the trial as filed by the District Judge and referred to by him in his interlocutory decree of February 20, 1917; and also to obtain certification of certain printed copies of the specifications and drawings of four U. S. Patents as filed with the accounting master which are appended to the printed transcript in the case (pages 4885 to 4907); and it is further ordered that when said certificate of evidence has been signed by the judge of the court and affiexd to the transcript, said transcript be forthwith returned to this court, and it is further ordered that meanwhile this court retain jurisdiction of this appeal, which is not dismissed hereby, nor by any acts to be taken in accordance herewith, and that the case hold its place upon

the argument list of the court, and that the stipulations and orders heretofore made in this court for the filing of briefs for the argument of the cause remain in force notwithstanding the granting of this remittitur.

It is further ordered that the effect and validity of such certificates if obtained, shall be reserved for final determination of this cause.

[fols. 4987 & 4988] And afterwards, to wit: On April 10, 1926, the transcript of record in this cause, which had been remitted to the District Court pursuant to the order of this court entered on January 29, 1926, was returned to the files of this court, together with a supplemental transcript of record, which said supplemental transcript of record was filed on April 10, 1926 and is not copied here as the same appears on pages 4909 to 4959 inclusive, of the Printed Record in this cause as Volume X certified herewith.

[fol. 4989] In United States Circuit Court of Appeals

[Title omitted]

Suggestions for Dismissal.—Filed October 6, 1926

Comes now Standard Asphalt and Rubber Company, Appellee, and shows to the Court that the appeal herein should be dismissed for the following reasons and upon the following grounds, to wit:

1. That the appeal from the decree of title, validity and infringement should be dismissed for all the reasons heretofore set forth in Appellee's motion to dismiss said appeal filed herein on November 2, 1925.

2. That said appeal from the decree on title, validity and infringement should be dismissed for the further reason that the purported order of his Honor, Judge FitzHenry, entered on March 30, 1926, as set forth in the Supplemental Transcript of Record filed herein on April 13, 1926, at pages 4913-4915, was entered without power, authority or jurisdiction, and is void, and also that said purported order does not amount to, or constitute a certification of the al-

leged evidence taken on the trial of the issues of title, validity and infringement, and that said alleged evidence purporting to be set forth in the purported transcript of the record filed herein, on pages 18 to 1577, inclusive, has never been certified to by the District Court, and has never been or become a part of the record in said cause, all as required by law.

3. That said appeal from the decree on title, validity and infringement should be dismissed for the further reason that it affirmatively appears from the transcript of the record on file in this cause that all of the evidence purporting to have been taken on the trial of said issues has never been certified to by the District Court, and has never been filed in the office of the Clerk of this Court, for in that it appears from said purported transcript of the record that 14 exhibits offered by Appellee and received in evidence on the trial of said cause, out of a total of 26 exhibits so offered by Appellee and received in evidence, have not been made a [fol. 4980] part of the transcript of the record filed in this cause, nor certified to by the District Judge, nor filed in this Court; and that 20 exhibits offered by Appellant and received in evidence on the trial of said cause, out of a total of 41 exhibits so offered by Appellant and received in evidence, have not been made a part of the transcript of the record filed in this cause, nor certified to by the District Judge, nor filed in this Court; and that 9 exhibits offered by Appellant and received in evidence on the trial of said cause Appellant filed in the office of the Clerk of this Court on September 30, 1926, but without having attached thereto or connected therewith, directly or indirectly, any certificate of the District Court, but attached thereto merely a purported certificate of the Clerk of said District Court; and that because and in consequence thereof said 9 alleged exhibits have never been made a part of the record filed in this cause, and cannot within the law be taken cognizance of or considered by this Court on this appeal.

4. That said appeal from the decree on the accounting issues should be dismissed for the further reason that it affirmatively appears from the transcript of the record on file in this cause that all of the evidence purporting to have been taken on the trial of said accounting issue has never

been certified to by the District Court, and has never been filed in the office of the Clerk of this Court, for in that it appears from said purported transcript of the record that 48 exhibits offered by Appellee and received in evidence on the trial of said cause, out of a total of 82 exhibits so offered by Appellee and received in evidence, have not been made a part of the transcript of the record filed in this cause, nor certified to by the District Judge, nor filed in this Court; and that 33 exhibits offered by Appellant and received in evidence on the trial of said accounting issues, out of a total of 47 exhibits so offered by Appellant and received in evidence, have not been made a part of the transcript of the record filed in this cause, nor certified to by the District Judge, nor filed in this Court.

5. That out of a total of 196 exhibits offered by Appellee and Appellant and received in evidence on the trials of the titles, validity and infringement issues and on the accounting issues of said cause, 114 thereof have not been certified to by the District Judge nor made a part of the transcript of the record filed in this cause nor filed in this Court, and Appellee attaches hereto statements of such exhibits with the pages of the purported transcript of the record showing where each of said exhibits was offered and received in [fol. 4991] evidence and showing which of said exhibits have been incorporated in the purported transcript of the record on file in this cause and which have not been so incorporated and have never been certified to, made a part of the record in this cause nor filed in this Court.

IN UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

MINUTE ENTRY OF MOTION TO DISMISS—October 6, 1926

Now this day come the parties by their counsel, and counsel for appellee presents a motion that this appeal be dismissed, and the court having heard the oral arguments of Mr. A. F. Reichmann, counsel for appellee, in support of said motion, and by Mr. Charles Neave, counsel for appellant, in opposition thereto, takes this matter under advisement.

In United States Circuit Court of Appeals

Minute Entry of Submission—October 6, 1926

Now this day come the parties by their counsel, and this cause now comes on to be heard on the printed record and briefs of counsel and on oral arguments by Mr. Charles Neave and Mr. Henry N. Paul, counsel for appellant, and by Mr. A. F. Reichmann, counsel for appellee, and the court having heard the same takes this matter under advisement.

[fol. 4992] In United States Circuit Court of Appeals for the Seventh Circuit, October Term and Session, 1926

No. 3614

Barber Asphalt Paving Company, a Corporation, Appellant,

vs.

Standard Asphalt & Rubber Company, a Corporation, Appellee

Appeal from the District Court of the United States, for the Southern District of Illinois, Southern Division

Opinion—Filed December 13, 1926

Before Evans, Page, and Anderson, Circuit Judges

Opinion by Page, Cir. J.:

The suit by appellee, called plaintiff, against appellant, called defendant, charged infringement of Culmer Patents Nos. 635429 and 635430. Judge Humphrey's decree, filed February 20, 1917, found infringement, ordered an accounting, and appointed a master to make an accounting. As the patents had expired, no injunction was ordered.

Judge Humphrey died in June, 1918. Judge FitzHenry, on April 30, 1924, entered a final decree on the accounting in favor of plaintiff. July 1, 1924, appeal was allowed, assignments of errors filed, and citation issued. Super-

sedeas bond was filed July 5, 1924. On defendant's request, twelve thirty-day extensions of time for filing the record in this court were allowed, the last one expiring July 26, 1925.

On April 24, 1925, nearly 300 days after the citation, defendant served upon plaintiff a præcipe, in part as follows:

"Please prepare a transcript of the record in the above [fol. 4993] entitled cause for use on appeal, including therein copies of the following: * * * Certificate of evidence, consisting of printed pages 24 to 1215, inclusive, pages 1222 to 4591, inclusive, and the following exhibits * * *."

Preceding that item, were requests for the pleadings and some other items. Following it, was a request for a portion of the exhibits. No condensed statement of the evidence was filed.

June 24, 1925, two days before the expiration of the last extension, the clerk of the District Court attached his certificate to the record. On July 3, 1925, one copy of the record was filed in this court. The required number of copies were filed November 2, 1925.

November 9, 1925, plaintiff moved to dismiss the appeal because no proper record had been filed here, one reason being that there was no certificate of evidence as required by Equity Rule 75. Sixty days thereafter, defendant moved to remit the record to the District Court for its certificate and for other purposes. January 29, 1926, that motion was allowed.

April 13, 1926, two years after the final decree, the District Court's certificate to the record was filed here.

As originally filed, the record, of nearly 5,000 pages, was printed in nine volumes, apparently containing everything in the proceedings in the court below. Nothing was eliminated, nothing condensed. The court's belated certificate neither required nor made any change in the record already here, except in two particulars,—it did not certify, but directed the clerk of the District Court to certify, certain exhibits, which were already in the record, and to amend the record and add "any file marks appearing upon the original stenographer's transcript, etc." The clerk complied with the first direction, but we are unable to determine whether

or not he complied with the second. The court ordered, as a part of his certificate:

"Upon the request of the said defendant * * * the court hereby directs that all the testimony in this cause be reproduced in the exact words of the witnesses, and not in narrative form."

The record is here, with the judge's certificate added, just as it came originally, except that the four exhibits, directed to be added by the clerk, are now in the record twice.
[fol. 4994] Plaintiff is insisting on its motion to dismiss for failure to comply with Equity Rule 75.*

Fourteen years ago, the Supreme Court, approving a record in a case then before it, said it was in compliance with the spirit of Rules 75, 76 and 77,

"which call for just such a winnowing out of the useless; the presentation of only the relevant parts of the exhibits,

*75. Record on Appeal—Reduction and Preparation. In case of appeal (a) It shall be the duty of the appellant or his solicitor to file with the clerk of the court from which the appeal is prosecuted, together with proof or acknowledgment of service of a copy on the appellee or his solicitor, a praecipe which shall indicate the portions of the record to be incorporated into the transcript on such appeal. Should the appellee or his solicitor desire additional portions of the record incorporated into the transcript, he shall file with the clerk of the court his praecipe also within ten days thereafter, unless the time shall be enlarged by the court or a judge thereof, indicating such additional portions of the record desired by him.

(b) The evidence to be included in the record shall not be set forth in full, but shall be stated in simple and condensed form, all parts not essential to the decision of the questions presented by the appeal being omitted and the testimony of witnesses being stated only in narrative form, save that if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness. The duty of so condensing and stating the evidence shall rest primarily on the appellant, who shall prepare his statement thereof and lodge the same in the clerk's office for the examination of the other parties at or before the time of filing his praecipe under paragraph (a) of this rule. He shall also notify the other parties or their solicitors of such lodgment and shall name a time and place when he shall ask the court or judge to approve the statement, the time so named to be at least ten days after such notice. At the expiration of the time named or such further time as the court or judge may allow, the statement, together with any objections made or amendments proposed by any party, shall be presented to the court or the judge, and if the statement be true, complete and properly prepared, it shall be approved by the court or judge, and if it be not true, complete or properly prepared, it shall be made so under the direction of the court or judge and shall then be approved. When approved, it shall be filed in the clerk's office and become a part of the record for the purposes of the appeal.

(c) If any difference arise between the parties concerning directions as to the general contents of the record to be prepared on the appeal, such difference shall be submitted to the court or judge in conformity with the provisions of paragraph (b) of this rule, and shall be covered by the directions which the court or judge may give on the subject.

documents, tables, and reports; and the elimination of all reduplications in written and oral testimony and a condensation into narrative form of what is material to the then issue before the court." (Louisville & Nashville R. R. Co. v. U. S., 238 U. S. 11.)

Since then, the Supreme Court and many Courts of Appeal have pointed out the purpose of the rule and the necessity of observing it, but the condition of this record and of numerous other records before us at this term indicates [fol. 4995] that transition from the old practice to that under Rule 75 has been neither accomplished nor commenced.

By order of the Supreme Court, the rule became effective February 1, 1913. In 1914, the Sixth Circuit Court of Appeals, in Re General Equity Rule 75 and Our Rule 15, 222 Fed. 884, held that: without an order made at the term decree is entered, carrying the matter over to the next term, the court has the power, at a subsequent term, to approve and direct the filing of the statement of evidence required by Rule 75 (See also Goodwin v. U. S., 295 Fed. (6th C. C. A., 1924) 856); that the perfection of the appeal by the approval of the bond and signing of citation yet leaves in the court the jurisdiction to settle the evidence, that proceeding being ministerial; that where the rule is wholly disregarded, the drastic remedy of dismissal may be necessary; and, where the record reaches the court containing the evidence in full, general equity Rule 76 provides a remedy which, at least during the transition in general practice, will be sufficient. Strnett v. Hill, 269 Fed. (9th C. C. A., 1920) adopted and followed the above practice. Sussex Land & Livestock Co. v. Midwest Refining Co., 294 Fed. (8th C. C. A., 1923) 597, 600, followed the Sixth and Ninth Circuit holdings, supra. The rule was before the court, in an incidental way, in U. S. v. Great Northern Ry. Co., 254 Fed. 522, 526 (9th C. C. A.) in 1918. In Carson v. Hunt, 250 Fed. (5th C. C. A., 1918) 30, 33, where a statement of the evidence was prepared by the parties but not approved by the court and there was nothing to show that it contained all the evidence, the court said it would be presumed that there was other evidence in the record to support the decree.

In Buessel v. U. S., 258 Fed. (2nd C. C. A., 1919), 811, 822, the equity practice prior to the rule is reviewed. The court said:

"Whatever may or may not have been the practice in this circuit prior to 1912 in the matter of preparing the record in an appeal, the subject is governed by rules 75, 76, and 77, as framed by the Supreme Court, and that there is no power in this court to exempt a particular case from their operation. The rules, having been promulgated under the authority of an act of Congress, have the authority of statutory regulation. Winter v. Ludlow, 104 Fed. Cas. No. 17,891."

The court further said:

"As the testimony in the transcript in this case is not there in conformity to Rule 75 we cannot consider it."

[fol. 4996] In Buckeye Cotton Oil Co. v. Ragland, 11 Fed. (2d) (5th C. C. A., 1926) 231, 232, the court said:

"We are of opinion that equity rule 75 does not contemplate that the trial court will order all the testimony in a case sent up in question and answer form. If particular answers of a witness are subject to different interpretations, the questions which elicited such answers frequently aid in determining which interpretation is correct. For that reason the rule provides, by way of exception, 'that if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness.' The rule was designed to prevent the imposition of such a record as this upon an appellate court. Newton v. Consolidated Gas Co., 258 U. S. 165, 42 S. Ct. 264, 66 L. Ed. 538; Houston v. Telephone Co., 259 U. S. 318, 42 S. Ct. 486, 66 L. Ed. 961. * * * We will not enforce the rule in this case, but only for the reason that counsel might have construed the order allowing the appeal to authorize the record in its present shape."

In Re Jewell Electrical Instrument Co., 283 Fed. (7th C. C. A., 1922) 978, 980, this court said:

"It is needless to test whether appellant's proposition is sustained by its citations of Conn v. Penn, 5 Wheat. 424, Blease v. Garlington, 92 U. S. 1, and First Nat. Bank

v. Abbott, 165 Fed. 852, under former rules, for under present equity rule 46 respecting oral testimony in open court and equity rule 75, concerning an appellant's duty to procure the trial judge's certification of the evidence (like a bill of exceptions on the law side) and his duty to file it with the clerk of the trial court and his duty to include within his præcipe those portions of the record which establish the existence of error in the decree, there is no room for contending that error must be presumed."

In Newton v. Consolidated Gas Co., 258 U. S. 165, 173 (1911) the court said, in part:

"Equity Rules 75 and 76 direct that records on appeal shall not set forth the evidence fully but in simple condensed form and require omission of non-essentials and mere formal parts of documents. Without apparent attempt to comply with these rules and with assent of appellee's counsel, appellants in No. 257 have filed a record of 21 volumes—twenty thousand printed pages—made up largely [fol. 4997] of stenographic reports of proceedings before the Master with hundreds of useless exhibits and many thousand pages of matter without present value. This is indefensible practice which we shall hereafter feel at liberty to punish to the limit of our discretion—possibly by dismissal of the appeal. These rules were intended to protect the courts against useless, burdensome records and litigants from unnecessary costs and delay. Counsel ought to comply with them, and trial courts should enforce performance of this plain duty."

See also Peterson v. Mobile Gas Co., 271 U. S. 131.

In Houston v. Southwestern Tel Co., 259 U. S. 318, 325 (1921), the court said:

"Equity rule No. 75 provides that evidence to be included in the record shall not be set forth in full but shall be stated in a simple and condensed form, and Rule 21 of this court provides that briefs of the argument shall be filed in each case, with references to the pages of the record and the authorities relied upon in support of each point. The first of these rules has been wholly ignored in the printing of this record and the second has been so neglected in the preparation of the briefs that it is impossible for the

court to consider this question except by itself reading and briefing the voluminous record. This we cannot consent to do, and for the reason that the record and briefs are not prepared in conformity with the rules prescribed by this court, we decline to consider this assignment of error."

Outstanding provisions of the rule are that: (a) all parts of the evidence not essential to the decision presented by appeal shall be omitted; (b) the evidence shall not be set forth in full, but shall be stated in condensed form; (c) testimony of witnesses shall be stated only in narrative form, save that the court may direct any part of the testimony to be reproduced in the exact words of the witness; (d) the burden of preparing the statement of the evidence, filing it with the clerk at or before the time of filing the praecipe, notifying the appellee and fixing a date for hearing before the judge, are placed on the appellant; (e) when the parties and the court have made up a statement that is "true, complete and properly prepared," the court is empowered and required to approve it. Excuse for not complying with (a), (b) and (c) is not attempted. For failure, during the two years between the final decree and the District Court's certificate, to [fol. 4998] comply with (d) no reason is offered. Since then it is urged that the court ordered as follows:

"Upon request of said defendant * * * the court hereby directs that all the testimony in this cause be reproduced in the exact words of the witnesses."

It is not within the power of the District court or judge to make such an order. The order is not in harmony with the spirit of Rule 75. The equity rules have the force of statutory enactments. Buessel v. U. S., supra. The duty of the court or judge in connection with the preparation of the statement is set out in the rule. The only power of approval vested in the court is found in the following language of the rule:

"If the statement" (when presented) "be true, complete and properly prepared, it shall be approved by the court or judge."

That must mean that it shall comply with the rule.

In a proper statement, the evidence: (a) must be condensed; (b) all parts not essential to a decision of the ques-

tions on appeal shall be omitted; and (c) the testimony of witnesses must be stated in narrative form only, with the single exception,

"That if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness."

That provision means that when the court or judge, being familiar with the evidence, finds that to properly present the questions on appeal it is desirable that a part of the testimony of a witness shall be reproduced in his exact words, he may so direct. It is not within the purpose and spirit of the rule to put in a statement the whole of the testimony of any witness or of all the witnesses.

No question raised by the errors assigned can be determined without a consideration of the evidence, and, it not being properly before us, the decree is affirmed.

[fols. 4999 & 5000] In United States Circuit Court of Appeals

[Title omitted]

Judgment—December 13, 1926

This cause came on to be heard on the transcript of the record from the District Court of the United States for the Southern District of Illinois, Southern Division and was argued by counsel.

On consideration whereof: It is now here ordered, adjudged and decreed by this court that the decree of the said District Court in this cause be, and the same is hereby affirmed with costs and interest until paid at the same rate that similar judgments bear in the courts of the State of Illinois.

And afterwards, to wit: On the thirty-first day of December, 1926, there was filed in the office of the clerk of this court a certain Petition for Rehearing and Motion to Vacate Order and Direct Condensation of the Record, which said Petition and Motion are in the words and figures following, to wit:

IN THE

United States Circuit Court of Appeals

FOR THE SEVENTH CIRCUIT.

THE BARBER ASPHALT COMPANY, *Appellant.* *vs.* STANDARD ASPHALT AND RUBBER COMPANY, *Appellee.*	No. 3614.

PETITION FOR REHEARING.

To the Honorable the Judges of United States Circuit Court of Appeals for the Seventh Circuit.

And now this 31st day of December, 1926, comes the appellant, The Barber Asphalt Paving Company, and prays this court:

(a) To reconsider and decide this cause upon the merits; or

(b) To grant a hearing upon the reasons and grounds which have led this court to declare in its opinion filed December 13, 1926, that the evidence in this cause is not properly before the court, there being before this court no motion raising this question, and no hearing having yet been had upon it; and

(c) To make an order directing the lower court to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of the evidence in simple and condensed form; and

(d) Upon being advised that this has been done to thereupon issue a writ of certiorari to the lower court

to bring up to this court such simple and condensed statement as a part of the record on appeal; and

(e) To make such orders in relation to the transcript of the evidence which is now before this court as may seem right and necessary and just in this cause;

(f) That pending the further order of this court the mandate be withheld.

All for the following reasons:

1. There has been no motion by appellee in this case to dismiss this appeal because the record has not been condensed, although this court in its opinion seems to have based its action upon a belief and statement that such a motion exists.

2. This court after having the record before it ordered it sent down to the lower court in order that it might be returned with a certificate of evidence without ordering or suggesting that the record ought to be condensed.

3. The decree in this court involves the sum of nearly a million dollars, and it is not just that defendant in this case should be penalized in this sum because there was not strict conformity to a rule of practice upon a point on which this court has for fourteen years permitted such nonconformity, as counsel believed because the court so wished it.

4. A majority of the Circuit Courts of Appeal have after a fair trial of the rule requiring condensation of record found it difficult of application in certain classes of cases, and have thought it undesirable to apply the rule too strictly, and have sanctioned liberality of construction of the language "any part of the testimony." The views of the judges of these courts upon this point have been well known to the patent bar and have been reflected in a practice which in those circuits

has made condensation of the record the exception rather than the rule. Appellant's counsel in the present case had every reason to believe, and did believe, that this court shared the view of these other Circuit Courts of Appeal and would adhere to its similar practice, and that in obtaining certification of a complete transcript of the evidence such counsel were only doing that which was in accordance with the long recognized practice of this court. And it is believed that this court should have made some announcement of its change of practice before imposing the penalty of dismissal.

5. The holding by this court that courts are without power to direct the sending to the Appellate Court of an uncondensed transcript, and that if they do so the transcript must be ignored and the appeal dismissed, is a dangerous limitation upon the powers of the court, and a violation of the letter and spirit of Section 269 of the Judicial Code as amended February 26, 1919, subsequent to the promulgation of Equity Rule 75.

6. As the transcript now stands this court has before it in a separate exhibit book the documents upon which plaintiff has rested its proof of title, which title is denied by the defendant. There is no testimony on this issue, and therefore nothing to simplify or condense, and this court should under its present ruling have passed upon this question of title, even if the other issues are not now properly before the court.

7. Now that the desires and position of this court have been made clear by the opinions of this court filed in this and other causes, counsel in this case, and doubtless in all others, know what to do and will earnestly strive to comply with the rule. In the present case the work of preparing a condensed and simplified transcript was begun immediately upon the filing of the opinion in this case and is proceeding as rapidly as feasible.

to bring up to this court such simple and condensed statement as a part of the record on appeal; and

(e) To make such orders in relation to the transcript of the evidence which is now before this court as may seem right and necessary and just in this cause;

(f) That pending the further order of this court the mandate be withheld.

All for the following reasons:

1. There has been no motion by appellee in this case to dismiss this appeal because the record has not been condensed, although this court in its opinion seems to have based its action upon a belief and statement that such a motion exists.

2. This court after having the record before it ordered it sent down to the lower court in order that it might be returned with a certificate of evidence without ordering or suggesting that the record ought to be condensed.

3. The decree in this court involves the sum of nearly a million dollars, and it is not just that defendant in this case should be penalized in this sum because there was not strict conformity to a rule of practice upon a point on which this court has for fourteen years permitted such nonconformity, as counsel believed because the court so wished it.

4. A majority of the Circuit Courts of Appeal have after a fair trial of the rule requiring condensation of record found it difficult of application in certain classes of cases, and have thought it undesirable to apply the rule too strictly, and have sanctioned liberality of construction of the language "any part of the testimony." The views of the judges of these courts upon this point have been well known to the patent bar and have been reflected in a practice which in those circuits

has made condensation of the record the exception rather than the rule. Appellant's counsel in the present case had every reason to believe, and did believe, that this court shared the view of these other Circuit Courts of Appeal and would adhere to its similar practice, and that in obtaining certification of a complete transcript of the evidence such counsel were only doing that which was in accordance with the long recognized practice of this court. And it is believed that this court should have made some announcement of its change of practice before imposing the penalty of dismissal.

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6. As the transcript now stands this court has before it in a separate exhibit book the documents upon which plaintiff has rested its proof of title, which title is denied by the defendant. There is no testimony on this issue, and therefore nothing to simplify or condense, and this court should under its present ruling have passed upon this question of title, even if the other issues are not now properly before the court.

7. Now that the desires and position of this court have been made clear by the opinions of this court filed in this and other causes, counsel in this case, and doubtless in all others, know what to do and will earnestly strive to comply with the rule. In the present case the work of preparing a condensed and simplified transcript was begun immediately upon the filing of the opinion in this case and is proceeding as rapidly as feasible.

1. THERE HAS BEEN NO MOTION BY APPELLEE IN THIS CAUSE TO DISMISS THIS APPEAL BECAUSE THE RECORD HAS NOT BEEN CONDENSED.

The facts are these:

On November 9, 1925, counsel for both parties appeared before this court in chambers and counsel for appellant presented a motion to separate and divide the argument hearing the cause on the merits first, and the questions of accounting afterwards, if necessary. In opposition to this motion appellee's counsel filed "Reasons Why Said Motion Should Be Denied". One of these (4) was that the transcript of the record was not stated in simple and condensed form. But appellant's motion was denied upon the hearing for other reasons.

Immediately following the disposition of this motion appellee presented its motion to strike from the transcript of the record herein all the evidence taken at the trial on the issues of title, validity and infringement of the patents in suit for three reasons of which the first two have to do with the appealability of certain parts of the decrees of the lower court, while the third was upon the ground that the evidence was not proved and certified to by the lower court, lacking any "certificate of evidence" and therefore "never became a part of the record in said cause for the purpose of the appeal herein or as required by Rule 75 of the Rules of Courts of Equity of the United States". In this motion nothing was said about the matter of a condensed record.

The full transcript of the evidence had been certified by the clerk of the court in accordance with a praecipe which had been served upon appellee's counsel on April 24, 1925 that is to say over six months before appellee's

motion. No objection had been made by appellee to this praecipe, although it specified the testimony already printed and in uncondensed form. Nor was this form of record made a ground of appellee's motion, on November 9, 1925. The court then ordered appellee's motion to stand until the final hearing of the cause.

Thereupon and in order to cure any defect in the record by reason of the lack of a certificate of evidence, this being the only point which had been raised by the appellee in its motion, appellant presented to this court on January 8, 1926, its motion for an order remitting the certified transcript of record to the District Court for permitting a certificate of evidence. This motion was opposed by appellee's counsel as coming too late, but the court stated that the question was of sufficient importance to warrant more full hearing on a later date, and it was thereupon ordered that the motion should be heard on January 29, 1926, on which date a full hearing occurred upon printed briefs which are on file in this court.

But on neither of these hearings, either orally or by formal motion or in its briefs, did appellee present any motion that the appeal ought to be dismissed for lack of a condensed record. The fact of noncondensation of the record was briefly referred in appellee's brief on this motion at the bottom of page 34, but it was not made the ground of any motion to dismiss the appeal and to have done so would have been inconsistent with that which appellee's counsel were then urging, namely, that only a certain part (to wit the trial record alone) should be stricken from the transcript upon the sole ground that it lacked a certificate of evidence. Appellee's counsel expressed their readiness to argue the questions arising upon the accounting on the record as

it stood which of course could not have been done had appellee insisted that the accounting evidence must be reduced to narrative form.

On the day of the later hearing, to wit, January 29, 1926, this court made its order (which appears on page 4910 of the printed record) remitting the transcript to the District Court in order that appellant might request the court for a certificate of evidence to the trial record (but not referring to the accounting record because appellee's counsel had expressed their satisfaction as to this); and for further amendment in certain minor points which had been brought to the attention of the court by appellant's motion and as to which the certified transcript appeared to be defective.

Thereupon counsel for both sides appeared before the District Court and a certificate of evidence was obtained, and by way of abundant caution the certificate was made to apply to the entire record, and upon the situation being explained to the District Judge he added to the order his direction that all of the testimony in the cause be reproduced in the exact words of the witnesses and not in narrative form. Such an order had not been secured previously because of the acquiescence of appellee's counsel in the praecipe calling for the entire record, and his failure to move for a condensation of the record; but it was deemed best by both court and counsel to have the matter made the more certain by the explicit order of the court.

In this shape the cause came on for argument before this court on October 7, 1926, and was on that day argued upon the merits. Upon appearing before the court on the morning of the argument appellee's counsel filed a motion setting forth five new technical reasons why the appeal should be dismissed. This motion in no way

suggested any defect in the record by reason of its non-condensed form, nor was there any reference to Rule 75, but on the contrary and inconsistent therewith, this motion after repeating its insistence upon the reasons set forth in the motion to dismiss filed November 9, 1925, (which said nothing about condensation of the record) added four others, of which that numbered 2 questioned the power of Judge Fitzhenry to execute any certificate of evidence after the transcript of evidence had been filed in this court; while the remaining three reasons were all based upon the allegation that the transcript of record now before this court failed to contain certain documents and exhibits which appellee asserted ought to have been included. These had not been included in appellant's praecipe and appellee had not exercised its privilege of filing a supplementary praecipe, and of course this court gave no effect to appellee's belated motion, and heard argument only upon the merits.

2. THIS COURT AFTER HAVING THE RECORD BEFORE IT ORDERED IT SENT DOWN TO THE LOWER COURT IN ORDER THAT IT MIGHT BE RETURNED WITH A CERTIFICATE OF EVIDENCE WITHOUT ORDERING OR SUGGESTING THAT THE RECORD OUGHT TO BE CONDENSED.

At all of the hearings of the motions above recited the printed transcript of the record in this case in ten volumes was physically and actually before this court. Reference was made more than once by counsel to the fact that on account of the complexity of the issues and the character of the case the testimony had been certified in full. If this court had given counsel an indication of its desire to then and there change the established practice of this court as existing for fourteen years, counsel could and would have added to its motion to remand a request that when remanded the District Court should be directed to institute procedure under Rule 75b for the condensation of the record. Had this suggestion been made by this court, all of the present difficulty might have been avoided without any more delay than has occurred, as abundant time for this purpose elapsed after the issuance by this court of its remittitur and the return of the newly certified transcript to this court.

3. THE DECREE IN THIS COURT INVOLVES THE SUM OF ALMOST ONE MILLION DOLLARS AND IT IS NOT JUST THAT DEFENDANT IN THIS CASE SHOULD BE PENALIZED IN THIS SUM BECAUSE THERE WAS NOT STRICT CONFORMITY TO A RULE OF PRACTICE UPON WHICH THIS COURT HAS FOR 14 YEARS PERMITTED SUCH NONCONFORMITY, AS COUNSEL BELIEVED BECAUSE THE COURT SO WISHED IT.

As we believe appellant to have presented just cause for reversal of the decree, and as its affirmance makes appellant liable in the sum named, it is evident that for failure to comply with a rule of procedure as to which this court has remained silent for fourteen years, during all of which time a contrary practice has been persistently and consistently followed by counsel and authorized by the court, the defendant is penalized to the extent of the judgment in this case, and deprived of a decision on the merits of the case.

The records of this court for the last five years have been searched for the purpose of verifying this statement, and it is found that in over one hundred cases this court has received uncondensed transcripts, permitted argument upon them, and decided the case upon the merits, in which a certified transcript of substantially the entire evidence in question and answer form was brought before this court. These cases are listed in detail in an Appendix to this Petition. We have been limited to this five-year period for investigation by lack of time, but it will be sufficient as it shows that the practice of this circuit in regard to noncondensed records was continued and permitted by this court after the decisions of the Supreme Court in 1921.

While in an opinion which has been filed in this court,

on December 22, 1926 (*Clark Manufacturing Co.* against *Tablet & Ticket Co.*) this court states that for fourteen years the courts have appealed to the bar to comply with this rule, and that "they have scolded and they have threatened", yet counsel cannot find reference to this subject in any recorded opinion of this court, nor can they, nor members of the bar to whom they have appealed, recall ever having heard any such appeal, statement, scolding or threatening by this court.

The opinion which has been filed in this cause truthfully asserts that the transition from the old practice to that of Rule 75 has in this court been neither accomplished nor commenced. Counsel feel sure that had the wishes of this court been made clear by any of the methods which have been adopted by certain other courts, the change of practice would long ago have been accomplished. In the year 1921 (and not before) the Supreme Court of the United States made its wishes clear in the cases of *Newton* against *Consolidated Gas Co.*, 258 U. S. 165, and in *Houston* against *Southwestern Telephone Co.*, 259 U. S. 318. (The opinion of this court is in error in assigning the former case to the year 1911). Prior to these decisions the practice in the Supreme Court had been largely to the contrary, influenced by the decision of that court in *United States* against the *United States Steel Co.* 240 U. S. 442. We know of no case in which the Supreme Court has dismissed an appeal for lack of compliance with this rule.

But the rule being primarily for the benefit of Circuit Courts of Appeal, and a very small proportion of cases to which it applies ever reaching the Supreme Court of the United States, the bar have in the latter class of cases been guided, and we believe properly so,

by the wishes of the Circuit Courts of Appeal themselves, as the only courts who have to deal with the record and which are entitled to have them in the shape in which they wish them.

When the Sixth Circuit Court of Appeals in 1914 desired to make clear its wishes in regard to the carrying out of the rule as to the condensation of records it issued a statement (*in re* General Equity Rule 75, 222 Fed. 884) and in this way secured strict compliance with the rule in that circuit ever since. We understand it was never found necessary to dismiss any cases because of infraction of the rule in that circuit.

When in January 1926 the Fifth Circuit Court of Appeals desired to make clear its views it said so in an opinion (*Buckeye Cotton Oil Co.* against *Hagland*, 11 Fed. (2), 231) but it expressly refrained from enforcing the rule in the case in which the decision was made.

No case is known anywhere prior to the present case in which dismissal of the appeal has been the penalty for infraction of this rule of condensation.

When this appeal had been perfected and the time came to obtain a certificate of the record, counsel conferred and carefully considered the course to be pursued. The senior counsel for appellant was the late Mr. Edward Rector of Chicago. He stated that in his experience he had found that this court was accustomed to receive and hear cases upon a transcript of the whole record and that he believed it to be the proper practice to pursue in this case. This advice was accepted and acted upon and was, we believe, the best advice which could have been obtained at the time. He could not have foreseen that the practice of this court might change so suddenly without notice.

In confirmation of all that we have said as to the previous practice of this court we quote from Judge Alschuler's dissenting opinion in *Clark* v. *Tablet & Ticket Co*:

> "this court's long acquiescence in the practice here followed makes it highly inequitable here to impose the capital penalty of affirmance without first affording opportunity to comply with the rule, in whose long nonobservance this court has, at least impliedly, seemed to invite litigants to continue."

4. A MAJORITY OF THE CIRCUIT COURTS OF APPEAL HAVE, AFTER A FAIR TRIAL OF THE RULE REQUIRING CONDENSATION OF RECORDS, FOUND IT DIFFICULT OF APPLICATION IN CERTAIN CLASSES OF CASES, AND HAVE THOUGHT IT UNDESIRABLE TO APPLY THE RULE TOO STRICTLY, AND HAVE SANCTIONED LIBERALITY OF CONSTRUCTION OF THE WORDS "ANY PART OF THE TESTIMONY."

The views of the judges of these courts being well known to the patent bar have been reflected in a practice which in those circuits has made condensation of the record the exception rather than the rule. This does not imply any opposition to the rule in general but only a desire to apply it with discretion according to the circumstances of the case.

Appellant's counsel believed that this court shared the view of these other Circuit Courts of Appeal, and would adhere to its similar practice, and that in obtaining certification of a complete transcript of evidence in this case such counsel were only doing that which was in accordance with the long recognized practice of this court. And it is believed that this court should have made some announcement of its change of practice before imposing the penalty of dismissal.

As most equity appeals, particularly patent cases, proceed no farther than the Circuit Court of Appeals, the patent bar have been in the habit of preparing the record on appeal in each different circuit as far as possible in accordance with either the known wishes of the judges of the Appellate Court of that circuit, or the practice of that court. This is inevitable in a situation where there has been as wide diversity of opinion concerning a rule and its application as has existed concerning this one.

It has been the experience of many counsel thus practicing, where the attempt was made to strictly carry out its provisions, that in certain cases after preparing a careful condensation in narrative form of the entire record at the expense to the client, often of many thousands of dollars, the work has all gone for nothing. Upon presenting the condensation to the court in accordance with the rule appellee's counsel has prepared a widely differing condensation and been unwilling to agree to anything else. Thereupon the District Judge has been asked to take up and settle the differences. In many cases the District Judge has refused to do this and has advised counsel that the only thing to do is to certify the entire record and thereupon made an order to this effect. The charges for useless labor thus incurred are not easily borne by the client. Again, where such condensed records were found feasible and certified to the Court of Appeals it occurred that the Court of Appeals raised objection to the form of the record stating that they much preferred to have the testimony before them in full in order that the accuracy of the witness might be tested by the reading of his deposition as taken. It naturally came about that in those circuits where the judges had thus expressed themselves, or where by tacit acquiescence in the practice it was assumed that their views were of this nature, counsel have always tried to conform to the views of that Court of Appeals to which the record was to be taken.

Accordingly it is believed that an examination of the records of the Courts of Appeal for the First, Second, Third and Fourth Circuits would show a general practice extending over many years past, of receiving, considering and passing upon the merits of cases thus

brought up upon uncondensed transcripts. Until the decision in this case this was believed to be the established practice of the Seventh Circuit also.

In the Fifth and Sixth Circuits the views of the Court of Appeals are well understood and they are of course followed and the records condensed. In the Eighth and Ninth Circuits it is believed that the practice still prevails very generally of sending up and using in the Court of Appeals the complete transcript of the record.

Subsequent to those decisions of the Supreme Court in 1921 re enforcement of the rule, Chief Justice Taft sat as presiding member of the Court of Appeals for the Fourth Circuit in *Wire Wheel Co.* v. *Budd Wheel Co.*, 288 Fed. 308. The testimony was before the court in question and answer form with no condensation and no reduction to narrative form. The case was decided upon the merits without criticism of the state of the transcript. Plaintiff-appellant was represented by a member (Mr. Davis) of the same firm (Rector, Hibben, Davis & Macauley) of which counsel in the case at bar is and was a member (Mr. Hibben).

Under these circumstances it is thought that this court will see the importance of giving fair notice to counsel as to the wishes of the court, or as to any change in practice, before refusing to hear an appeal upon the merits because the evidence has been certified in full.

5. THE HOLDING BY THIS COURT THAT COURTS ARE WITHOUT POWER TO DIRECT THE SENDING TO THE APPELLATE COURT OF AN UNCONDENSED TRANSCRIPT AND THAT IF THEY DO SO THE TRANSCRIPT MUST BE IGNORED AND THE APPEAL DISMISSED, IS A DANGEROUS LIMITATION UPON THE POWERS OF THE COURT, AND A VIOLATION OF THE LETTER AND SPIRIT OF SECTION 269 OF THE JUDICIAL CODE AS AMENDED FEBRUARY 26, 1919, SUBSEQUENT TO THE PROMULGATION OF EQUITY RULE 75.

As to the holding of this court that the equity rules have the force of a statute and that "it is not within the power of a District Court or Judge to make such an order" as was made in this cause by the lower court, directing that the testimony be reproduced in the exact words of the witnesses; we respectfully suggest the following necessary consequence of the holding:

If this interpretation be correct it follows that neither has this court nor the Supreme Court the power to make such order, for both are bound by statute. Cases must in the future arise in which this court will earnestly wish to have a verbatim transcript in order to know what the witnesses have said, and so the better to do justice; but the hands of the court are tied and justice cannot be done in this way.

This court has in the past several times experienced the force of this and made orders directing the complete record to be sent up on appeal.

On November 4, 1925, Judges Alschuler, Evans and Anderson, sitting in this court, heard a motion in the case of *Bestwall Manufacturing Co. v. U. S. Gypsum Co.* (No. 3693) for leave to reproduce the testimony

taken in the lower court in full in the appeal transcript, and in pursuance thereof ordered

> "that in preparing the transcript of the record on the appeal in this cause all of the testimony shall be reproduced in the exact words of the witnesses."

On December 11, 1925, Judge Evans, sitting in this court made such an order in the case of *Wirebound* v. *Gibbons* (No. 3650).

On April 21, 1926, Judge Alschuler, sitting in this court made such an order in the case of *Deer Co.* v. *U. S. Slicing Machine Co.* (No. 3756).

On May 17, 1926, Judge Evans, sitting in this court made such an order in the case of *Fairbanks Morse & Co.* v. *American Valve & Meter Co.* (No. 5776).

And in the other circuits hundreds, probably thousands of cases are *in consimile casu* and *must* be dismissed, if this court has correctly interpreted the law.

In 1919 after the promulgation of the rule requiring condensation of the record, Sec. 269 of the Judicial Code was amended to read:

> "On hearing of any appeal * * * the Court shall give judgment after examination of the *entire* record before the Court, without regard to technical errors, defects, or exceptions which do not affect the substantial rights of the parties."

This would seem to mean, as applied to the requirements of Equity Rule 75, that in case of its infraction (as the rule does not concern the substantial rights of the parties, but only court procedure) the remedy is to be found in the provisions of Equity Rule 76, as to the imposition of costs. And the last paragraph of Rule 75 empowers the court to deal with just such a situation as the present by means of orders such as we ask this court to make.

As to the invalidity of Judge Fitzhenry's order, and similar orders made by this court, we submit that they are justified and within the terms of Rule 75c empowering the court generally to give directions "as to the general contents of the record to be prepared on the appeal", and that this useful and important power should not be abridged and narrowed as the opinions in this case would do.

6. AS THE TRANSCRIPT NOW STANDS THIS COURT HAS BEFORE IT IN A SEPARATE EXHIBIT BOOK THE DOCUMENTS UPON WHICH PLAINTIFF HAS RESTED ITS PROOF OF TITLE WHICH TITLE IS DENIED BY THE DEFENDANT. *There is no testimony* ON THIS ISSUE AND THEREFORE NOTHING TO SIMPLIFY OR CONDENSE AND THIS COURT SHOULD UNDER ITS PRESENT RULING HAVE PASSED UPON THIS QUESTION OF TITLE EVEN IF THE OTHER ISSUES ARE NOT NOW PROPERLY BEFORE THE COURT.

This court may have overlooked the fact that upon the issue of title there is no testimony in the record. Plaintiff offered its documentary showing of title. All of the documents thus offered are separately printed in Volume 3 of the record. Defendant objects that taken collectively they fail to show title. Condensation of these documents would hardly be possible. Appellee's counsel insists that taken together they create a title in the plaintiff. Whether this is true can only be determined by the court examining the papers and seeing if it can find in them any title vested in the plaintiff. As to this issue there has been no violation of any rule, and a decision upon it can as well be made now as under any possible different form of record. It is therefore requested that the court, at the least, decide this issue upon the merits instead of adhering to its order of complete dismissal.

Precisely this sort of thing was recently done by the Supreme Court in a much more extreme case. See *Patterson* v. *Mobile Gas Co.* 46 S. C. Reporter, p. 445.

However we make this suggestion without waiver of our request for a more equitable course, to wit the use of the process of this court to secure the preparation and certification of a suitable condensed record in order that full justice may be done in this case.

7. NOW THAT THE DESIRES AND POSITION OF THIS COURT HAVE BEEN MADE CLEAR BY THE OPINIONS OF THIS COURT FILED IN THIS AND OTHER CAUSES, COUNSEL IN THIS CASE AND DOUBTLESS IN ALL OTHERS, KNOW WHAT TO DO AND WILL EARNESTLY STRIVE TO COMPLY WITH THE RULE.

The condensation of the record in the present case is proceeding as rapidly as possible in the hope and expectation that this court will see that its course is in contravention of the considerations which usually govern the disposition of causes in equity. A course of procedure carried on with the knowledge and acquiescence of this court for many years is made, without notice from this court, a reason for penalizing a party in the sum of nearly a million dollars; the spirit of Section 269 of the Judicial Code has been violated, and we ask that appellant's motion be allowed, and this cause either decided upon the merits on the record now before the court, or an opportunity granted to the appellant, as prayed for in this motion, to condense the record and bring it before this court in the form in which the court desires it to be.

8. THE PARTICULAR RELIEF WHICH WE EARNESTLY PRAY THIS COURT TO GRANT IS THAT WHICH JUDGE ALSCHULER HAS POINTED OUT IN HIS RECENT DISSENTING OPINION IN CLARK V. TABLET & TICKET COMPANY.

He says that this court should not impose the capital penalty of affirmance without first affording reasonable opportunity for compliance, and that he believes this court has the power to make such an order, and that the District Court may thereupon certify a proper condensed statement of the record notwithstanding the term has passed. This is strictly in accordance with the deliverance of the Circuit Court of Appeals for the Sixth Circuit in 222 Fed. 884 and for the Ninth Circuit in 269 Fed. 227. These courts hold that the shaping of the statement of evidence is a ministerial proceeding, and so far pertains to the making of the return to the appeal that the perfecting of the appeal does not deprive the trial court of jurisdiction, and therefore does not deprive this court of the right to direct the trial court to now proceed with the shaping of a statement of evidence. (222 Fed. 886.) We believe it entirely within established precedents that an order should be made such as we have suggested, or in some similar form. When in pursuance of this order a simple and condensed record has been prepared under direction of the lower court this court may issue its certiorari (by analogy to certiorari upon suggestion of a diminution of the record) and order the simplified transcript sent up, and as soon as this has been done this court will have before it a record complying with the rules and can proceed to do justice.

In *Stenuick* v. *Jones*, 282 Fed. 161, 164 (C. C. A. 9), on appeal from an accounting in a patent case, the rec-

ord on the accounting had been certified without condensation by order of the District Court. In the Appellate Court the appellee objected to the record because not condensed under Rule 75.

The court said:

> "If, notwithstanding this order of Judge Gilbert, we were of the opinion that a restatement of the case under rule 75 was necessary for the purpose of this review, and that its absence would be prejudicial to the case of the appellees, we should so order; but we do not find it necessary, or that its absence will be prejudicial to the appellees upon any issue before the court."

9. LEST THE COURT BE INFLUENCED BY AN APPEARANCE OF DELAY IN THE EARLIER PROCEEDINGS ON THIS APPEAL, A FEW WORDS OF EXPLANATION ARE PROPER.

The master in this cause was an elderly gentleman over eighty years of age. He died before the appeal. He had left the papers filed by him with his report in great confusion. Many were unidentified. Many were duplicated. Many tables of figures submitted by the accountants had informal pencilings in the margin. To straighten this out and produce the accounting exhibit book (Vol IX of the record) involved several months of hard labor. The official printer of this court was in charge of printing this record, he made numerous trips to Springfield and Philadelphia in the effort to properly prepare this part of the record. There has been a great deal of condensation as a result of his labors and those of counsel.

The court refers to an apparent duplication of four printed patents in the record. The trouble is that these patents, although handed to the master as evidence, after witnesses had been examined concerning them, were not by him in any way marked. They were filed physically with his report. The printed feared to include them within his printed transcript (which was printed before it was certified) and merely annexed them at the end of Vol. IX, *after* the clerk's certificate. They therefore form no part of the record. When the transcript was returned they were properly certified by Judge Fitzhenry's express direction and therefore form part of Vol. X of the record being before the clerk's second certificate. But they only appear once in the actual record.

Much more might be said in explanation of the length

of time it took to print this record. There was in fact no lack of diligence, but a more full explanation would seem out of place here as no action of the court is based upon this ground.

Respectfully submitted,

CHARLES NEAVE,
SAMUEL E. HIBBEN,
HENRY N. PAUL,
Of Counsel for Appellant.

STATE OF ILLINOIS, } ss.
COUNTY OF COOK. }

HENRY N. PAUL, having been duly sworn according to law, deposes and says that the facts as stated in this foregoing petition are true, except as stated on information, in which case he believes them to be true.

HENRY N. PAUL.

Sworn to and subscribed before me this 31 day of December, 1926.

ROBERT DOBERMAN,
Notary Public.

(NOTARIAL SEAL)

We hereby certify that the foregoing petition is in our opinion, well founded in law and should be granted and is not interposed for delay.

CHARLES NEAVE,
S. E. HIBBEN,
H. N. PAUL.

APPENDIX.

Cases decided on merits by Court of Appeals for Seventh Circuit on appeals from about June, 1921, to date, in which the evidence was not condensed but was in original question and answer form, or substantially so as noted:

PATENT CASES.

No. 3024 Neilsen v. Libby.
Full record approved by District Court (Judge Carpenter).

No. 3025 Rockford Co. v. Abramson.
Full record without stipulation or order but certified by District Court (Judge Landis).

No. 3029 Advance Corp. v. Reflex Co.
Full record approved by District Court (Judge Geiger).

No. 3030 Duplicator Co. v. Heyer.
Full record ordered by Judge Alschuler "certified to the Court of Appeals without condensation and reduction to narrative form."

No. 3031 Flexhume Co. v. Opalite Co.
Full record stipulated. No order by District Court.

No. 3032 Flexhume Co. v. Mid City Co.
Same procedure as in No. 3031.

No. 3049 Muehmore Bros. v. Thau.
Full record approved by District Court (Judge FitzHenry).

No. 3051 Safe Co. v. Globe Wernicke Co.
Full record approved by District Court (Judge Carpenter).

No. 3079 Stewart Warner Corp. v. Payton.
Full record stipulated. No order by District Court.

No. 3088 Lundie v. Sellers Co.
Full record approved by District Court (Judge Carpenter).

No. 3089 Mount Vernon Co. v. Pressed Steel Co.
Evidence partly in narrative form and partly in question and answer form. Approved by District Court (Judge English).

No. 3100 Universal Co. v. American Co.
Full record approved by District Court (Judge Carpenter).

No. 3101 Universal Co. v. American Co.
Same procedure as in No. 3100.

No. 3102 Nagle Works v. American Co.
Same procedure as in No. 3100.

No. 3110 Brokaw Co. v. Conlon Co.
Full record approved by District Court (Judge FitzHenry).

No. 3117 Bogda v. Automatic Co.
About 50% of evidence condensed, remainder in original question and answer form. Approved by District Court (Judge Geiger).

No. 3123 Wells v. American Bureau.
Full record approved by District Court (Judge Carpenter).

No. 3124 American Bureau v. Int. Inst.
Same procedure as in No. 3123.

No. 3132 U. S. Co. v. I. T. S. Co.
Full record approved by District Court (Judge Luce).

No. 3153 Nye Works v. Crown Co.
Full record approved by District Court (Judge Carpenter).

No. 3263 Guardian Co. v. Johnson Co.
Full record approved by District Court (Judge Carpenter).

No. 3165 Milwaukee Co. v. Stover.
Substantially full record (although called a "condensed statement"), approved by District Court (Judge Geiger).

No. 3180 Rodman Co. v. Schofield.
Full record by stipulation. No order by District Court.

No. 3214 Sheahon v. Meyer.
Full record approved by District Court (Judge Page).

No. 3244 Harris v. National Co.
Full record approved by District Court (Judge Carpenter).

No. 3294 Burry Co. v. Laughlin.
Full record approved by District Court (Judge Page). Specifically ordered to be "not in narrative form."

No. 3296 Barnet v. Anchor Co.
Full record approved by District Court (Judge Carpenter).

No. 3320 Hunt & Co. v. Elbert.
Full record approved by District Court (Judge Luce).

No. 3325 Dickenson v. Schie.
Full record approved by District Court (Judge Luce).

No. 3342 Dallas v. Faries Co.
Full record approved by District Court (Judge Wilkerson).

No. 3379 Pick Co. v. Imperial Corp.
Full record approved by District Court (Judge Wilkerson).

No. 3382 Moline Co. v. Wright.
Full record for condensed introductory part of testimony. No order of District Court.

No. 3384 Kalmon Co. v. Goldsmith Co.
Full record approved by District Court (Judge Wilkerson).

No. 3385 Wolf v. Patent Co.
Full record approved by District Court (Judge Wilkerson).

No. 3386 Cutler-Hammer Co.
Full record approved by District Court (Judge Geiger).

No. 3390 Creamery Corp. v. Miller Co.
Full record approved by District Court (Judge Page).

No. 3391 Creamery Corp. v. Miller Co.
Same procedure as in No. 3390.

No. 3395 Printing Co. v. International Co.
Full record approved by District Court (Judge Wilkerson).

No. 3401 Wood Corp. v. Gender.
All testimony in original question and answer form although designated "Condensed Statement." Approved by District Court (Judge Geiger).

No. 3404 Brush v. Lexington Co.
Full record approved by District Court (Judge Wilkerson).

No. 3438 U. S. Corp. v. West Co.
Full record approved by District Court (Judge Wilkerson).

No. 3457 Chicago Co. v. Rooch Co.
Testimony in question and answer form limited to certain pages of trial record. Approved by District Court (Judge Evans).

No. 3494 Madison Mogum v. Diamond Co.
Full record approved by District Court (Judge Evans).

No. 3499 Stromberg Co. v. Benecke Co.
Full record approved by District Court (Judge Wilkerson).

No. 3500 Stromberg Co. v. Benecke Co.
Same procedure as in No. 3499.

No. 3501 Stromberg Co. v. Benecke Co.
Same procedure as in No. 3499.

No. 3502 Stromberg Co. v. Benecke Co.
Same procedure as in No. 3499.

No. 3507 Schoenhofen Co. v. Alvey Co.
Full record approved by District Court (Judge).

No. 3508 Heyer Co. v. Ditto.
Full record approved by District Court (Judge Wilkerson).

No. 3549 Anchor Co. v. P. & M. Co.
Full record approved by District Court (Judge Wilkerson).

No. 3551 Brush v. Lexington Co.
Full record approved by District Court (Judge Wilkerson).

No. 3557 Economy Co. v. Chicago Co.
Full record approved by District Court (Judge Wilkerson).

No. 3559 American Co. v. Presto-Lite Co.
Full record approved by District Court (Judge Baltzell).

No. 3590 O'Cedar Corp. v. Grossman Corp.
Full record approved by District Court (Judge Wilkerson).

No. 3595 Starr Co. v. Auto. Co.
Full record approved by District Court (Judge Baltzell).

No. 3597 Starr Co. v. Auto Co.
Same procedure as in No. 3595.

No. 3604 Pressed Steel Co. v. Enterprise Co.
Full record approved by District Court (Judge Carpenter).

No. 3606 Scherzer v. City of Chicago.
Full record approved by District Court (Judge Lindley).

No. 3614 Barber Co. v. Standard Co.
Full record approved by District Court (Judge FitzHenry).

No. 3645 Imperial Co. v. Maxim Co.
Full record approved by District Court (Judge Alschuler).

No. 3646 Woods v. McCord & Co.
Full record approved by District Court (Judge Cliffe).

No. 3664 Milliken v. Aermotor Co.
Full record approved by District Court (Judge Wilkerson) and later additions to record approved by Court of Appeals.

No. 3691 Barker v. Atwell.
Full record approved by District Court (Judge Carpenter).

No. 3701 Heine Co. v. Rust Co.
Testimony partly abstracted, remainder in question and answer form. Approved by District Court (Judge Cliffe).

No. 3735 Merske v. Holeproof Co.
Full record approved by District Court (Judge Geiger). Argued and decided at October 1926 Term.

BANKRUPTCY CASES.

No. 3283 Hummel & Shelby.
Full record. No order by District Court.

No. 3292 Stearns Co. v. Lee.
Full record. No order by District Court.

No. 3352 Pruter v. Commonwealth Bank.
Full record. No order by District Court.

No. 3398 Farmers State Bank of Belmont, Wis. v. Prussing, trustee.
Full record. No order by District Court (Judge Luce).

No. 3471-3527 Burry et al. v. Hecht, Jr. et al.
Full record approved by District Court (Judge Wilkerson).

No. 3472-3526 Central Trust Co. I. Hecht, Jr. et al.
Same procedure as in No. 3471.

No. 3473-3525 Lachman v. Hecht, Jr. et al.
Same procedure as in No. 3471.

No. 3474-3524 Kennedy et al. v. Hecht, Jr. et al.
Same procedure as in No. 3471.

No. 3543 Rossi v. Arber.
Full record approved by District Court (Judge FitzHenry).

No. 3544 Rossi v. Arber.
Same procedure as in No. 3543.

No. 3565 Kaynee Co. v. Low.
Full record. No order by District Court.

No. 3610 Shire v. Hummel.
Full record approved by District Court (Judge Cliffe).

No. 3763 Wilson v. Wilson.
Full record approved by District Court (Judge FitzHenry).

Miscellaneous Cases.

No. 2986 Gibbons v. Quinn.
Full record. No order by District Court.

No. 2994 Gianovi v. U. S.
Full record approved by District Court (Judge Landis).

No. 3035 Cassin v. U. S.
Full record approved by District Court (Judge Carpenter).

No. 3044 Freiderich v. U. S.
Full record approved by District Court (Judge Landis).

No. 3053 Smetana v. U. S.
Full record approved by District Court (Judge Landis).

No. 3054 Suggs v. U. S.
Full record approved by District Court (Judge Landis).

No. 3064 O'Malley v. U. S.
Full record approved by Distdict Court (Judge Landis).

No. 3083 Triester v. U. S.
Full record approved by Distdict Court (Judge Landis).

No. 3116 Journal Co. v. Tribune Co.
Full record approved by District Court (Judge Carpenter).

No. 3119 First Calumet Bank v. Rogers.
Record partly abstracted, much in question and answer form. Approved by District Court (Judge Anderson).

No. 3155 Soper v. Industrial Corporation.
Full record approved by Distdict Court (Judge Page).

No. 3169 Fox v. U. S.
Full record approved by District Court (Judge Page).

No. 3239 Investment Co. v. Fitch Co.
Full record approved by District Court (Judge Page).

No. 3308 Mon Clair Co. v. Lee.
Full record approved by District Court (Judge English).

No. 3310 Sanders v. Southern Co.
Substantially full record. No order by District Court.

No. 3383 Morand Bros. v. Chippewa Corporation.
Full record approved by District Court (Judge Wilkerson).

No. 3483 International Brotherhood v. Western Co.
Substantially full record approved by District Court (Judge Wilkerson).

No. 3484 Millanckas v. U. S.
Full record approved by District Court (Judge

No. 3561 Henderson v. Henderson.
Full record approved by District Court (Judge Wilkerson).

No. 3613 U. S. Co. v. Boone Mills.
Full record approved by District Court (Judge Wilkerson).

No. 3637 Farina Line v. City of Hammond.
Full record approved by District Court (Judge Slick).

No. 3684 Woods v. Primm.
Full record approved by District Court (Judge FitzHenry).

No. 3685 Edwards Co. v. Boserman.
Substantially full record approved by District Court (Judge Wilkerson).

No. 3705 Thompson v. Woods.
Full record approved by District Court (Judge FitzHenry).

No. 3706 Strattan v. Illinois Assn.
Same procedure as in No. 3705.

Cases now on docket of Court of Appeals for the Seventh Circuit, awaiting argument, in appeals in which the evidence has not been condensed under Rule 75.

PATENT CASES.

No. 3650 Wirebounds Co. v. Gibbons.
Full record submitted to but not approved by District Court (Judge Anderson) but later approved by Judge Evans in Court of Appeals as a "Sufficient compliance with the Equity Rules."

No. 3666 Bassick Co. v. Auto Co.
Full record approved by District Court (Judge Slick).

No. 3710 Kercher I. Forsythe Bros.
Full record approved by District Court (Judge Wilkerson).

No. 3791 Eibel Co. v. Alexandria Co.
Full record approved by District Court (Judge Slick). Specially that it "need not be stated in narrative form."

No. 3801 Directoplate v. Bleistein.
Testimony partly abstracted, remainder in question and answer form. Approved by District Court (Judge Lindley).

No. 3807 Lakewood Co. v. French & Co.
Testimony partly abstracted, remainder in question and answer form. Approved by District Court (Judge Cliffe).

No. 3811 Wall Co. v. Gardner.
Full record approved by District Court (Judge FitzHenry).

No. 3812 Macomb Co. v. Mantle Co.
Full record approved by District Court (Judge FitzHenry).

No. 3815 Cutler Hammer Co. v. General Electric Co.
Full record approved by District Court (Judge Geiger).

No. 3816 Wall Co. v. Gardner.
Same procedure as in No. 3811

No. 3823 Larkin Co. v. Bassick Co.
Full record approved by District Court (Judge Lindley).

No. 3828 Westinghouse Co. v. Rock Island Co.
Full record approved by District Court (Judge FitzHenry).

No. 3845 Collegiate Co. v. DuPont Co.
Full record approved by District Court (Judge Wilkerson).

No. 3849 Wessels v. Chicago Co.
Full record approved by District Court (Judge Cliffe).

No. 3837 Star Can Opener Co. v. Ace Mfg. Co. et al.
Full record approved by District Court (Judge Wilkerson).

Cases affirmed by Court of Appeals of the Seventh Circuit for noncompliance with Rule 75 as to condensation of record:

No. 3614 Standard Co. v. Barber Co.

No. 3766 Hug Co. v. Hug.

No. 3740 Clark Co. v. Tablet Co.

No. 3743 Cramer v. Motor Player Corp.

No. 3755 Deer Co. v. U. S. Co.

No. 3756 Deer Co. v. U. S. Co.

No. 3776 Fairbanks Co. v. American Co.

No. 3782 Fairbanks Co. v. American Co.

No. 3794 Semaphoric Co. v. Boyce.

SUMMARY.

Number of Equity Cases decided during last five years in which record is uncondensed or substantially so, including patent, bankruptcy and miscellaneous cases and not including cases partially condensed— 119

Number of cases now on docket, awaiting argument, in which record is uncondensed— 15

Number of cases already decided on ground of uncondensed record— 10

IN THE

United States Circuit Court of Appeals

FOR THE SEVENTH CIRCUIT.

THE BARBER ASPHALT COMPANY, *Appellant*, vs. STANDARD ASPHALT AND RUBBER COMPANY, *Appellee*	No. 3614.

AFFIDAVIT OF HENRY N. PAUL.

STATE OF ILLINOIS, } ss.
COUNTY OF COOK, }

HENRY N. PAUL, having been duly sworn according to law, deposes and says:

I have been counsel for the plaintiff in the above case since the suit was instituted and entrusted by my client with full control of the suit. At an early stage of the litigation, upon my advice, plaintiff also retained the firm of Rector, Hibben, Davis & Macauley of Chicago, as additional counsel; and the late Mr. Edward Rector of that firm tried the case with me in the District Court.

After the appeal was taken, Mr. Rector advised me that in a case of this character in the Seventh Circuit it was preferable and usual to have the entire testimony certified, in question and answer form, and upon the strength of his advice as to the prevailing usage and practice in the Seventh Circuit this course was followed.

In taking this course I relied chiefly upon Mr. Rec-

tor's advice as that of a lawyer who had practiced all his life largely in equity, in the Seventh Circuit, but his judgment was confirmed by my own experience, chiefly in the Third Circuit, where our Court of Appeals puts a liberal construction upon the provision of the Supreme Court Equity Rules relating to condensed records, and has expressed its preference for records containing all of the testimony in the form of question and answer.

I am also informed by those qualified to know that the same practice prevails in the First, Second, Fourth and other circuits.

I had never been informed of, nor had I ever seen any decision of or intimation from this court covering this point, and I therefore followed the advice of counsel, as distinguished from being guided by anything the court had said.

After the record had been printed and filed a motion was made by appellee's counsel on November 7, 1925, and heard on November 9, 1925, to strike from the transcript of record certain parts of the transcript; namely, pages 18 to 1577, being the proceedings at the trial (as distinguished from the proceedings before the master, his report and the final decree entered thereupon). Three grounds were asserted for this, one of which was that the evidence taken at the trial was not approved by the court or judge "and was not signed, certified to, or authenticated by the Court or Judge, and was never filed with such approval, certification, or authentication in the office of the Clerk of said District Court, and never became a part of the record in said cause for the purpose of the appeal herein, all as required by Rule 75 of the Rules of the Court of Equity of the United States." Appellee's counsel did not ask this court to dismiss this appeal because the testimony was not condensed or put into narrative form. At the argument of the cause upon the

merits on October 6, 1926, appellees's counsel presented additional reason at great length for dismissing the appeal but they were based upon the allegation that appellant had not caused enough of the record to be certified.

Had this question been pressed either by counsel or the court at the time when appellant moved and obtained from this court an order permitting the return of the record to the District Court for further certification, appellant's counsel might at the same time have asked leave to have the record reduced to narrative and condensed form, and this could have been done without delay and the case argued when it was argued, upon such condensed or abbreviated record.

But under the above circumstances I permitted the record to come before the court at the argument in the form in which it now stands in accordance with the original decision which Mr. Rector and myself had reached at the time of the taking of the appeal. In doing this, I was but following the best advice I could get. I feel that my client should not suffer a penalty on this account and that the court should now allow prompt and proper correction of the record in accordance with their views now clearly expressed.

Should this court grant the motion to remand which is now made the record will be condensed and reduced to narrative form without any delay chargeable to the appellant, the work of doing this being already well under way, and returned to this court in order that the cause may then be decided upon its merits.

The decision of the Court of Appeals in this case would leave the impression that after the perfecting of this appeal on July 5, 1924, nothing was done until April 24, 1925, when for the first time a praecipe was served upon plaintiff. As a matter of fact, it was during this interval that the record was made up and printed.

After this it remained for the clerk to verify this entire printed transcript from the original on file and certify it. In making up the printed record a great deal of the accounting record on file was carefully eliminated, thereby reducing the record, and when this had been done the praecipe, which had been deferred for this purpose, was prepared and served.

The accounting papers which had been filed by the Master with his report were very voluminous and left by him in great confusion. He had died and the official printer of this court to whom had been entrusted the preparation and printing of this record, in consultation with appellant's local counsel in Springfield, spent many months' difficult labor in straightening out these accounting exhibits. A great mass of confused schedules, lists, calculations and accounts were found among the papers filed by the Master with his report, some identified and others not so marked. Many were duplicates. Others were duplicates except for additions or marginal pencilings. An immense amount of elimination and condensation was therefore performed. This involved voluminous correspondence between Springfield and Philadelphia, and a great many trips of counsel or the printer. After many months hard labor there was produced the present condensed accounting Exhibit Book (Vol. IX), which in any future condensation of the record, will not need or admit of much further condensation. Then a praecipe was prepared and served limited to this selected record and the appellee has filed no counter praecipe. So that this labor and time has not been wasted.

Also, before the Master, there had been produced a large scrap book containing specimens of defendant's advertising matter in over a hundred pages, which was used to justify an item of $400,000 for the cost of this advertising. During the accounting and for the benefit

of the lower court, this entire exhibit had been photo-lithographed but when the printing of the record was well advanced and the printer was ready for such copies, it was found that the same had been inadvertently destroyed, whereupon it became necessary to again reproduce such matter.

These instances are only given as some of many circumstances which if fully understood by the court would adequately explain what was going on during the nine months which elapsed between the completion of the appeal and the service of the praecipe.

HENRY N. PAUL.

Sworn to and subscribed before me this 31 day of December, 1926.

ROBERT DOBERMAN,
Notary Public.

(NOTARIAL SEAL.)

IN THE

United States Circuit Court of Appeals

FOR THE SEVENTH CIRCUIT.

THE BARBER ASPHALT COMPANY, *Appellant.* *vs.* STANDARD ASPHALT AND RUBBER COMPANY, *Appellee.*	No. 3614.

AFFIDAVIT.

STATE OF ILLINOIS, } ss.
COUNTY OF COOK. }

SAMUEL E. HIBBEN, being duly sworn upon oath, deposes and says as follows:

I am and have been a member of the Federal Bar of this Circuit for nearly thirty-five years during which time I have specialized more particularly in the practice of patent law. I am a member of the firm of Rector, Hibben, Davis & Macauley, of Chicago.

To my knowledge, the perfecting of the appeal in this case and the preparation of the transcript on appeal were carried out under the advice of my late partner, Mr. Edward Rector. At that time, it was and had been the practice of this court to receive and consider a full or uncondensed transcript of record particularly in cases, such as the present one, in which counsel felt that the whole record would be helpful to the court and I

can, therefore, quite understand why Mr. Rector in the present case advised such course, which was my own practice at the time and that of the other members of this firm and of the Patent Bar generally of the Seventh Circuit.

SAMUEL E. HIBBEN.

Subscribed and sworn to before me this 31st day of December, 1926.

ROBERT DOBBERMAN,
Notary Public.

IN THE

United States Circuit Court of Appeals

FOR THE SEVENTH CIRCUIT.

THE BARBER ASPHALT COMPANY, *Appellant*, vs. STANDARD ASPHALT AND RUBBER COMPANY, *Appellee*.	No. 3614.

MOTION TO VACATE ORDER AND DIRECT CONDENSATION OF THE RECORD.

And now this 31st day of December, 1926, comes the appellant, the Barber Asphalt Paving Company, and moves this court that the mandate in this cause be stayed, and the order of affirmance vacated, and an order made permitting the District Court for the Southern District of Illinois to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of the evidence in this cause in simple and narrative form; and that upon this court being advised that this has been done a writ of certiorari do issue to cause such simple and condensed statement to be certified to this court as a part of the record on appeal to the end that the appeal may then be determined in accordance with the merits of the controversy.

The grounds upon which this motion is based are fully set forth in the Petition for a Rehearing of the Cause which has this day been filed and to which reference is here made.

[fol. 5046] blank. [fol. 5047] omitted.

[fols. 5048 & 5049] IN UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

MINUTE ENTRY OF MOTION TO STAY MANDATE AND VACATE AFFIRMANCE—January 4, 1927

Now this day come the parties by their counsel, and counsel for appellant presents a motion that the mandate in this cause be stayed, and the order of affirmance vacated, and an order made permitting the District Court for the Southern District of Illinois to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of evidence in this cause in simple and narrative form; and that upon this court being advised that this has been done a writ of certiorari do issue to cause such simple and condensed statement to be certified to this court as a part of the record on appeal to the end that the appeal may then be determined in accordance with the merits of the controversy.

And the court having heard the same takes this matter under advisement.

[fols. 5050 & 5051] UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

ORDER EXTENDING TIME—January 12, 1927

On motion of counsel for appellee, it is ordered by the court that the time for filing answer to petition for rehearing and motion to vacate order and direct condensation of record in this cause be, and the same is hereby extended to and including January 18, 1927.

[fol. 5052] In United States Circuit Court of Appeals

[Title omitted]

Answer to Petition for Rehearing and Suggestions in Opposition to Motion to Vacate Order of Affirmance and Direct Condensation of the Record—Filed January 18, 1927

To the Honorable the Judges of the United States Circuit Court of Appeals for the Seventh Circuit:

The Appellee, Standard Asphalt and Rubber Company, for answer to the petition for rehearing and by way of suggestion in opposition to the motion to vacate the order affirming the decree of the District Court and to direct condensation of the record, respectfully presents to the court the following:

General Statement of Appellee's Position

This case differs in many essential and determining features from the other cases in which the Court affirmed the judgments and in which motions to put the evidence in narrative form were allowed.

[fol. 5053] In the other cases the opinions seem to show that the uncondensed testimony in the form of questions and answers and without being put in narrative form was incorporated in the transcript of the record filed in the Court of Appeals by stipulation of parties and in certain instances with the affirmative approval of the Trial Court. It is thus manifest that both parties participated in the violation of the rules of Court and particularly Equity Rule 75, and that therefore, the appellees in those cases were in no position to ask for the enforcement of the rule, and did not do so.

Under these circumstances, therefore, none of the appellees was in a position to complain or to oppose the action of the Court in permitting the testimony to be put in narrative form because of the delay that might be involved, or the expense incurred, or for any other reason. Notwithstanding the fact that as this Court pointed out in its opinions in certain of the other cases and particularly in the

case of R. W. Clark Mfg. Co. v. Tablet & Ticket Co., No. 3740, in which the Court said, that the abuse of Equity Rule 75 in this respect results in great delay and needless expense to the litigants from which litigants have a right to expect the Courts to relieve them, and notwithstanding the fact also that the Supreme Court of the United States in Newton v. Consolidated Gas Co., 258 U. S. 165, 173, said that Equity Rule 75 was intended to protect litigants from unnecessary costs and delay, yet the appellees in these other cases were in no position to invoke the enforcement of this rule or to claim the protection that its observance contemplated.

This, however, is not in the situation in the case at bar. Appellee in this case is in a position to rightfully and equitably ask the protection of this Court against the unnecessary cost and delay, not only involved in the violation of the Rule in the first instance, but particularly against the delay and expense involved at this late day in granting the motion of appellant to now permit it to put the evidence in "simple and condensed" and in "narrative form."

Appellee in the case at Bar not only did not stipulate and thereby preclude itself, as did the appellees in the other cases, but on the contrary was from the beginning earnest and vigilant in claiming the protection of the Court under Equity Rule 75, and in insisting upon the performance by Appellant of its "plain duty", to use the words of the Supreme Court in the Newton case, and thereby relieving Appellee, to use the language of this Court, in the R. W. Clark Mfg. Co. case, of the "unnecessary expense and the unneces- [fol. 5654] sary delay, which unavoidably follows an attempt to dispose of litigation in such an awkward and cumbersome manner." Having invoked the protection of this Court under Equity Rule 75 and protested against its violation from the beginning, we submit that Appellee had the right and particularly now, after the submission to and determination by this Court of this whole question, with the additional delay involved, to expect this Court, as it said in the R. W. Clark Mfg. Co. case to relieve it of the "unnecessary expense and the unnecessary delay" to which it has already been subjected and would especially be subjected if in the circumstances we have pointed out, Appellant were now to be permitted to start all over again and

to attempt to rectify its violation of its "plain duty", which it should have discharged in the first instance.

If, as the Supreme Court said in the Newton case, counsel ought from the very beginning and in every instance to comply with the direct and imperative requirements of Equity Rule 75, and if from the beginning "courts should enforce performance of this plain duty," as was said in the Newton case, and if from the beginning, litigants have a right to expect the courts to relieve them from and protect them against the violation of this Rule, as this Court has said, then certainly under the circumstances of this case all these things are conclusively true as to Appellee in the case at bar.

For the purpose of enabling the Court to get the true facts of the case at bar with the least labor we trust we may be permitted to set them forth in some detail.

The chronology of events succinctly stated is as follows:

Decree of infringement entered February 20, 1917.

Accounting decree entered April 30, 1924.

Appeal prayed and allowed, assignment of errors filed and citation issued July 1, 1924.

Supersedeas bond filed July 5, 1924.

Twelve 30 day extensions of time for filing record in Court of Appeals, the last extension expiring July 26, 1925.

Praecipe served April 24, 1925, nearly 300 days after citation.

Clerk's certificate to record June 24, 1925.

Copy of printed record with Clerk's certificate filed July 3, 1925.

Twenty-five copies of record not filed till November 2, 1925, four months after July 3, 1925.

Appellee's motion to dismiss appeal, etc., filed November 9, 1925.

[fol. 5055] Appellant's motion to remit record to District Court for certificate, etc., allowed January 29, 1926.

No motion made before Judge FitzHenry till March 30, 1926. Two months after.

Additional record with Judge FitzHenry's order filed April 13, 1926.

Cause set for hearing in Court of Appeals, April 29, 1926.

Order entered April 23, 1926, continuing cause on motion appellant to October 6, 1926.

Cause argued orally and motion of appellee to dismiss Appeal, etc., submitted October 6, 1926.

Order affirming decree December 13, 1926.

We charge that this chronology shows deliberate and intentional delay. Though the printed transcript of record was filed July 3, 1925, appellant withheld filing in the Clerk's office, as it was its duty to do, under the rules of this Court, twenty-five copies of this same printed record (which of necessity it had in its possession during this time), until November 2, or four months later. Immediately upon being served by the Clerk with a copy of this printed record appellee proceeded to prepare its motion to dismiss the Appeal etc. and filed the same on November 9, or seven days after being served. The motion came before this Court on November 9th, and was taken and reserved to the final determination of the cause.

We deny the statement (Petition for Rehearing, 23) and the affidavit of counsel p. 38, that the circumstances required or justified taking from April 30, 1924, the date of the entry of the decree, or from July 1, 1924, the date of the prayer and allowance of Appeal, to July 3, 1925, or over a year to prepare a transcript of the record in this cause.

The statement of counsel (p. 23) that the Master was an elderly gentleman over eighty years of age and died before the appeal is, we submit, gratuitous, and seems to have for its purpose some insinuation against him and his report. Whether the accounting papers filed by the Master were left in confusion or not, as to which we have merely the statement of counsel (and which we deny, and which there is nothing of record to show), it did not require a year or more to get them together with the evidence taken by him and to put the same in the form of a Certificate of Evidence in compliance with Equity Rule 75.

On November 9, 1925, one week after appellee was served by the Clerk with a copy of the printed purported transcript [fol. 5056] of the record, it filed and presented to the Court the following:

Its motion "to strike from the purported transcript of the record filed herein all purported proceedings and the purported evidence and testimony purported to have been had and taken on the trial of said cause before said Dis-

trict Court, on the issues of Plaintiff's title to the patents therein sued upon, and on the validity of the said patents, and of the infringement thereof by Defendant" for the following among other reasons.

"3. The purported transcript of the record filed in said cause that the purported evidence and testimony purporting to have been taken upon the trial of said cause before the District Court was not approved by the Court or Judge before whom said cause was tried and was not signed, certified to or authenticated by said Court or Judge, and was never filed with such approval, certification or authentication in the Office of the Clerk of said District Court and never became a part of the record in said cause for the purposes of the appeal herein; all as required by Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof, said purported proceedings, evidence and testimony should be stricken from the said purported transcript of record and disregarded and not considered by this Court, and because and in consequence thereof also the decree of said District Court entered on February 20, 1917, appearing on page 1217 of said purported transcript of record, and said purported proceedings, evidence and testimony, is not subject to review by this Court.

Wherefore, appellee prays that said purported proceedings, evidence and testimony be stricken from the purported transcript of the record filed herein, and that the Court do not consider or review the same, or said decree of said District Court of February 20, 1917."

At the same time on November 9, 1925, there was filed and presented to this Court certain objections of appellee to the motion of appellant to separate and divide the argument in the cause.

Among the grounds urged in support of the objections was the following:

"4. The purported evidence appearing in the purported transcript of the record filed herein is not stated in simple [fol. 5057] and condensed form, and the purported testimony of witnesses is not stated in narrative form, but on the contrary thereof, said purported evidence and testimony

is set forth in full, all contrary to Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof all of said evidence and testimony should be stricken from the purported transcript of the record in this cause and disregarded by this Court."

The second ground urged by appellee in support of its petition for rehearing is as follows, p. 1:

"(b) To grant a rehearing upon the reasons and grounds which have led this Court to declare in its opinion filed December 13, 1926, that the evidence in this cause is not properly before the Court, there being before this Court on motion raising this question, and no hearing having yet been had upon it."

We respectfully submit that counsel's suggestion is without force and cannot affect the situation in the case at bar.

The third ground in support of appellee's motion directly charged that the evidence taken before the District Court had never been "approved" by the Court or Judge, as required by Equity Rule 75. The approval by the Court under Equity Rule 75 necessarily involved compliance with the antecedent requirements of the rule as conditions precedent to such approval as follows:

First, stating the evidence to be included in the record "in simple and condensed" and "in narrative form," which duty rested primarily upon appellant; second, lodging "the same in the Clerk's Office for the examination of the other parties at or before the time of filing his praecipe under paragraph (a)" of the rule; third, notifying the other party or their solicitors of such lodgment; fourth, naming the time and place where appellant would ask the Court or Judge to approve the statement; fifth, a hearing thereon before the Court or Judge.

Therefore we submit that the statement above referred to that the evidence had not been approved as required by Equity Rule 75 of necessity and unmistakably charged that none of the conditions precedent to such approval had been complied with. It is, we contend, sticking in the bark, to say that appellee should have set forth each and all of these conditions precedent.

And continuing appellee said in this ground for its motion not only that the evidence had not been approved, as required by Equity Rule 75, but also, "was never filed with such approval" in the Clerk's Office, "and never became a [fol. 5058] part of the record in said cause for the purposes of the Appeal herein; all as required by Equity Rule 75," etc., providing specifically, "when approved, it shall be filed in the Clerk's Office and become a part of the record for the purposes of the Appeal."

It could only be filed and become a part of the record, as the rule provides, after it had been approved, and it could not be approved until the antecedent requirements had been complied with, as was specifically held by this court in Fairbanks Morse & Co. v. American Valve etc. Co. number 3776 decided on December 22, 1926.

In this connection, let it be noted that Equity Rule 75 is not merely affirmative and directive in form, but is negative and imperative in form, the language being, "the evidence to be included in the record shall not be set forth in full, but shall be stated in simple and condensed form * * * and the testimony of witnesses being stated only in narrative form."

That counsel for appellant understood that the failure to condense and put in narrative form was involved and included in this ground is shown by their printed brief filed January 18, 1926, to which we will later call the Court's attention, and from which we will later quote.

Ground (4), supra, of objection to appellant's motion to divide the argument, above set forth in full, does specifically charge that none of the evidence in the purported transcript of the record is condensed and put in narrative form, but is set forth in full, "all contrary to Equity Rule 75." and concludes by urging that all of the evidence "should be stricken from the purported transcript of the record in said cause and disregarded by this Court." Here, certainly, is a direct and specific statement of non-compliance with Equity Rule 75, and the insistence that the evidence should be stricken and disregarded. Certainly, here the protection of the Rule is invoked. Will it be said that because forsooth the words "and it is so moved" or similar words were not added, appellee lost the protection of this Rule, and this in the face of what the Supreme Court of

the United States said in the Newton Case as to the duty of the Courts to enforce performance of the Rule, or what this Court said in the R. W. Clark Mfg. Co. case as to the duty of the Court to relieve litigants of the consequences unavoidably following a violation of the rule?

We cannot believe that any such technical objection will prevail against a party protesting in apt time and invoking [fol. 5059] the duty of the Court to protect it against the violation of the Rule, and to do what the Supreme Court of the United States pointed out should follow the violation of the rule, to decline to consider the evidence, or to dismiss the Appeal, or to affirm the judgment.

And let it be remembered that appellee's insistence was not merely technical or merely that the evidence had not been put in narrative form. Its objections were substantial and that it had been deprived of a real, valuable and undeniable right, namely the right, under the rule, to have the court below pass upon the evidence to be used on appeal, to the end that, as the rule expressly says, the certificate of evidence be "true, correct and properly prepared," as a condition precedent to its being approved by him and thereupon filed and made a part of the record, and the right also to participate and be heard by the court to the same end, of all of which appellee explained that it had been deprived by the improper and ex parte actions of appellant, and in consequence of which, we shall show, the purported transcript of the testimony now before this court is not true or complete, but as it itself shows on its face, and as the Petition for Rehearing and Mr. Paul's affidavit admit, is incomplete, deleted and emasculated and contains matter never put in evidence at all.

After appellant was thus admonished on November 9, 1925, it waited two months before it again proceeded, and on January 8, 1926, made its motion to remit the transcript of the record to the District Court for the purpose of obtaining from it a certification of the testimony and evidence. Counsel were permitted to file briefs and the argument of the motion set January 29, 1926.

Counsel say in their petition for rehearing (p. 5) that appellee in its brief on this motion only briefly referred to the non-condensation of the record at the bottom of page 34 of appellee's brief.

This is not true. We quote the following passages from our brief.

Page 17 we said,

"Under Equity Rule 75 appellee's counsel have a right to be heard on the settling of the Certificate of Evidence. Manifestly, the Rule does not contemplate an arbitrary power in the District Court, or in the Court of Appeals to direct the District Court to settle the Certificate of Evidence, and thereupon approve and sign the same, without giving counsel for appellee an opportunity to make the showing provided for in the Rule itself."

[fol. 5060] Again on page 23 we said,

"This language is peculiarly applicable to the provisions of Equity Rule 75, providing the manner in which the evidence taken in equity causes shall be settled and approved, involving a judicial hearing, participated in by both parties, and consideration and action by the Court.

"The order requested by appellant cannot properly be entered, because in any event the evidence under Equity Rule 75 must be settled, approved, certified and filed in the manner provided by this Rule, which involves giving appellee an opportunity to be heard, and judicial consideration and determination by the District Court."

And still again on page 31 we said,

"Counsel refer to this complete omission to comply with Equity Rule 75, or to obtain the certification of the trial Judge to the purported evidence in the transcript of the record so as to make the same a part of the record in the cause as 'a purely technical omission. The Supreme Court of the United States and other Federal Courts to which we have called attention do not so regard this omission, but on the contrary characterize it as a grave matter."

And on page 34, and 35, we said,

"Equity Rule 75 was violated in letter and in spirit in that the testimony was not reduced to narrative form, and presented to counsel for appellee so that the same might be settled and approved by the Court in the manner contemplated by the Rule and thereby be made a part of the record.

"Not only this, but appellee's counsel were never tendered a Certificate of Evidence, or given an opportunity to examine or to be heard concerning the purported evidence and numerous exhibits incorporated in the transcript of the record on file. Counsel for appellee were totally ignored, and the first opportunity they had to know of the action of counsel for appellant was when the printed record was served upon them, and this was after the purported transcript of the record had been filed, and the whole situation closed so far as counsel for appellee were concerned."

On page 40 we said,

"Counsel say again that it was some time after the adoption of Equity Rule 75 before the Bar understood that the Court's certification of a condensed statement of evidence also applied to those cases where, either by agreement of counsel, or order of court, the entire record was sent up on [fol. 5061] appeal."

And on page 41, we said,

"Under Equity Rule 75, however, certain specific things were required of counsel for appellant before counsel for appellee could be required to move or to do anything. None of these things were done, and no attempt at compliance with the Rule was made by counsel for appellant. Counsel for appellee were not asked to, or given any opportunity to participate."

Here, then, whatever counsel for appellant may say concerning appellee's motion to strike of November 9, 1925, above referred to and quoted from, it is clear beyond peradventure of doubt that in its brief filed on January 26, 1926, above quoted from, appellee did insist repeatedly that appellant's violation of Equity Rule 75 consisted, among other things, in failing to condense and put the evidence taken in the District Court in narrative form.

This is conclusively shown by appellant's brief in support of the motion to remit the record for certification filed January 18, 1926, from which we quote the following; for the Court's ready reference.

On page 3, appellant said,

"3. Until July 1, 1924, there was no appellant, and accordingly, no one upon whom Rule 75 of the Supreme

Court, Equity Rules cast the duty of condensing the evidence as taken at the trial. In the meantime, on June 14, 1918, Judge Humphrey died, and in view of the nature of the controversies at the trial, and the conflicting views of the parties upon many points, it was not feasible to attempt to settle a condensed statement of the evidence before a Judge not thoroughly familiar with the trial of the cause, and accordingly, it was deemed best to ask the Clerk of the Court to certify the stenographer's notes of the testimony and proceedings at the trial, as already filed of record in the cause."

On page 11, appellant said,

"No such a thing as a Certificate of Evidence was known in Federal Equity practice until after the promulgation, November 4, 1912, of the Supreme Court Equity Rules, and particularly Rule 75 B thereof. All that was required was that the testimony be taken down and preserved in the record. Blease v. Garlington, 92 U. S. 1.

"But even after the adoption of Rule 75 B the Bar [fol. 5062] did not at once understand, and it was sometime before the Courts ruled, that the requirement for the Court's certification of a condensed statement of evidence also applied to those cases where, either by agreement of counsel or order of Court, the entire record was sent up to the Court of Appeals."

Here is a direct recognition by counsel of the fact that Courts had ruled that a condensed statement of evidence was required notwithstanding stipulation of counsel, or in other words, that stipulation of counsel would not avoid the Rule.

And continuing counsel said (page 11):

"Uncertainty still exists upon this subject, for there is a diversity of ruling in different circuits."

On page 16, counsel say:

"There has been no negligence on the part of appellant's counsel in this case. At most there has been a pardonable oversight. All of the cases which have been cited make it clear that the duty to procure the trial Judge's certification of the evidence is founded upon Equity Rule 75. (See Judge Baker's opinion in this circuit In re

Jewell Electrical Instrument Co.). Judge Baker's language is very precise in speaking of this, 283 Fed. 978, 980) as 'Appellant's duty'; for by the express terms of the Equity Rule no duty rests upon anyone until there is an 'Appellant.' If the testimony is to be condensed 'the Appellant' must first attempt that duty and then 'the Appellee' if dissatisfied. Therefore, no duty in this respect rested upon anybody until there was an appellant; that is, until July 1, 1924, or six years after Judge Humphrey died."

Here then it appears that throughout their brief counsel for appellant were discussing the matter of condensing the evidence as required by Equity Rule 75, and we have an express acknowledgment on the part of counsel for appellant that the duty did devolve upon appellant to condense the testimony at least on July 1, 1924. Yet counsel for appellant in the face of this recognition of duty went ahead and on July 3, 1925, one year later, filed the wholly uncondensed purported transcript of the evidence taken both before Judge Humphrey and the Master, and in the face of the motion of appellee filed November 9, 1925, and its supporting brief, filed on January 26, 1926, above referred to, calling attention specifically among other things to appellant's violation of Equity Rule 75, by failing to give appellee an opportunity to be heard and to obtain the lower court's ap[fol. 5963] proval and to condense the testimony, persisted in their violation, argued against it and did nothing to comply with the Rule in this respect.

In passing we feel impelled to take issue with appellant's counsel upon the correctness of the statement that

"No such thing as a certificate of evidence was known in Federal Equity practice until after the promulgation, November 4, 1912, of the Supreme Court Equity Rules, and particularly Rule 75B thereof. All that was required was that the testimony be taken down and preserved in the record. Blease v. Garlington, 92 U. S. 1."

A reference to the opinion by Mr. Chief Justice Waite in Blease v. Garlington shows that in referring to testimony taken in open court and not before an examiner, he said,

"The testimony presented in that form must be taken down or its substance stated in writing and made a part

of the record or it will be entirely disregarded here on appeal."

It will be noted that while counsel for the appellant purport to state on the authority of the Supreme Court that it "must be taken down—and preserved in the record," the Supreme Court says it "must be taken down—and made a part of the record, or it will be entirely disregarded here on appeal."

How, may we ask, could testimony taken in open court be made a part of the record without certification by the presiding judge?

While Mr. Chief Justice Waite does not state how such evidence shall be made a part of the record the statement that it must be made a part of the record assumes, we think, that it could only be done by proper certification, and that certification could only be by the presiding judge, as it is not the function of the clerk to certify evidence heard in open court. Mr. Chief Justice Waite's statement that the evidence must be made a part of the record must be assumed to have been made in the light of the law as settled and generally known and understood by lawyers at that time.

Nothing that Mr. Chief Justice Waite says in Blease v. Garlington justifies the statement that no certificate of evidence heard in open court was necessary, but rather, we think, the contrary is implied by the language of that learned jurist.

On January 29, 1926, this Court entered an order on appellant's motion for leave to transmit the printed purported transcript of record to the District Court for the purpose [fol. 5964] of applying to the District Court for further certification of the record, but expressly provided in the order at the end that "it is further ordered that the effect and validity of such certificate if obtained, shall be reserved for final determination of this cause."

Appellee's protest against the violation of Equity Rule 75, and its motion to strike were also reserved until final hearing.

On October 6, 1926, when the cause came on for oral argument counsel for appellee called attention to its pending motion and objections and filed additional reasons for the dismissal of the appeal, among which were that the order

of Judge Fitz Henry entered on March 30, 1926, as set forth in the supplemental transcript of record, filed April 13, 1926, page 4913, was entered without jurisdiction and is void, and does not amount to, or constitute a certification of the alleged evidence, and that said alleged evidence has never been certified to by the District Court, and has never been or become a part of the record in the cause, and also that it appears from the purported transcript of the record that neither the purported testimony taken on the infringement issue, or on the accounting, is complete in that it appears that out of a total of 196 exhibits received in evidence on the trial of the above issues, 114 thereof are wholly absent from the purported transcript of the record and have never been certified to by the District Judge, nor made a part of the transcript of the record filed in this Court nor have ever been filed in this Court.

The whole matter of appellant's violations of Equity Rule 75 were thus submitted to the Court by appellant with full knowledge on the part of appellant of such violation, and without any attempt having been made to rectify them.

We submit it is now too late for appellant, after it has submitted these matters to the determination of the Court, and after they have been decided adversely to appellant to now come in and ask the court to set aside its action and to permit appellant to start all over again. To allow this would be to run counter to the whole policy of the law and the Courts. In support of this we call the Court's attention to the case of United States v. Adams, 9 Wall. 554, et seq. infra, in which upon the affirmance of a judgment, appellant came in on motion to correct the record, claiming that the record from the Court of Claims was erroneous in material facts stated in it. It appeared from the affidavit of appellant in support of the motion that this error in the record was observed by him and known to his coun-[fol. 5065] sel, at the argument on the appeal, but that no steps were taken to have it corrected, their belief having been that the action of the Board of Commissioners could have no binding effect upon the rights of the claimant.

So in the case at Bar, counsel knew of the violations of Equity Rule 75 urged by appellee, among others being the failure to put the evidence in condensed and narrative form, and now say they relied on the views of Mr. Rector,

despite the imperative language of the Rule itself, and despite the fact that they knew that certain Courts had insisted that the evidence must be put in the form required by the Rule in order to be taken and considered by them, and must be held to have known that the Supreme Court of the United States in the Newton case said that the violation of this Rule in this respect might be visited by the dismissal of the Appeal, and in the Houston case had refused to consider the evidence, or an assignment of error based thereon, and yet in the face of all this they submitted this entire matter to this Court.

The Supreme Court overruled the motion in the above case on the specific ground that a party will not be allowed to lie by, with knowledge, until the matter was decided and the opinion delivered and then to apply for correction, which might have been made earlier if applied for prior to the hearing, saying:

"The courts are not willing to go further, and permit the remedy to be applied after the case is heard and decided, as we fear that such a precedent would work greater injustice and hardship in its general use and application than that which may exist in any particular case."

See to the same effect many cases cited and quoted from herein, page 30, et seq. infra.

The case at bar also differs from the other cases in a most vital and determinative respect, namely, in the other cases the whole evidence material to the appeal, though uncondensed and not in narrative form, is in the transcript of record on file in this court by stipulation and agreement of counsel on both sides, while in the case at bar, the whole evidence is not and does not purport to be in the transcript of the record on file, but on the contrary it affirmatively appears from the transcript of the record on file and by the admission of counsel in the petition for rehearing, as we shall point out that the whole evidence is not in the transcript, but is admittedly there only in incomplete, garbled and emasculated form and therefore it follows that the court should not consider the evidence in the uncondensed form in which it now appears, as counsel for appellant move, or permit it to be put in condensed and narrative

[fol. 5066] form, as counsel for appellant move in the alternative.

From the foregoing it is manifest that in the case at bar we have not a mere formal matter of putting admittedly complete and stipulated evidence in narrative form, as is the stipulation in the other cases, but a matter of starting all over again and from the beginning, in an attempted compliance with equity Rule 75.

In the other cases, as we have pointed out, the correctness and completeness of the transcript of the testimony in the record was agreed and stipulated to by counsel for both sides, and in certain of them if not all of them, with the approval of the Trial Court. It is manifest, therefore, that counsel for appellees in those cases are in no position to challenge the correctness or completeness of the transcript of the testimony. Furthermore, as we have pointed out also, counsel for appellees in those cases cannot complain of any hardship, delay or expense which may be involved, because they were equally guilty of violating Equity Rule 75.

Entirely aside from the contentions we urged from the beginning, and still urge, as to the total want of power or jurisdiction of the Trial Court to participate in putting the evidence in condensed and narrative form and thereupon approving it and causing it to be filed in the Clerk's Office and thereby making it "a part of the record for the purposes of the Appeal," the case at Bar totally differs in all of the foregoing respects from the other cases.

With the Court's indulgence we will now point out these differences and show to the Court, in addition to the reasons we have already set forth, the many other reasons why the motion of appellant to consider the evidence on this Appeal as it now appears in the transcript or in the alternative to put the same in condensed and narrative form, cannot be allowed.

In the first place, not only did appellee not stipulate or agree to the correctness or completeness of the testimony appearing in the transcript on file, but on the contrary pointed out its incompleteness and from the beginning constantly protested that it had not been given an opportunity, in violation of Equity Rule 75, to participate or be heard in the preparation of the transcript of the testimony. We

think this is abundantly shown by what we have already said and the quotations above set forth from our brief filed in this court on January 26, 1926, to which, in this connection, we again call the Court's attention.

In the second place, it follows, that in the case at Bar, unlike the other cases, it is not a mere matter of putting [fol. 5067] in condensed and narrative form an admittedly correct and complete transcript of the evidence with the exhibits introduced by both sides.

In the third place, as we have said, the purported transcript of the evidence in the record on file is not correct and complete, but is incorrect, incomplete, garbled, emasculated, and contains matter never introduced in evidence at all, all as appears from the purported transcript of the testimony itself.

We shall point this out in detail but before doing so desire to call the court's attention to a few additional considerations.

The procedure prescribed by Equity Rule 75b under which counsel for appellee are given their day in Court and an opportunity to be heard and the Trial Court or Judge is given an opportunity also to determine "if the statement be true, complete and properly prepared" as the rule specifically provides, as a condition to its being "approved" by him, is manifestly designed to insure the statement being "true, complete and properly prepared." The Rule expressly says that the condensed statement of the evidence shall be approved "if the statement be true, complete and properly prepared." This is, we submit, tantamount to saying that it shall not be approved and filed and become a part of the record for the purposes of the Appeal, unless and until it is "true," it is "complete," and it is "properly prepared," that is to say, is condensed in the manner prescribed in the Rule.

Not only did counsel for appellant fail to give the Trial Court, and also counsel for appellee, an opportunity to participate and to be heard for the purpose of insuring the transcript of the evidence being true and complete, whether in narrative form or in uncondensed form, with full questions and answers, but, as we have said, and as we will now show, it affirmatively appears from the transcript of the purported evidence itself, that if it had been presented to

the Trial Judge for his approval, he could not under the Rule have approved the same, because it is patently and indisputably not true and not complete, entirely aside from its not having been "Properly prepared."

Therefore, it is manifest beyond controversy that it is not possible to take the purported transcript of the evidence and reduce it to narrative form and have the same approved by the Trial Court, and made a part of the record, because it is not true and is not complete but, on the con-
{fol. 5068} trary, because manifestly, it will be necessary to incorporate in the condensed statement evidence that has been eliminated, and exhibits in large number that have been omitted, and also to strike from it a great deal of matter appearing in the present purported transcript of evidence that is shown never to have been put in evidence.

In other words, it is manifestly that in the present situation of this case it will be necessary for counsel for appellant, for the first time, to begin and travel the entire route step by step, prescribed by Equity Rule 75.

This we submit cannot now be done, because, first, the term having passed and the appeal having been perfected, the lower court is now without power or jurisdiction to make or change the record of the District Court and second it is against the whole policy of the law to permit this to be done at this late day and especially under the circumstances of this case, to which we have called attention.

In their petition for rehearing counsel for the appellant urge that the dismissal of an appeal or an affirmance of a decree is an unusually and unprecedentedly severe penalty for an infraction of Equity Rule 75. This contention, we believe, is without merit.

Not only in the cases cited by this court in its opinion but in numerous cases decided by other courts of last resort, appeals have been dismissed and decrees and judgments of the lower courts affirmed and a review of assignments of error based on evidence refused, because of violation of the rules of the reviewing courts requiring evidence to be condensed and printed in narrative form.

Indiana D. & W. Railway Co. v. Ditto, 64 N. E. Rep. 222 (Supreme Court of Indiana, 1902);

Cleveland C. & St. L. Ry. Co. v. Snow, 74 N. E. 908 (App. Ct. of Indiana, 1905);

Caswell v. Hopson, 43 S. W. Rep. 547 (Ct. of Civ. App., Texas, 1897);
O'Keefe v. Beecher, 117 N. W. 353 (N. D.);
Smith v. Kunert, 115 N. W. 76;
Morgan v. Chittenden Land Co., 159 Pac. 129;
Boggs v. Cullowhee, 76 S. E. (N. C.) 717.

[fol. 5069]

I.

This Court is without power to grant the motion of the appellant and decide this case upon the merits.

1. Because the appellant has not purported to embody all of the evidence in the transcript. What is referred to therein as a "certificate of evidence" is not in fact a certificate of evidence, nor is it all of the evidence, a large number of exhibits being missing. (See "Appendix.")

a) Pages 1 to 1577, purporting to be the evidence upon the infringement issue, never were certified by the presiding judge who heard the evidence on the infringement issue, nor by his successor, Judge FitzHenry.

Fairbanks Morse & Co. v. American Valve & Meter Co., Nos. 3776 & 3782, decided Dec. 22, 1926.
In re Jewel Electric Co., 283 Fed. 978 (C. C. A. 7th Cir.);
Wong Kow v. United States, 215 Fed. Rep. 95 (C. C. A. 7th Cir.);
Buessel v. United States, 258 Fed. Rep. 811, 822, 823;
Insurance Co. v. Lenier, 95 U. S. 171.

b) It was never filed, and does not purport to have been filed in the office of the Clerk of the District Court and was never thereby or in any other manner made a part of the record of the District Court.

In re Jewel Electric Co., 283 Fed. Rep. 978 (C. C. A. 7th Cir.);
Wong Kow v. United States, 215 Fed. Rep. 95 (C. C. A. 7th Cir.);
Buessel v. United States, 258 Fed. Rep. 811, 822, 823;
Insurance Co. v. Lenier, 95 U. S. 171.

c) There is no certificate of any kind, either by the presiding Judge or by the Clerk, that what Appellant has filed

in this Court as an alleged "Certificate of Evidence" is the evidence heard by the Court on the infringement issue, or that it is all the evidence heard by the Court on that issue, so it is to be presumed that the Court's findings were supported by evidence other than that which the record on appeal discloses.

Carson v. Hurt, 250 Fed. 30, 33 (C. C. A. 5th Cir.);
In re Jewel Electric Co., 283 Fed. Rep. 978 (C. C. A. 7th Cir.);
Wong Kow v. United States, 215 Fed. Rep. 95 (C. C. A. 7th Cir.);
[fol. 5070] Buessel v. United States, 258 Fed. Rep. 811, 822, 823;
Insurance Co. v. Lenier, 95 U. S. 171.

d) It affirmatively appears from the "Praecipe for Record," the transcript itself, and Appellant's counsel in open court and in the Petition for Rehearing have admitted, that the Appellant has not embodied in the alleged "Certificate of Evidence" all of the evidence on the infringement issue (See "Appendix").

In the petition for rehearing and an affidavit printed therewith it is stated, and upon the argument of Appellant's motion on January 4, 1927, Appellant's counsel admitted, that evidence had been omitted by "elimination and condensation" indulged in by Appellant's Solicitor without any consent of the court or the Appellee.

2. What the appellant has embodied in the transcript of the record as an alleged "certificate of evidence" (pages 1578 to 4591 inclusive), purporting to be the "evidence relating to accounting" cannot be the basis of any hearing in this court upon that issue because a large number of exhibits are missing.

4 C. J. 443;
Rupert v. United States, 181 Fed. (C. C. A. 8th Cir.), 87, 89;
U. S. v. 337 Cases of Wine, 1 Woods (U. S. Cir. Ct.), 47;
Reed v. Gardner, 17 Wallace, 409;
Leftwitch v. Lecanu, 4 Wallace, 187;
U. S. v. Siden, 293 Fed. 422;
Weaver v. Schumpert, 168 Fed. 43;

S. W. Va. Imp. Co. v. Frari, 58 Fed. 171;
Newport News v. Yount, 136 Fed. 589;
Peshtigo Co. v. Merchants & Shippers Agency, 82 Ill. App. (1st Dist.), 149;
Legnard v. Rhodes, 51 Ill. App. (1st Dist.), 477;
Charles v. Remick, 50 Ill. App. 534;
Tolman v. Dreyer, 50 Ill. App. 243;
Hennessy v. Metzger, 50 Ill. App. 533;
Hursen v. Lehman, 35 Ill. App. 489;
Byrne v. Clark, 31 Ill. App. 651.

a) The transcript of record does not contain any certificate whatever by the Master purporting to show that the evidence embodied in this transcript was the evidence taken [fol. 5071] and heard by him, nor does it contain anything showing that it was all the evidence taken or heard by him.

Wheeler v. Abeline Natl. Bank Bldg. Co., 159 Fed. 391, (C. C. A. 8th Cir.);

Citing

Sheffield Ry. v. Gordon, 14 Sup. Ct. Rep. 343;
Green v. Bishop, 1 Cliffe 186;
Donnell v. Columbian, Federal cases 3987;
McCourt v. Singer, 145 Fed. 103.

b) There is nothing in the transcript to show that it was the so-called evidence upon the accounting issue (pages 1578 to 4591 inclusive), nor does the transcript purport to show even a file mark on said purported evidence purporting to show when it was filed in the Clerk's office or that it was ever so filed.

c) It affirmatively appears from the "Praecipe for Record," the transcript itself, and Appellant's counsel in open court and in the Petition for Rehearing have admitted, that the Appellant has not embodied in the alleged "Certificate of Evidence" all of the evidence on the accounting issue (See "Appendix").

In the petition for rehearing and an affidavit printed therewith it is stated, and upon the argument of Appellant's motion on January 4, 1927, Appellant's counsel admitted, that evidence had been omitted from the evidence taken by

the Master by "elimination and condensation" indulged in by Appellant's Solicitor without any consent of the court or the Appellee. (Pet. p. 8.)

II

The Appellee, within seven days after the printed copies of the transcript of record were filed in this Court, called the attention of Court and counsel to the fact that the appellant, in preparing the transcript of record, had not complied with Rule 75 both by motion in writing and in open court and otherwise. The statement in the petition for rehearing that there was no motion in this Court raising this question is incorrect, although no motion on the part of the appellee was necessary.

Fairbanks, Morse & Company v. American Valve & Meter Company. No. 3776. Decided Dec. 22, 1926.

[fol. 5072] III

An order of this Court such as the appellant requests "Directing the lower court to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of the evidence in simple and condensed form" would be a nullity. The term having passed and the appeal having been perfected, the cause is pending solely in this court and the District Court has lost jurisdiction. Any act of the District Court, or any other purporting to be made by it in this cause, would be coram non judice. Such an order would direct the District Judge to do an act which (as a court or judge) he is powerless to perform. This Court ought not to direct the District Court or judge to perform a judicial act in a cause not pending in that court (except where a mandate remanding the cause is directed). (See in support of these contentions our brief filed herein on January 26, 1926, where the matter is fully discussed and many cases cited in support.)

Jennings v. Phila. B. & W. Ry. Co., 218 U. S. 255;
Mich. Ins. Bank v. Eldred, 143 U. S. 293;
Blisse v. U. S., 263 Fed. (C. C. A. 2nd Cir.), 961, 965;
Hovey v. McDonald, 109 U. S. 150; 3 Sup. Ct. 136;

First National Bank v. State National Bank, 131 Fed. (C. C. A. 9th Cir.), 430;
In re Gustin, 281 Fed. (D. C. Mich. 1922) 320;
Keyser v. Farr, 105 U. S. 265, 266;
Draper v. Davis, 102 U. S. 370;
Kendrick v. Roberts, 214 Fed. (D. C. Ga.), 268;
Omaha Elec. L. & P. Co. v. City of Omaha, 216 Fed. (C. C. A. 8th Cir.), 848, 855;
Morrin v. Lawler, 91 Fed. (C. C. N. Y.) 693;
Fed. App. Jur. and Pro. (Zoline) par. 646;
Harding v. Oregon-Idaho Co., 110 Pac. (Ore.) 412, 414.

[fol. 5073] IV

Appellant's motions are based upon a complete misapprehension and a false premise because they assume that the evidence upon both issues has been properly preserved and filed and made a part of the record and nothing remains but to condense or abstract it. This is not correct. Appellant in its petition for rehearing and motion to direct condensation of the record assumes and states that while it did not comply with Equity Rule 75 it embodied in the transcript of record a "certificate of evidence" containing all the evidence in question and answer form. This is not true. There is no certificate of evidence in this record upon the infringement issue, nor is there any certificate by the Master of any kind showing that the evidence incorporated in the transcript (purporting to be the evidence on the accounting issue) was the evidence taken and heard by him, nor any certificate by the clerk showing that it was the evidence attached to and filed with the Master's report or returned and filed by the Master in the clerk's office as the evidence taken and heard by him; nor is there any file mark shown anywhere in the transcript as to the evidence upon the accounting issue is all of the evidence taken or heard on that issue, but the contrary affirmatively appears. A check-up of the record shows that out of 196 exhibits introduced in evidence 114 are omitted from the transcript. Therefore, there is nothing in this transcript to be condensed or which anyone has the right or power to condense or reduce to narrative form. Nor could this court consider such evidence even if

condensed and reduced to narrative form. Since it would not be *all* of the evidence, it will be presumed that the decrees on both issues are supported by evidence other than that which this record discloses.

Wheeler v. Abeline Nat'l Bank Bldg. Co., 159 Fed. 391 (C. C. A. 8th Cir.);
Citing, Sheffield Ry. v. Gordon, 14 Sup. Ct. Rep. 343;
Green v. Bishop, 1 Cliffe 186;
Donnell v. Columbian, Federal cases 3987;
McCourt v. Singers-Bigger, 145 Fed. 103.

[fol. 5074] V

Although the point upon which the Court bases its decision was raised in November, 1925, over a year ago, appellant took no steps to comply with Equity Rule 75, evidently deeming it unnecessary to do so, and on October 6, 1926, submitted the case to the Court for decision.

After this Court has rendered an adverse decision, the Appellant is not entitled to have this Court reopen the case and now permit the Appellant to do what it should have done at the time it perfected its appeal or before the case was submitted.

United States v. Adams, 9 Wallace, 554;
Cimiotti Unhairing Co. v. Bowsky, 113 Fed. 699;
Barlass v. Kargus, 87 N. W. (Wisc.) 800;
Blisse v. United States, 263 Fed. (C. C. A. 2nd Cir.) 961.
Oxford & Coast Line Ry. Co. v. Union Bank, 153 Fed. 723, at 728;
Clark-Harris Co. v. Douthet, 31 Pac. (Wash.) 442;
Drake v. New York Iron Mine, 55 N. Y. S. 920;
Allen v. LeMoyne, 101 Ill. 655;
Hanson v. DeVita, 72 Atl. (N. J.) 60;
Nealan v. Ring, 193 Pac. (Ore.) 747;
Tunnicliff v. Watts, 210 S. W. (Mo.) 876;
Smith v. Gustin, 81 N. E. (Ind.) 722;
Buessel v. United States, 258 Fed. (C. C. A. 2nd Cir.) 811, 824.

VI

The appellant did not have the evidence in this cause certified by the district judge pursuant to the permission granted January 29, 1926. The only action taken by the District Court pursuant to this court's order was an order entered of record on March 30, 1926, which purports to be shown in a supplemental transcript of record filed April 13, 1926. This purported order of the District Court entered March 30, 1926, is not a certificate, does not authenticate or identify the evidence, and is a nullity.

In order to approve and certify the evidence it is necessary for the Court to indicate such approval by a certificate signed by him at the end of the evidence itself for the purpose of authentication and identification.

Insurance Co. v. Lanier, 95 U. S. 171;

[fol. 5075] In re Jewell Electrical Instrument Co., 283 Fed. (C. C. A. 7th Cir.) 978;

Wong Keow v. U. S., 215 Fed. (C. C. A. 7th Cir.) 95;

Buessel v. U. S., 258 Fed. (C. C. A. 2nd Cir.) 811, 822, 823;

Carson v. Hurt, 250 Fed. (C. C. A. 5th Cir.) 30, 33.

I

This Court is without power to grant the motion of the Appellant and decide this case upon the merits.

1. Because the appellant has not purported to embody all of the evidence in the transcript. What is referred to therein as a "certificate of evidence" is not in fact a certificate of evidence, nor is it all of the evidence, a large number of exhibits being missing (See "Appendix").

In the brief filed January 26, 1926, by the Appellee in opposition to Appellant's motion for transmission and certification of evidence, we pointed out (pages 35 and 36) that what is referred to in the Præcipe for Record as a "Certificate of Evidence" is not and could not be any evidence which was ever filed in the District Court. The "Præcipe for Record" will be found in the printed transcript of rec-

ord, on pages 4873-4875, inclusive. It was filed in the office of the Clerk of the District Court and a copy served on counsel for appellee on April 24, A. D. 1925. It directed the Clerk to prepare a transcript of the record, "including therein copies of the following: * * * Certificate of Evidence, consisting of printed pages 24 to 1215, inclusive, pages 1222 to 4951, inclusive, and the following exhibits" (Here follows a list of certain memoranda, statements and exhibits).

Printed pages 24 to 1577 inclusive purport to be the evidence heard by the late Judge Humphrey upon the infringement issue. They will be found in what are marked on the outside as "Vol. I", "Vol. II", "Vol. III" and "Vol. IV." There is no certificate of any kind, either by the Clerk or by a Judge, in any of these volumes. The only certificate that purports to relate to this evidence on the infringement issue is the Certificate of the Clerk which is found at the end of Vol. IX, on page 4876. This certificate is as follows:

"I, S. T. Burnett, Clerk of the District Court of the United States for the Southern District of Illinois and keeper of the records and seals thereof, do hereby certify [fol. 5076] the foregoing to be a true and complete transcript of the proceedings had of record in said court consisting of nine (9) volumes, paged from 1 to 4877, inclusive, in a certain cause entitled Standard Asphalt & Rubber Company, a corporation, v. Barber Asphalt Paving Company, a corporation, No. 25, in equity, said transcript having been prepared in accordance with praecipe filed therein, as fully as the same appear from the records of said court now remaining in my custody and control.

In Testimony whereof I have hereunto set my hand and affixed the Seal of said Court, at Springfield, in said district, this 24th day of June, A. D. 1925.

S. T. Burnett, Clerk."

First it should be noted that the Praecipe does not direct the Clerk to embody the "Certificate of Evidence," or a copy of the "Certificate of Evidence," on file or on record in his court or any evidence whatever on file or of record in his court on either the infringement or accounting issue, but "Certificate of Evidence consisting of printed pages 24 to 1215 inclusive, 1222 to 4591 inclusive," etc., which does

not purport to be on file or of record nor all of such evidence.

In his præcipe, counsel for appellant then proceed to itemize certain exhibits which they instruct the clerk to include in the transcript of record. It appears upon the face of the præcipe that these are not all of the exhibits but only a part of them, and the clerk only certifies that the transcript contains what the præcipe calls for.

In Carson v. Hurt, 250 Fed. 30, at 33 (C. C. A. 5th Cir.), it was expressly pointed out that in the absence of a certificate by the trial court that the evidence contained in the transcript is all the evidence, it will be presumed that there was other evidence to support the findings, the court saying:

"The record contains a statement of evidence adduced by the opposing parties, which their respective counsel certified was "examined and found correct.' This statement was not approved by the court or judge, pursuant to equity rule 75 (198 Fed. x l, 115 C. C. A., x l). Nothing in it shows that it contained all, or the substance of all, the evidence adduced. The contrary not appearing, it is to be presumed that the court's findings were supported by evidence other than that which the record on appeal discloses."

In Nadeau v. Lynch, 183 Pac. 278 (Cal. App. Ct.), it was held that where testimony is taken upon appeal the judge must certify all the evidence, and where there is obviously [fol. 5077] more, the Appellate Court will not disturb findings of fact.

And in Larson v. Seattle, 208 Pac. (Wash.) 34, the certificate of the trial judge stated that the transcript contained all the evidence which appellant asked him to certify, and not that it contained all the evidence. The transcript is stricken, on motion.

It has been squarely held, and necessarily so, that even where the certificate of the Judge recites that it is all the evidence, yet, if it appears from the transcript of the evidence itself that it is not all the evidence, the court on review will refuse to consider it.

Bell v. Bell, 56 Pac. (Kas.) 471.

School District v. Trotter, 64 Pac. (Okla.) 9.

Evidently, counsel for the Appellant have proceeded upon the theory that under Equity Rule 75 Appellant's counsel

can, by præcipe, "indicate the portions of the evidence to be incorporated in the transcript." In other words, counsel have evidently construed paragraph A of Rule 75 to permit Appellant's counsel to pick out certain portions of the evidence which they desire incorporated in the transcript of record, instead of having the evidence incorporated into the record in accordance with paragraph B of Rule 75, requiring the "true, Complete and properly prepared" evidence to be approved, certified, filed and made of record. It requires no argument to show that paragraph A, providing for a "præcipe which shall indicate the portions of the Record to be incorporated in the transcript," does not authorize a solicitor to pick out or indicate such portions of the Evidence as he desires incorporated in the transcript of the record, if he expects this court to review questions of fact or mixed questions of law and fact.

It is quite apparent from the præcipe and the record, as well as from the statements in the petition for rehearing, that counsel for Appellant have frankly assumed to designate, by a præcipe, the portions of the evidence to be incorporated in the transcript on the theory that they can "prepare" the evidence under paragraph A instead of having it condensed under the supervision of the District Judge under paragraph B. In other words, counsel for the Appellant have ignored paragraph B of Rule 75, and have prepared the evidence as though they had a right to designate what evidence they wished included under Paragraph A.

Of course, this Court cannot pass upon questions of fact, or mixed questions of law and fact, without having all the evidence in the record before it. It is one thing to con- [fol. 5078] dense "true" and "Complete" evidence into narrative form under the supervision of the District Judge at a hearing at which both sides are represented as prescribed by Equity Rule 75; it is quite a different thing for counsel for Appellant, by his ex parte act, to "eliminate" evidence altogether from the transcript.

Since the præcipe itself merely designates certain exhibits, omitting other exhibits, and since the Certificate of the Clerk certifies that the transcript was "prepared in accordance with præcipe filed herein," it is quite apparent that the Clerk does not purport to certify that all of the evidence is embodied in the transcript of the record. In

any event, the contrary appears from the purported transcript of the evidence itself.

Furthermore, it appears from the petition for rehearing and the affidavit of Henry N. Paul, Esq., one of the counsel for the appellant, that the nine volumes of purported printed transcript of record were printed before the præcipe for record was filed or served upon counsel for appellee and do not contain all the evidence.

In his affidavit Mr. Paul says (Petition for rehearing, pp. 37-38):

"The decision of the Court of Appeals in this case would leave the impression that after the perfecting of this appeal on July 5, 1924, nothing was done until April 24, 1925, when for the first time a præcipe was served upon plaintiff. As a matter of fact, it was during this interval that the record was made up and printed."

Therefore, the entire transcript of record was prepared and printed in nine volumes, and after it was printed a Præcipe for Record was filed with the Clerk on April 24, 1925, which designated the things which had already been printed in the transcript of record.

By the Præcipe the Clerk was directed to include in his record, as purported certificate of evidence, not the evidence given in the case below, before the court or the Master, but something which Appellant's counsel had already prepared and printed prior to the filing of the Præcipe for Record and not something which was then on file and of record in the Clerk's office and certain selected exhibits.

This is reversing the procedure provided by Equity Rule 75a. Manifestly, these printed pages had not been filed or made of record in the office of the Clerk of the District Court either at the time of the hearing by Judge Humphrey on the infringement issue or at the time of the entry of the [fol. 5079] decree, or at the time of the filing of the Master's Report, upon the accounting issue or at the time of entry of the decree thereon.

It does not appear from the transcript of the record that these nine volumes (printed copies of which have been filed in this Court) were ever filed in the District Court. Not only does the transcript of the record fail to embody any certificate by Judge Humphrey or his successor in reference to the evidence in volumes 1 to 4 (purporting to be the

evidence on the infringement issue), but the certificate of the Clerk does not certify that the copy of the evidence in the printed transcript, from pages 24 to 1577, is a true copy of the evidence taken and heard by Judge Humphrey, nor that it is a true copy of the evidence filed in his office, nor a fortiori that it contains all of the evidence taken or heard by Judge Humphrey upon the infringement issue nor all the evidence upon which the original decree of February 20, 1917, was founded, but merely that it is a transcript prepared in accordance with a praecipe (which itself shows that it designates only a part of the evidence).

Of course, there is nothing anywhere in either Vol. I or Vol. II, III, IV, to identify it as the same volume referred to by the Clerk of the District Court in his certificate at the conclusion of Vol. 9. On the other hand, it affirmatively appears, from an inspection of that part of the printed transcript which purports to contain the "Certificate of Evidence" that it is not complete nor correct. For example, in Vol. IV, page 1517, there is purported to be set forth defendant's Exhibit 16. The page, however, does not contain the exhibit, but is blank.

Vol. IV, page 1519, purports to set out defendant's exhibit 17, but again the page is left blank.

Vol. IV, page 1543, purports to set forth "Defendant's Exhibit Pennyman Chart" but the page is left blank.

Vol. IX, pages 4732, 4733, 4734, 4735, 4736 and 4737 contains memoranda which do not purport or appear to be exhibits introduced in evidence. They are entitled "Choctaw Memorandum," "Memorandum Tank Steamers," "Losses of the Trinidad Lake Petroleum Co. from the Abandonment of Wells," "The Uintah Railway Co.," "Relationship of B. A. P. and Affiliated Companies," etc. There is nothing to show that these written memoranda were ever introduced in evidence.

On page 4746 there appear to be memoranda in reference to questions 230, 231 and 672.

[fol. 5080] On page 4747, memoranda in reference to question 636.

On page 4748, memoranda in reference to questions 678 and 352.

There is nothing to show that any of these memoranda were introduced in evidence.

On pages 4776 and 4777 there appears what purports to be "Defendant's Exhibit D," which purports to be a statement of income and costs for accounts considered in manufacturing profit shown on Exhibit C. The transcript of record filed in this Court nowhere shows that this Exhibit D was ever introduced in evidence.

Before a court of review can pass upon and review a decree entered in an equity cause in the District Court involving a question of fact or a mixed question of fact and law, it is manifest that there must be brought before it all of the evidence taken or heard in the District Court. Not even the Clerk himself certifies that the unidentified Volumes 1 to 4 (which we are supposed to assume are the same volumes referred to in the Clerk's certificate in Vol. IX) embody all of the evidence.

A careful examination of the contents of volumes 1 to 4, if assumed to be the same volumes referred to in the Clerk's certificate in Vol. IX) disclosed on their face that a large number (fourteen) of the Appellee's exhibits introduced upon the infringement issue before Judge Humphrey are not included in the alleged "Certificate of Evidence" on this issue. A large number of the Appellant's exhibits, introduced upon the issue of infringement before Judge Humphrey are not included in the printed volumes, and therefore not brought up on the appeal. (See Appendix.)

It will therefore be apparent to the Court that the objection that there is no certificate either by the Judge (who alone can make it) or by the Clerk that pages 24 to 1577, contain all of the evidence heard by Judge Humphrey upon which he bases his decree of February 20, 1917, is not a mere technicality. On the contrary, there is presented to this Court by the Appellant a record in which a large number of exhibits (which the Appellant's own record shows were introduced both by the Appellant and by the Appellee) are deliberately omitted. An itemized list of the Appellee's exhibits which are shown by printed volumes 1 and 2, to have been introduced in evidence, tabulating those which are included in the printed record and those which have been omitted, and an itemized list of Appellant's exhibits which volumes 1 and 2 show were introduced before Judge [fol. 5081] Humphrey, itemizing those which are included in the printed transcript and those which are omitted from

the printed transcript, will be found in an "Appendix" attached to this answer.

The "Appendix" shows on its face the page of the printed transcript where each exhibit is introduced, and shows whether the exhibit is included in the transcript or whether it has been omitted therefrom by the Appellant.

Upon the face of the printed transcript filed by the Appellant it is manifest that all of the documentary evidence at least which was introduced before Judge Humphrey and considered by him as the basis of his decree of February 20, 1917, is not in the printed transcript of record and is not befor- this Court.

Under these circumstances, how is it possible for this Court to "reconsider and decide this cause upon the merits?" or how is it possible for this Court to direct that it be put in condensed and narrative form and then to consider it.

The data in the appendix is taken from the motion which we filed in this Court on October 6, 1926, in connection with our motion to dismiss the appeal. A copy of this motion, together with the data in the appendix, was served upon Appellant's counsel and presented to this court in open court on October 6, 1926. Therefore, counsel for the Appellant cannot say that it comes as a surprise. The omission of so large a number of exhibits cannot be due to an oversight on the part of Appellant's counsel. It is not attempted to be explained in their petition for rehearing, but in the face of the fact that we called the Court's attention to the omission of this great number of exhibits from the printed transcript filed in this Court, the Appellant's counsel, in their petition for rehearing, without any reference to the fact that parts of the evidence are missing, calmly as this Court to "decide this cause upon the merits."

Where exhibits are not brought up on appeal with the other evidence taken and received on the trial of the cause, all of the evidence is not before the Court and therefore the cause cannot be reviewed on the evidence and the appeal must be dismissed.

In support of these suggestions see "Appellee's Brief in Opposition to Appellant's Motion for Transmission and Certification of Evidence" filed herein January 26, 1926.

In 4 C. J. 443, it is said:

"Papers included in, referred to, or annexed to the transcript, case made, abstract of record, bill of exceptions, etc., on appeal must also be authenticated and identified or they [fol. 5082] will not be considered by the Appellate Court," citing many cases.

In Rupert v. United States, 181 Fed. (C. C. A. 8th Cir.), 87-89, it is said:

"Courts make the records, and the trial judge must sign the bill of exceptions. The clerk is without authority to certify up anything, except that made of record by the orders of the court."

In U. S. v. 337 Cases of Wine, 1 Woods (U. S., 5th Cir.) 47, certain depositions were not put in the bill of exceptions at the time of the certification, but were added two months later by the Clerk. It was held that the Judge is the only one to certify and his certificate must extend to any exhibits to be brought up so as to fully identify them.

In Reed v. Gardner, 17, Wallace 409 the Clerk incorporated exhibits in the transcript but which were not contained in the bill of exceptions certified to by the Court, and the Court on appeal refused to consider the exhibits saying, "depositions, exhibits or certificates not contained in the bill cannot be considered by the court."

Leftwitch v. Lecanu, 4 Wallace 187, is to the same effect.

U. S. v. Siden, 293 Fed. 422, holds that exhibits must be put into the bill of exceptions, and follows and quotes from Reed v. Gardner, 17 Wallace 409.

In Weaver v. Schumpert, 168 Fed. 43, documents were sent up with the bill of exceptions, but not identified by the Trial Judge, and it was held they must be so identified. The court said, page 44:

"The bill of exceptions is insufficient, as the trial judge does not by marks or numbers or paragraphs identify the papers not incorporated in, but intended to be made part of, the bill."

To the same effect see S. W. Va. Imp. Co. v. Frari, 58 Fed. 171.

Newport News v. Yount, 136 Fed. 589, to the same effect.

In Peshtigo Co. v. Merchants & Shippers Agency, 82 Ill. App. (1st Dist.,) 149, the bill of exceptions concluded its statement of the evidence as follows:

"Which, with documentary proof referred to and to be inserted, was all the testimony offered on the trial of said cause by either of the said parties."

It appeared that but 2 out of the 8 exhibits offered in evidence and read to the jury were certified to by the court and filed in the Appellate Court. It was contended that [fol. 5083] counsel for Appellee refused to furnish copies or to permit counsel for Appellant to take copies of such exhibits.

The court held, however, that nothing appeared in the record with reference to any such refusal and consequently it was apparent that the bill of exceptions was not complete and the judgment of the court below must be affirmed, the court saying:

"As all the evidence produced at the trial is not before us, we must presume that the judgment was justified by such evidence, even if we felt at liberty to interfere with the verdict of the jury, on evidence which the incomplete evidence before us shows was conflicting."

In Legnard v. Rhodes, 51 Ill. App. (1st Dist.,) 477, the court said:

"It is shown by the bill of exceptions that the defendant below offered in evidence more than one hundred exhibits in writing, and the plaintiff offered several more like exhibits, and not one out of the entire number on both sides, are with the bill of exceptions, or in any way certified to us by the trial court.

"A large bundle of what may be exhibits offered on the trial, has been filed in this court, but they are not entitled in any cause and are not certified by the judge below, and we are not at liberty to regard them."

Subsequently it was made to appear that the exhibits spoken of had been detached from the record in some unauthorized manner and an order was entered that the record in the cause be restored to the condition in which it

was filed in the Appellate Court. Thereupon, upon rehearing, however, the court said:

"The exhibits referred to in the former opinion now appear tied together and attached by a string to the bill of exceptions, but with no additional authenticity lent to them. As has been repeatedly held by this court as well as by the Supreme Court, we can not look at those exhibits. It will be presumed they justify the judgment of the court below. Stock Quotation Telegraph Co. v. Board of Trade, 144 Ill. 370; Hennesy v. Metzger, 50 Ill. App. 533; Charles v. Remick, 50 Ill. App. 435, where the earlier cases are referred to. The petition for a rehearing will therefore be denied."

In Charles v. Remick, 50 Ill. App. 534, at 535, it was said:

"Between the last sheet of the bill of exceptions bearing the signature of the judge who heard the case, and the wrapper inclosing the whole and having the file markings [fol. 5084] of the case, are to be found seventeen separate sheets bearing marks of 'Exhibits' and letters, as above mentioned.

"We cannot say that these papers marked 'Exhibit's' are the same papers offered in evidence. The trial judge nowhere states them to be such, and it is to his certificate alone that we can look to ascertain what evidence was before him. As stated in the authorities cited, his signature, and nothing else, imports the truth."

And page 536:

"The papers referred to, and marked 'Exhibits,' never having been certified by the judge whose certificate precedes them, as being the papers introduced in evidence, there is no one else who can give authenticity to them. The certification by the clerk to the record is not enough."

In Tolman v. Dreyer, 50 Ill. App. 243, the exhibits were not certified to but were inserted in the bill of exceptions following the certificate of the clerk, and the court refused to consider them.

In Hennessy v. Metzger, 50 Ill. App. 533, it was held that exhibits to become part of the record must be incorporated into the body of the bill of exceptions preceding the signature of the judge.

In Hursen v. Lehman, 35 Ill. App. 489, it was held that exhibits attached to the bill of exceptions after the signature of the judge cannot be considered.

In Byrne v. Clark, 31 Ill. App. 651, certain exhibits were omitted. The parties stipulated they might be incorporated by the clerk. It was held that the determination of what should go into the bill of exceptions is a judicial act and cannot be delegated, and that therefore the exhibits would not be considered on appeal.

The omission of these exhibits is an insurmountable objection to a consideration of this case upon the merits.

2. What the appellant has enrolled in the purported transcript of the record as an alleged "certificate of evidence" (pages 1578 to 4591 inclusive), purporting to be the evidence "relating to accounting," cannot be the basis of any hearing in this court upon that issue.

Nowhere in the printed volumes filed in this Court, purporting to be a transcript of the record, is there included any certificate by the Master purporting to show that the evidence which the Appellant has embodied in this transcript as the evidence heard by the Master upon the accounting [fol. 5085] issue was in fact the evidence taken and heard by him, and the transcript does not contain anything showing that it was all of the evidence taken or heard by the Master.

As we have already stated, in the Praecipe for record, there is included a "Certificate of Evidence consisting of pages 24 to 1215 inclusive, pages 1222 to 4591 inclusive, and the following exhibits," etc. We have already discussed what purports to be the "Certificate of Evidence" consisting of printed pages 1 to 1577 inclusive. Here again we find that Appellant's counsel have assumed the right to pick out certain exhibits to be included and omit others. We shall now discuss the "Certificate of Evidence" consisting of printed pages 1578 to 4591 inclusive.

Pages 1578 to 4591, inclusive, will be found in volumes 5, 6, 7 and 8. None of these printed volumes contain any certificate of any kind. The only certificate which purports in any way to relate to or certify in respect to the evidence in these volumes upon the accounting is the general certificate of the Clerk to which we have already referred (p. 4876), which certifies that it is prepared according to the

praecipe. As we have already pointed out, this certificate is not sufficient to enable this Court to pass upon the merits of this cause.

Referring to the certificate of the Clerk which we have above set forth, what we have already said as to the evidence purporting to have been heard by Judge Humphrey applies equally to the evidence printed in this transcript purporting to be evidence taken and heard by the Master.

Just how the Clerk of the District Court could make a certificate under any circumstances with reference to evidence heard by a Master as to whether or not it was all the evidence which he heard we confess we are at a loss to know. But the Clerk does not purport to undertake to so certify. The Clerk's certificate extends only to proceedings "had of record in said court" and includes only what is designated by the praecipe.

The certificate is silent as to whether or not the purported evidence contained on pages 1578 to 4591 of the printed record was the evidence heard by the Master, nor does the certificate state whether or not the evidence in the printed record which purports to relate to the accounting was attached to the Master's report or returned with the Master's report or filed by the Master. One looks in vain through the printed pages to even find any file mark with respect to this evidence. If it was filed by the Master [fol. 5086] in the Clerk's office, we would be glad to have counsel for Appellant inform us as to where the file mark is shown in the printed transcript of record, as we have searched for it in vain.

"A Master's findings of fact upon evidence taken by him cannot be impeached upon appeal in the absence from the record of this certificate or other competent proof either that the evidence presented is the entire evidence taken by him or that it contains all the evidence which was before him relating to the specific finding or findings challenged."

Wheeler v. Abilene National Bank Building Co., 159 Fed. 391 (C. C. A., 8th Circuit), citing

Sheffield Railway v. Gordon, 14 Sup. Ct. Rep. 343, 151 U. S. 285.

Green v. Bishop, 1 Cliff. 186.

Donnell v. Columbian, Fed. Cases 3987.

McCourt v. Singers-Bigger, 145 Fed. 103.

Exhibits Introduced Before Master on Accounting Issue Omitted from Transcript

With respect to the exhibits introduced before the Master on the accounting issue, the printed transcript of record filed in this Court is absolutely incomplete. A number of exhibits which the transcript of record itself shows were introduced in evidence are omitted (See "Appendix").

The statement in the printed petition for rehearing on page 23 of this subject is enlightening:

"The Master in this cause was an elderly gentleman over eighty years of age. He died before the appeal. He had left the papers filed by him with his report in great confusion. Many were unidentified. Many were duplicated. Many tables of figures submitted by the accountants had informal pencilings in the margin. To straighten this out and produce the accounting exhibit book (Vol. IX) of the record involved several months of hard labor. The official printer of this court was in charge of printing this record, he made numerous trips to Springfield and Philadelphia in the effort to properly prepare this part of the record. There has been a great deal of condensation as a result of his labors and those of counsel."

This statement is further amplified in the affidavit of Henry N. Paul, Esq., printed in the petition for rehearing. We quote from page 38 of that printed petition as follows:

"The accounting papers which had been filed by the [fol. 5087] Master with his report were very voluminous and left by him in great confusion. He had died and the official printer of this court to whom had been entrusted the preparation and printing of this record, in consultation with appellant's local counsel in Springfield, spent many months' difficult labor in straightening out these accounting exhibits. A great mass of confused schedules, lists, calculations and accounts were found among the papers filed by the Master with his report, some identified and others not so marked. Many were duplicates. Others were duplicates except for additions or marginal pencilings. An immense amount of elimination and condensation was therefore performed. This involved voluminous correspondence between Springfield and Philadelphia, and a great

many trips of counsel or the printer. After many months' hard labor there was produced the present condensed accounting Exhibit Book (Vol. IX), which in any future condensation of the record, will not need or admit of much further condensation."

In this affidavit Mr. Paul also states (Petition for rehearing, page 38):

"In making up the printed record a great deal of the accounting record on file was carefully eliminated, thereby reducing the record, and when this had been done the praecipe, which had been deferred for this purpose, was prepared and served."

The sworn statement of one of counsel for the Appellant in the affidavit above referred to that, with respect to the exhibits introduced before the Master, an "immense amount of elimination and condensation was therefore performed" shows clearly that all the exhibits are not included in this transcript of record. This "elimination and condensation" was not "performed" under the supervision of the District Judge at a hearing at which the Appellee was represented, nor was it even done in conference with counsel for the Appellee or by stipulation or agreement. Counsel for the Appellant boldly admits that a number of exhibits were eliminated by the Appellant's counsel on their own responsibility without consulting the District Judge or counsel for the Appellee, or anyone. It is one thing for the record to be condensed under the supervision of the presiding Judge of the District Court at a hearing where both parties are represented; it is quite a different thing for one party, in preparing a record for appeal, to deliberately omit part of the evidence and call it "elimination and condensation." [fol. 5088] What right has counsel for one party, in the absence of the Judge and the opposite party, to perform what he calls "elimination and condensation of the record?" It is purely an act of emasculation totally unauthorized by any procedure.

In the face of the sworn admission by Henry N. Paul, Esq., one of counsel for Appellant who is of record in this cause in this court, that in "making up the printed record a great deal of the accounting record on file was carefully

eliminated, thereby reducing the record" is the evidence in this printed transcript to be treated as all of the evidence in the record?

The Clerk does not certify that it is all the evidence, and with the affidavit of counsel for Appellant in the record showing that it is not all of the evidence but that counsel for Appellant independently and without any authority and without consulting either the District Judge or the Appellee has "carefully eliminated a great deal of the accounting record" upon his own responsibility, how can the Court possibly "decide this case upon the merits" or "make an order directing the lower court to bring about a statement of the evidence in simple and condensed form" and then decide the case upon the merits.

In the face of these sworn statements by one of counsel for the Appellant in an affidavit filed in this court, what becomes of the statement in the petition for rehearing that "Appellant's counsel in the present case had every reason to believe, and did believe, that this court shared the view of these other Circuit Courts of Appeal and would adhere to its similar practice, and that in obtaining certification of a complete transcript of the evidence such counsel were only doing that which was in accordance with the long recognized practice of this court." (Petition for rehearing, page 3.)

This statement is made to appear absolutely disingenuous and incorrect by the affidavit of Mr. Paul, as they did not "obtain certification of a complete transcript of the evidence." Counsel for the Appellant undertook to censor the evidence and to eliminate a "great deal of the accounting record."

Counsel for the Appellant eliminated from the record what he wanted to eliminate, without any right or authority and without any attempt to comply with equity rule 75. Now we have a record in which the evidence is neither "true" and "complete" nor as equity rule 75 prescribes condensed under the direction of the District Court into narrative form. It is neither one thing nor the other. Is it possible that the learned counsel for the Appellant did not know that they had no right to emasculate the record secretly and privately, in the absence of the District Judge and in the absence of the Appellee, and then file it as purporting to be [fol. 7089] a complete certificate of evidence?

Appellant's counsel, after having submitted the case to this Court for a determination upon the merits, with a certificate of the Clerk which they claim showed that it was a complete record, now admit in their petition for rehearing and in their affidavit filed after this Court has decided the case, that counsel for the Appellant themselves, without consulting anyone, deleted and eliminated evidence from the transcript.

The statements in the petition for rehearing and in the affidavit of Mr. Paul were intended to excuse the long delay in the filing of the transcript of record on appeal, but they show other things which make it quite apparent that what has been filed in this Court as a "Certificate of Evidence" does not contain all the evidence but is admittedly and confessedly incomplete.

The explanation given in the petition for rehearing and the affidavit that it was necessary for the "official printer" to make numerous trips to Philadelphia and that the preparation of the record involved voluminous correspondence between Springfield and Philadelphia appears to confirm what we have repeatedly stated about the evidence purporting to have been taken by the Master. If this evidence was returned by the Master with his report or filed by him in the Clerk's office, it is difficult for us, and probably will be for the Court, to understand why it should be necessary for the printer to make numerous trips to Philadelphia or necessitate a "voluminous correspondence between Springfield and Philadelphia" in order to print what should have been on file in the Clerk's office at Springfield.

As it must be clearly apparent that all of the evidence on either the infringement or the accounting issue is not included in the record, or shown by any certificate to be included, this Court cannot comply with the Appellant's motion to "reconsider and decide this cause upon the merits." The same difficulty confronts the Appellant in respect to its motion for an order directing the lower court to now proceed to prepare a statement of the evidence in simple and condensed form.

Counsel for Appellant either did not understand or ignored Equity Rule 75. They have no right by praecipe to direct the clerk to incorporate anything in the transcript of the record that was not part of the record and hence could

[fol. 5090] not by præcipe direct him to put into the transcript of the record any evidence until after the "true" and "complete" certificate of evidence had been approved by the trial Judge and filed in the office of the Clerk and thereby made a part of the record in the cause. When this had been done, then and only then had they the right to direct the clerk to incorporate the evidence in the transcript of the record on appeal. The meat and kernel of Equity Rule 75 is clearly stated by this Court in Fairbanks Morse & Co. v. American Value & Meter Co., Nos. 3776, 3782, decided Dec. 22, 1926, as follows:

"On appeal this court, in a sense, hears the case de novo, but it must not be forgotten that it hears it not as a trial but as a reviewing court. The case is heard here upon such parts of the record, made in the court below, as the parties deem necessary to review certain questions raised and decided there. The record in the trial court ordinarily consists of the process, pleadings, report of the master, if there be one, and the decree. The evidence is not of itself part of the record, but may be made so 'in case of appeal' only in accordance with clause (b) of Equity Rule 75. When the evidence has been so made a part of the record in the court below, clause (a) of the rule provides how it may 'be incorporated into the transcript on such appeal.' Except as provided in Equity Rule 77, litigants have no power to stipulate what the record here shall contain."

Of course, if all of the evidence was not brought up appellant cannot have a review of any questions of fact or mixed questions of fact and law. Carson v. Hurt, 250 Fed. 30 at 33 (C. C. A. 5th Cir.).

II

The appellee, within a few days after the printed copies of the Transcript of Record were filed in this Court, called the attention of Court and Counsel to the fact that the appellant, in preparing the Transcript of Record, had not complied with Rule 75, both by motion in writing and in open court and otherwise. The statement in the petition for rehearing that there was no motion in this Court raising

this question is incorrect, although no motion on the part of the appellee was necessary.

First. The first reason stated by the Appellant in its petition for rehearing is

(1) "There has been no motion by Appellee in this case to [fol. 5091] dismiss this appeal because the record has not been condensed, although this court in its opinion seems to have based its action on a belief and statement that such a motion exists."

This statement is, in our view, inaccurate and apparently inexcusably so.

This Court has in its opinion stated succintly the chronology of this appeal. On November 9, 1925, (seven days after the required number of printed copies of the record were filed in this court) Appellee, pursuant to a written notice to the attorneys for the Appellant, presented a motion in open court. One ground for this motion not only is expressly and specifically based upon the provisions of Equity Rule 75, but the verbiage of Rule 75 is embodied in the grounds for the motion.

The Rule requires that after the Appellant's solicitors have condensed the evidence and lodged it in the Clerk's office he shall, pursuant to notice to the opposite solicitors, ask the Court to "approve it."

The Rule then provides that "if the statement be true, complete and properly prepared it shall be approved by the court or judge."

One of the reasons assigned for the motion to strike the evidence and testimony from the purported transcript was that what purported to be the evidence (upon which the decree of infringement of February 20, 1917, was predicated) "was not approved by the court or judge before whom said cause was tried * * * and was never filed with such approval * * * in the office of the Clerk of the District Court * * * all as required by Rule 75 of the rules of Courts of Equity of the United States."

While the language in Equity Rule 75 does not specifically require the evidence when reproduced in the form of a statemen- in condensed form and approved by the court or judge to be "certified" or "authenticated" by the hand of the court or judge before whom the case was heard, this

court has held (in the cases already cited in our brief) that it is requisite that it be "certified" or "authenticated" by the court or judge.

Insurance Co. v. Lanier, 95 U. S. 171.

In re Jewell Electrical Instrument Co., 283 Fed. 978, (C. C. A. 7th Circuit).

Wong Keow v. U. S., 215 Fed. Rep. 95 (C. C. A. 7th Circuit).

[fol. 5092] Buessel v. U. S., 258 Fed. (C. C. A. 2nd C.) 811, 822, 823.

Carson v. Hurt, 250 Fed. (C. C. A. 5th C.) 30, 33.

In other words, while Equity Rule 75 is silent as to the manner in which the judge or court before whom the cause was heard shall express his approval of the statement of the evidence required to be prepared under that rule, it has been construed by this Court to mean that the Court or Judge cannot express his approval of the statement of the evidence verbally or by an order of record, but must do so by a "certification" or "authentication" under his hand, as is required in the case of a bill of exceptions.

In the same paragraph, in the grounds set forth in support of the motion, we further pointed out that what purported to be the evidence in this transcript of record had never been "authenticated" or "certified" by the Court or Judge "all as required by Rule 75 of the Rules of Courts of Equity of the United States."

Having called attention to the violation of Rule 75, which is devoted almost entirely to prescribing the manner in which the evidence shall be incorporated into the record, we do not see how appellant can justify the statement which it makes in its petition for rehearing, on page 2 and again on page 4, that there was no motion by appellee to dismiss this appeal "because the record has not been condensed," when that is what Rule 75 required. It is true this ground for appellee's motion did not use the precise words "because the record has not been condensed," neither did it repeat or embody the whole rule in ipsissima verbie, but there is no magic in those particular words and the Appellant's counsel to make their argument appear convincing have not only embodied a garbled statement of the grounds for the Appellee's motion but have actually misquoted its language.

Appellant's counsel in their petition (page 4), in reference to Appellee's motion, in referring to the reasons (which were set forth in writing and attached to the motion) state that "the third was upon the ground that the evidence was not proved and certified to by the lower court, lacking any 'certificate of evidence.'" The words "Certificate of Evidence" are quoted as from the objection.

The Court will look in vain for the words quoted from the third reason in support of Appellee's motion referred to.

There are no such words used in the third paragraph of the reasons in support of Appellee's motion, and the quoted words, not being in the original, are incorrect and misleading.

[fol. 5093] This is not the only incorrect statement on this subject. The very next quotation in the petition is also incorrect.

In their petition, in quotation marks, counsel give what purports to be a quotation from the third reason for said motion, as follows: "never became a part of the record in said cause for the purposes of the appeal herein or as required by Rule 75," etc. Whereas, in the reasons assigned in support of the motion the quotation (which is picked out from the middle of a sentence and therefore gives a peculiarly misleading impression) is "all as required by Rule 75."

The appellant's solicitors follow this by a statement that "in this motion nothing was said about the matter of a condensed record," ignoring the fact that the condensation of the evidence is the subject matter of the rule (so far as that rule relates to evidence). Rule 75, the violation of which is given as one of the reasons for the motion to strike, is devoted in large part to the provision for "a condensed record." That is what the Rule itself is about, and the Appellee having expressly stated as one of the reasons for its motion the fact that the requirements of Rule 75 with respect to the evidence had not been complied with, it appears to us to be a disingenuous quibble to make a statement that the Appellee had not made any motion on that ground. When followed by a garbled misstatement of the reasons in support of Appelle's motion embodying two actual misquotations, what more need be said?

On the same date the Appellee in open court presented to the court and filed as a part of the same document in op-

position to the Appellant's motion, reasons why the Appellant's motion should be denied, and in setting forth the reasons in varied form included, among others, that:

"The purported evidence appearing in the purported transcript of the record filed herein is not stated in simple and condensed form and the purported testimony of witnesses is not stated in narrative form, but on the contrary thereof, said purported evidence and testimony is set forth in full, all contrary to Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof all of said evidence and testimony should be stricken from the purported transcript of the record in said cause and disregarded by this Court."

The reasons stated in support of a motion or in opposition to a motion are no part of the motion but are intended to appraise the opposite party and the Court of the reasons why the motion should be granted. Unless otherwise [fol. 5694] required by the rules, these reasons may be stated orally or in writing. In this case the reasons were stated both orally and in writing.

The motions by the Appellee and the Appellant above referred to were made in open court on November 9, 1925, nearly fourteen months ago. Can the Appellant now at this late date plead ignorance of the application of Equity Rule 75 to this case?

Whatever may have been the reasons which control its solicitors in attempting to file the evidence without any authentication by the presiding judge and without condensing it into narrative form, its failure to comply with that rule after its attention had been called to its violation on November 9, 1925, cannot be justified. It knew then that the Appellee was making its motion, based upon the violation of the requirements of Equity Rule 75, because the failure to comply with the requirements of that rule were stated verbally and in writing as one of the reasons for the Appellee's motion.

Furthermore, as we have already shown, this whole matter was urged and argued by appellee and answered by appellant in their brief filed in January, 1926. (See ante, page 10 et seq.)

Yet notwithstanding this, although the Appellant, after waiting sixty days, moved to remit the record to the District Court for a certificate or authentication by the court

or judge (which, by the way, it never procured), it made no move whatever to comply with the requirements of Equity Rule 75 as to condensing the evidence.

Now after three years (lacking four months) from the date of the final decree for accounting, Appellant's counsel state that the "work of preparing a condensed and simplified transcript was begun immediately upon the filing of the opinion of this case and is proceeding as rapidly as feasible." Just what this means after nearly three years delay we do not know, but if there is ever to be an end to litigation (and there certainly should be) rules governing appeals should be complied with and solicitors should not be permitted to delay the disposition of an appeal for years after the entry of a final decree.

But what, may we ask, do counsel intend to do with the "condensed and simplified transcript" after they have completed it, whenever that may be? What court do they intend or expect to submit it to for examination? What judge or court has the power, after nearly three years [fol. 5095] from the date of the final decree, to supervise what they propose to prepare as a "condensed and simplified transcript?" Possibly counsel do not intend to submit it to any court or judge to supervise it, but merely follow the practice which was indulged in with respect to the "immense amount of elimination" already done in the preparation of this record without consulting either the judge or counsel for the Appellee or anyone.

III

An order of this court such as the appellant requests "directing the lower court to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of the evidence in simple and condensed form" would be a nullity. The term having passed and the appeal having been perfected, the cause is pending solely in this court and the District Court has lost jurisdiction. Any act of the District Court, or any order purporting to be made by it in this cause, would be coram non judice. Such an order would direct the District Court to do an act which (as a court of judge) he is powerless to perform. This Court ought not to direct the District Court or judge to perform a judicial act in a cause not pending in that court (except where a mandate remanding the cause is directed).

We discussed this at length with abundant citation of authorities in our brief, filed herein on January 26, 1926, to which we again call the court's attention.

The settling and signing of a bill of exceptions or a certificate of evidence is a judicial and not a ministerial act.

4 Corpus Juris, 247, 251.
Oxford & Coast Line R. Co. v. Union Bank, 153 Fed. 723 (C. C. A. 4th Cir.).
Maloney v. Adsit, 20 Sup. Ct. Rep. 115.
Mallers v. Whittier Machine Co., 170 Ill. 434.
Young v. City, 173 Ill. App. 311.
Citizens' St. R. Co. v. Heath, 55 N. E. (Ind.) 744.
Winter v. People, 51 Pac. (Col.) 1006.
Va. Devel. Co. v. Rich Patch Iron Co., 37 S. E. (W. Va.) 280.
Cincinnati Traction Co. v. Ruthman, 96 N. E. (Ohio) 1019.
Morgan v. Perkins, 113 N. W. (Mich.) 583.
Herren v. Merrillees, 54 Pac. (Okla.) 467.
Darden v. Williams, 54 S. W. (Tenn.) 669.

[fol. 5096] It is quite clear, from the provisions of Equity Rule 75, that the manner in which the evidence taken in equity causes shall be settled and approved involves a judicial hearing participated in by both parties and consideration and action by the court.

It is well settled, however, that when the term has passed and an appeal has been perfected the exclusive jurisdiction of the cause is vested in the Court of Appeals and the trial court loses all jurisdiction over the cause.

In Jennings v. Phila. B. & W. Ry Co., 218 U. S. 255; 31 Sup. Ct. Rep. 1, a bill of exceptions was signed by the trial judge after the term and after an appeal bond was approved and filed. The Court, in holding that for both reasons the Court was without jurisdiction and power so to do, among other things said:

"No order had been made in term time for the filing of such a delayed bill. Not only had the term closed, but an appeal had been allowed and perfected. The trial court had thereby lost control of the cause, and had no authority to add to or take from the record."

And continuing, the Court said:

"The proceeding was coram non judice. Appellee was not in court or before a court. The judge and the court had lost all power over the cause, the parties and the record."

Under Equity Rule 75, Appellee's counsel have a right to be heard on the settling of the certificate of evidence. Manifestly, the rule does not contemplate an arbitrary power in the District Court, or in the Court of Appeals, to direct the District Court to settle the certificate of evidence, and thereupon approve and certify and sign the same, without giving counsel for Appellee an opportunity to make the showing provided for in the Rule itself. If, however, as the Supreme Court has said, the close of the term, and especially the perfecting of the appeal, has resulted in the District Court's losing all power over the parties as well as the cause and the record, we ask how can Appellee now be required to participate in a judicial hearing in the District Court for the purpose of judicially settling the certificate of evidence?

In Michigan Ins. Bank v. Eldred, 143 U. S. 293, a bill of exceptions was signed by the Judge and filed during the term at which judgment was entered. After the expiration of the term, and after a writ of error was sued out and entered in the Supreme Court, the Judge on the application [fol. 5097] of plaintiff's attorneys ordered the original bill of exceptions to be amended by adding two exceptions to rulings made by him on the trial, and signed the same nunc pro tunc as of the date of the signing of the original bill of exceptions, and ordered it to be filed nunc pro tunc as of the date of its filing.

The court held, as we have before shown, not merely that the power of the court terminated with the expiration of the term, but this was especially true after a writ of error had been entered, the Court saying (p. 298):

"After the term has expired, without the Court's control over the case being reserved by standing rule or special order, and especially after a writ of error has been entered in this court, all authority of the court below to allow a

bill of exceptions then first presented, or to alter or amend a bill of exceptions already allowed and filed, is at an end."

In Blisse v. U. S., 263 Fed. (C. C. A. 2nd Cir.) 961, 965, the Court expressly held that after an appeal or writ of error has been perfected the lower court is without authority to sign a bill of exceptions, or, "to proceed further until the writ of error has been heard and determined and the case remanded to it," saying that, "when a writ of error is perfected the cause comes within the authority of the Appellate Court Alone," citing in support Michigan Ins. Bank v. Eldred, supra; Jennings v. Phila. B. & W. Ry Co., supra; Hovey v. McDonald, 109 U. S. 150, 157, 3 Sup. Ct. 136, and other cases.

And the Court further said (p. 967):

"The signing of a bill of exceptions after the expiration of the term is a grave matter, and it is a peculiarly grave matter when it is signed 15 months after the expiration of the term. If it is to be justified by the consent of the United States' Attorney, we do not think that his consent should rest upon his silence and upon inferences. We are also of the opinion that his consent, even if expressly given, would be ineffective, if the writ of error had already removed the case into this court."

In First National Bank v. State National Bank, 131 Fed. (C. C. A. 9th Cir.) 430, the Court said (p. 431):

"The overwhelming weight of authority of the state courts is that an appeal, properly perfected, absolutely removes the case from the trial court, and places it in the appellate tribunal. The case must of necessity, either be in the Appellate or lower court. It cannot very well be [fol. 5098] in both courts at the same time. Such a course would lead to endless confusion. Under all the ordinary rules of practice, the Appellate Court alone would have the jurisdiction. After the cause leaves the lower court, it is deprived of taking any action upon any question involved in the appeal. Many of the authorities in the state courts upon this point are collected and cited in Elliott's App. Pro. 541; The Federal authorities are substantially to the same effect."

This language was used in connection with an appeal in a bankruptcy proceeding, in which the rules governing causes in equity apply.

So in re Gustin, 281 Fed. (D. C. Mich. 1922), 320, it was held that after an appeal had been taken in a bankruptcy proceeding (which is in its nature an equity proceeding), the lower court had no power to strike from the records certain of the pleadings, the Court saying:

"As the effect of this was to transfer the jurisdiction of this court over this cause and its power to proceed further therein to the appellate court, this motion cannot be considered by me, at least unless and until the proceedings have been remanded for that purpose."

In Kayser v. Farr, 105, U. S. 265, 266, which was an equity proceeding, it was said:

"After the acceptance of the bonds for the appeal and the docketing of the course in this court, the jurisdiction of the court below was gone. From that time the suit was cognizable only in this court."

To the same effect is Draper v. Davis, 102 U. S. 370, which was also an equity case.

So in Kendrick v. Roberts, 214 Fed. (D. C. Ga.) 268, it was held that the District Court, after approving a supersedeas bond, made a part of the record in the case, which had been filed in the Circuit Court of Appeals on writ of error, has no jurisdiction to vacate the supersedeas, the Court saying:

"The jurisdiction of the Appellate Court over the case now is complete; it having been transferred to that court, and therefore entirely removed from the jurisdiction of this court."

In Omaha Electric L. & P. Co. v. City of Omaha, 216 Fed. (C. C. A. 8th Cir.) 848, 855, which was a chancery proceeding, it was said:

"It is a universal rule that the perfecting of an appeal transfers the cause to the Appellate Court, and that it remains there until it is remitted to the trial court by the [fol. 3099] sending down of the mandate."

Citing many cases.

In Morrin v. Lawler, 91 Fed. (C. C. N. Y.) 693, it was held that it is the rule of the Federal courts that when all the steps necessary to perfect an appeal have been taken, the action is within the control of the Appellate Court, and a motion for substitution of the appeal bond must be addressed to that court, saying:

"The trial court should not engage in undoing or modifying the proceedings by which such jurisdiction has been obtained."

See also Fed. App. Jur. and Pro. (Zoline) par. 646:
Harding v. Oregon-Idaho Co., 110 Pac. (Ore.), 412, 414.

In the case at bar the term has long since passed and every step necessary to the perfecting of the appeal was taken before the motion under consideration was made, as we have shown.

[fol. 5100] IV

Appellant's motions are based upon a complete misapprehension and a false premise because they assume that the evidence upon both issues has been properly preserved and filed and nothing remains but so condense or abstract it. This is not correct. Appellant in its petition for rehearing and motion to direct condensation of the record assumes and states that while it did not comply with equity rule 75 it embodied in the transcript of record a "certificate of evidence" containing all the evidence in question and answer form. This is not true. There is no certificate of evidence in this record upon the infringement issue, nor is there any certificate by the master of any kind showing that the evidence incorporated in the transcript (purporting to be the evidence on the accounting issue) was the evidence taken and heard by him, nor any certificate by the clerk showing that it was the evidence attached to and filed with the master's report or returned and filed by the master in the clerk's office as the evidence taken and heard by him; nor is there any file mark shown anywhere in the transcript as to the evidence upon the accounting issue. There is nothing in the transcript showing that the purported evidence appearing therein on either issue is all of the evidence

taken or heard on that issue. But the contrary affirmatively appears. A check-up of the record shows that out of 196 exhibits introduced in evidence 114 are omitted from the transcript. Therefore, there is nothing in this transcript to be condensed or which anyone has the right or power to condense or reduce to narrative form. Nor could this court consider such evidence even if condensed and reduced to narrative form. Since it would not be all of the evidence, it will be presumed that the decrees on both issues are supported by evidence other than that which the record discloses.

The Appellant's counsel have treated these motions as though all of the evidence was properly in the record. As to the alternative motion, they assume the only thing that is necessary is to condense or abstract the evidence under the direction of the District Court. This, is, of course, an incorrect assumption.

We have already shown that the transcript does not contain, nor does it purport to contain, all of the evidence. [fol. 5101] A careful check-up of the transcript of record and the exhibits which have been incorporated into the transcript shows that out of 196 exhibits introduced in evidence 114 are omitted from the transcript of record filed in this court. The petition for rehearing makes the rather misleading statement that in obtaining "certification of a complete transcript of the evidence such counsel were only doing that which was in accordance with the long recognized practice of this Court."

In the Illinois Supreme Court, where the evidence is abstracted and only the abstract is printed, the original transcript of record contains all of the evidence, properly certified. Under this State Court practice in Illinois the Court has before it not only the abstract but also the complete evidence. Equity Rule 75 does not contemplate the practice of abstracting the evidence, but the only thing before the Court is what the District Court, after complying with procedure in Equity Rule 75 incorporates into the record and which is then embodied in the transcript and is the only record for this Court to review. Where the evidence is patiently incomplete, as in the present case, it is quite manifest that what would amount to abstracting or condensing the record in narrative form cannot be done by anyone at

the present stage of the appeal. There is nothing to condense or abstract. There is no starting point.

Equity Rule 75 contemplates that the Judge shall supervise and direct the condensation of the evidence in narrative form as a judicial act. He exercises a discretion which is judicial in character and does it in the presence of both parties, or upon notice to the opposite party and an opportunity to be heard. Where, as in this case, the District Court has long since lost jurisdiction, he can no longer function so as to perform a judicial act as this cause is now pending in this Court and cannot be pending in two courts at the same time.

We respectfully and earnestly insist therefore, that the Appellant's motion to reconsider and decide this case upon the merits cannot be granted because, through the Appellant's deliberate act, part of the evidence was not incorporated in the transcript. Nor can it grant the motion to direct the lower court to condense the evidence under Rule 75 as a matter within the discretion of this Court, because in the present stage of this proceeding this Court cannot direct the District Court to perform any act, and particularly not a judicial one, nor can the District Court, [fol. 5102] either with or without any order from this Court, perform any act in this case and particularly not a judicial act.

We respectfully urge, therefore, that the motion to decide this case upon the merits or for an order directing the lower court to condense the evidence under Rule 75 must be denied.

This court cannot comply with the suggestion of appellant's counsel in their petition for rehearing (point 6) and pass upon the question of title, because all of the evidence is not in the transcript.

In their petition for rehearing, Point 6, counsel for Appellant ask this Court to pass upon the question of title to the Letters Patent, urging that "this Court may have overlooked the fact that upon the issue of title there is no testimony in the record." Appellant's counsel then urge that as the evidence relating to the title is documentary in character, the Court should proceed to decide the question of title to the Letters Patent upon its merits.

In view of the fact that the solicitor for Appellant who prepared the transcript of record instructed the Clerk, by the Praecipe for record which he filed, to include only certain documents which were introduced as exhibits, and has admittedly "eliminated" a large part of the evidence from the record without consulting either the District Court or counsel for the Appellee, this Court could not properly, even if it desired to do so, pass upon any question of fact in this record. Out of 196 exhibits which were offered in evidence as appears by the record, 114 exhibits, or over one-half, have been "eliminated." Is this the kind of a record upon which any court of review can base a decision upon the question of title to the Letters Patent involved if the title is in dispute? Manifestly not. It would be an unheard of practice for any court of review to decide any issue of fact upon a record which is admittedly incomplete and which has been doctored by a solicitor for one of the parties by a process of elimination and the inclusion of subject matter appearing not to have been put in evidence without the consent of the other party and without any supervision by the trial court. If this Court should undertake to do so, it is hardly necessary to point out what the consequences of such a procedure would be and what it would open the door to in other cases.

The answer is so self-evident that it hardly needs any illumination. The solicitor who prepared the transcript of [fol. 5103] record and assumed to delete and eliminate evidence and exhibits which had been offered in evidence and admitted in the District Court, should have applied to the District Court under Rule 75 to approve his act, and cannot expect this Court to decide or pass upon the question whether or not the evidence and exhibits he deleted and eliminated from the transcript of record are or are not incompetent or irrelevant upon this issue or upon any other issue.

The suggestion in the petition for rehearing that this Court should pass upon a single isolated question of fact upon fragmentary documentary evidence is ill-conceived and lacks the merit of precedent or common sense.

V

Although the point upon which this court bases its decision was raised in November, 1925, over a year ago. Appel-

lant took no steps to comply with Equity Rule 75, evidently deeming it unnecessary to do so, but in October, 1926, submitted the case to the Court for decision.

Appellant, not having complied with equity rule 75 at the time it perfected its appeal, was admonished by the Appellee, on November 9, 1925, by motions and objections, orally and in writing, but notwithstanding this, it failed to comply with the provisions of the Rule.

In October, 1926, and almost a year later, the case was argued and submitted to the Court, the Appellant having taken no steps to condense the evidence in narrative form. Now, after this Court has handed down an opinion and decision affirming the decree for failure of Appellant to comply with equity rule 75, it seeks to have the opportunity to do what it should have done at the time it perfected the appeal or a fortiori at the time the motion and objection of the Appellee was made on November 9, 1925. After this Court has decided the case and handed down its opinion, it is too late for the Appellant now to seek to be allowed to go back and comply with equity rule 75.

In United States v. Adams, 9 Wallace, 534, the Supreme Court of the United States said as follows:

"The court is of opinion that a case has not been presented by the appellee, which would justify it in the exercise as follows: 'A finding of the facts in the case by the said [fol. 5104] The second rule of this court on appeals from the Court of Claims, in respect to making up the record, is as follows: 'A finding of the factes in the case bw the said Court of Claims, and the conclusions of law on the facts on which the court founds its judgment or decree. The finding of the facts and the conclusions of law to be stated separately, and certified to this court as part of the record.'

The remedy, in case the Court of Claims falls into a mistake as to the finding of the facts, is familiar. It is by an application to this court to remit the case back for correction, if it be shown, satisfactorily, that a mistake has been committed.

In the case before us, it is admitted that the mistake was known to the party and his counsel in season to have had it corrected before hearing; but, relying on its immateriality, no step was taken to have the correction made. We do not doubt but that this opinion was hon-

estly entertained, and that this motion is made in good faith; but it is impossible not to see that, if granted, the precedent might lead to great abuse and delay in the hearing of these cases. We should allow either party to lie by till the case was decided, and the opinion delivered, and then to apply for the correction, as the exigency of the case might require, or as the materiality of the fact might appear from the ground upon which the decision was placed. On an appeal, the parties are entitled to have all the facts proved in the case before the court below, in the judgment of the court, truly found, and stated in the record, that either deemed material to the decision; and, as we have seen, the remedy is ample to correct any mistakes committed, if applied for prior to the hearing in this court. The court are not willing to go farther, and permit the remedy to be applied after the case is heard and decided, as we fear that such precedent would work greater injustice and hardship, in its general use and application, than that which may exist in any particular case."

"As was said by the Court in Blisse v. United States, 263 Fed. (C. C. A. 2d Cir.), 961:

'We are not insensible to the fact that the dismissal of a cause without passing on the merits, because the inadvertence of counsel has disregarded an established rule of procedure, is to impose upon the litigants an extreme [fol. 5105] penalty. At the same time we are compelled to adhere to established rules of orderly procedure, which experience has shown to be important in the administration of justice. The rules respecting the preparation of a case to be brought to the Appellate Court on writ of error are not uncertain and are not obscure, and it is to be assumed that they are familiar to counsel. The failure to observe them, as has frequently been remarked, only tends to confusion and to the demoralization of the procedure of the court. Du Pont v. Smith, 249 Fed. 409. To disregard such rules is to introduce uncertainty and perplexity into the administration of justice, and, as Mr. Justice Story remarked, is destructive of the law as a science. (Story's Eq. Pl., Sec. 544.)'

"So in Oxford & Coast Line R. Co. v. Union Bank, 153 Fed. 723, 728, it was said:

'While it is not the policy of the court to dismiss writs of error and cases on appeal on account of slight technicali-

ties, at the same time, the rules of this court, as well as the rules of the Circuit Court, are plain and easily understood. In this instance the provisions of the statute relating to the question at issue is mandatory and must be enforced. It is incumbent upon attorneys who practice in the federal courts to observe and strictly follow the rules of practice and procedure in preparing and presenting bills of exceptions.' (Michigan Ins. Bank v. Eldred, 143 U. S. 298.)

"Continuing, the court said:

'It is essential to the orderly procedure of the courts that attorneys should comply with the rules relating to the same; otherwise, it would be useless to promulgate rules for the guidance of those who may seek to review the action of the lower court.'

"And the Court quotes with approval from Mr. Justice Story on Equity Pleading (Sec. 544), as follows:

'The want of due form constitutes a just objection to the proceedings in every court of justice, for to reject all form would be destructive of the law as a science, and would introduce great uncertainty and perplexity in the administration of justice. Every irregularity of this sort is fraught with inconvenience, and generally tends to delays and doubts. And it has been well remarked that infinite mischief has been produced by the facility of courts of justice in overlooking errors of form. It encourages careless-[fol. 5106] ness and places ignorance too much on a footing with knowledge amongst those who practice the drawing of pleadings.'"

In Barlass v. Kargus, 87 N. W. 800 (Supt. Ct. Wis. 1901), the Court said:

"The bill of exceptions, however, is not certified to contain all of the evidence, and hence, under the rule which is frequently applied, it must be presumed that there was sufficient evidence of a conclusive nature before the trial court to justify its conclusion. Application was made after the argument by the appellant for leave to withdraw the record and return the same to the trial court for the purpose of obtaining the proper certificate. Such leave was, however, denied. We have found it necessary to adhere closely to the rule that the record must be complete when a case is placed upon the assignment for argument."

In Clark-Harris Co. v. Douthet, 31 Pac. Rep. 422, the Court said:

"Appellant moves to reinstate this cause, and asks leave to withdraw the transcript to enable the judge of the superior court to amend his certificate thereto, which, by the judgment of this court heretofore rendered in the cause had been declared insufficient, and on that ground the appeal had been dismissed. A motion to withdraw the transcript, in order to enable a certificate of the superior judge to be amended to correspond with the facts, or for any other material correction of the transcript to meet the objections of the respondents, is a proper one to be made, and will, in ordinary cases, before the final determination of the cause, be granted. This rule of practice is clearly shown by the authorities cited by counsel for appellant, and has been frequently recognized and laid down by this court. And had this motion been made immediately after the filing of the respondents' brief in which objections to such certificate were raised, it would undoubtedly have been granted without any terms whatever, and even up to the time of the final submission of the cause it would, upon proper suggestion, and a sufficient showing why it had not been sooner made, have probably been granted upon such reasonable terms as the court saw fit to impose. But in this case the appellant, after having not only by the brief of respondents, but also by the oral argument upon the [fol. 5107] motion to dismiss, had his attention fully called to the insufficiency of such certificate, saw fit to stand thereon, and failed to ask this court for any relief whatever against the action of the court below in making the same, or even to suggest to this court that the certificate did not fully correspond with the facts in the case. Instead of so doing, he awaited the decision of the court, and when he found that it was against him, he for the first time sought to have such certificate changed. Under these circumstances, in our opinion, he is entitled to no relief, and the other party is entitled to have the judgment of the court treated as final. To hold otherwise would be to encourage a party to an action to await the decision of the court upon any doubtful proposition, and, if against him, ask to be relieved therefrom by alleging facts which resolved such doubtful question into a certainty in his favor. In other

words, it would allow a party, in order to save himself some little trouble that the exact facts might be made to appear, to take the judgment of the court upon the sufficiency of the partial statement of facts, and then, if such decision was adverse to him, suggest for the first time the additional facts, and upon such suggestion ask to be relieved from the effect of the judgment of the court upon the partial statement of facts upon which he voluntarily saw fit to rest his case. None of the cases cited by appellant, in our opinion, present a case of this kind, and such a course would, in our judgment, be destructive of any proper practice in a court of justice."

Drake v. New York Mine, 55 N. Y. Supp. 920 (S. Ct. App. D.).

This was an action by Drake, and judgment was against him. He appealed to the Supreme Court, where the case was affirmed and then to this court, where it was again affirmed, on the ground that appeal was made on the judgment roll only, and the evidence was not before the court, and it could not therefore consider the facts. Drake then moved for leave to amend his record and this was denied, the court saying:

"It is now over four years since the judgment was rendered. When the case was pending before the court of appeals, and in a condition where the plaintiff might have made a motion to amend his record if he so desired, and before argument, the defect upon which the court based its determination was pointed out to the plaintiff, and he then understood that the objection which subsequently controlled the action of the court would be taken. It was [fol. 5108] made to appear by the plaintiff upon this motion that he was fully apprised of such point, made critical examination of the same, and reached the conclusion that the questions which he sought to present in the court of appeals were sufficiently raised by the exceptions which then appeared in the record. Having elected to take his chances of an adverse decision upon the record which he had made up, and being in no wise misled, by ignorance or otherwise, he ought not now, in the orderly administration of the law, to be heard to complain. It is the

public policy of the state that litigation shall some time have an end; and where a party has had an opportunity to present his case to the court upon a record of his own making, and which he deems sufficient, he cannot thereafter make a new record for the purpose of having his case re-heard. To adopt such a rule of law would leave the judgments of the court of last resort open to be continually disturbed in their finality, and would impose upon the court an obligation which, in the present state of burdens already imposed upon it, would render impracticable the determination of causes and the final ending of litigation. It is no answer to say that the plaintiff has never had a determination of the case upon its merits. The fault for such fact rests with him and his fate in this regard is by no means unusual, for very many of the judgments rendered by the court of appeals and other appellate tribunals proceed upon questions of law in which the merits of the controversy are not involved, and when, perhaps, correct practice might have sufficed to have procured a decision upon the merits. These cases are so frequent that were it once the established rule that a party might litigate and invoke the judgments of all the courts in the state, be beaten upon his legal propositions, and then come back and renew the same proceedings in the appellate tribunals, upon no other basis or reason than that he had mistaken his practice, or failed to have his record contain the true case as it appeared upon the trial, there would be little dispatch of business or end to litigation. In the present case, as we have already stated, the plaintiff has not even the excuse that he was misled in the court of last resort. There is therefore no basis upon which he can now ask that a new record shall be made up."

[fol. 5109] Allen v. Le Moyne, 101 Ill. 655.

The court here held that an application to amend the record, made after decision and pending an application for rehearing, comes too late, unless very special circumstances are shown.

"If it happen that the record is so far incomplete as not to present the real merits of the case as developed on the trial in the court below, steps should be taken in

apt time to supply the deficiency. It is too late at this stage of the case,—after the decision of the court has been rendered, and pending an application for a rehearing,—to ask that the alleged omitted matter be now supplied, and thus perhaps present an entirely different case for our consideration from that submitted for determination on the original hearing. Such a practice would be exceedingly objectionable, as enabling parties to bring their cases to this court by piecemeal, and should not obtain in any case except there be shown very special circumstances, which we do not discover here, requiring a deviation from the usual course.

The motions will have to be denied."

In Nelson v. Ring, 193 Pac. (Ore.) 747, which on the facts will be found strikingly similar to the facts in the case at bar, the case was argued Oct. 6, 1920, and opinion handed down later, the opinion declining to consider the testimony because it had not been filed with the Clerk of the Circuit Court or authenticated by the Circuit Judge. After the opinion, appellant secured the certification, and now moves for a rehearing on the merits.

In this case the appellant claimed he had no idea that the testimony was uncertified, and didn't know how it got into the Clerk's office in the first place, and that the testimony had been shown to appellees, who agreed to its accuracy.

The court holds that this application is too late.

"This application comes too late. Had it been made before the hearing, we would have been inclined to permit the transcript to be amended; but to allow a party after having tried his case upon the transcript he has presented, and after defeat, to procure an amendment of it and a rehearing upon the transcript as amended, would lead to intolerable delays in the administration of justice. This is especially the case in instances like the present, where the defect was pointed out in the respondent's brief. We [fol. 5110] quote from that brief the following:

'There is another feature in this case, that we are to presume that the transcript contains all of the evidence and exhibits. There was no official reporter appointed by the court to report or transcribe the evidence in the case and the same does not bear the file mark of the clerk of the

court, nor is it identified in his certificate or by the certificate of the trial judge.'

"This brief was filed November 8, 1919, and the hearing was had on October 6, 1920, so that appellant had nearly a year prior to the hearing in which to procure the certificate of the trial judge, had he deemed it material."

(The time here is practically identical with the time in the case at bar.)

"Neither the affidavit nor the transcript of testimony shows any such controlling equities as should induce this court to disregard the salutary rule announced in State v. Jennings, 48 Ore. 483, 494; 87 Pac. 524, 89 Pac. 421, 424, which is substantially to the effect that amendments to the transcript will not be permitted after a cause had been argued and submitted and an opinion handed down. See also McCann v. Burns, 73 Ore. 167, 172, 136 Pac. 659, 143 Pac. 916, 1099, 1100; Noble v. Watrous, 84 Ore. 418, 426, 163 Pac. 310, 165 Pac. 349; Malloy v. Marshall-Wells Hardware Co., 90 Ore. 303, 359, 173 Pac. 267, 175 Pac. 659, 176 Pac. 589.

"The petition for rehearing is denied."

In Tunnicliff v. Watts, 210 S. W. 876 (Sup. Ct. Mo.) the record was deficient in certain formal aspects. A motion to dismiss the appeal or affirm the judgment was made, and this is sustained and judgment affirmed. Appellant made affidavit that he was greatly rushed at the time, and also that he was unfamiliar with appellate practice, and unintentionally omitted the missing items, and asked leave to amend.

Held that a motion to amend comes too late after a motion to dismiss or affirm.

In Smith v. Gustin, 81 N. E. (Ind.) 722 the court says:

"The rule has been long established that this court will not grant a rehearing to enable a party to correct or perfect a record."

See also Conductors Benefit Assoc. v. Leonard, 166 Ill. at 161, which involved amendment of a certificate of evidence to include what had been omitted by error of the clerk of the Appellate Court.

[fol. 5111] Furthermore, as was pointed out by this Court in the case at bar, and in the case of Buessel v. United States, 258 Fed. (C. C. A. 2nd Cir.) 811, 824, the Equity Rules have the force of a statute, and no particular case can be exempted from their operation, the Court saying:

"We may add that whatever may or may not have been the practice in this circuit prior to 1912 in the matter of preparing the record in an appeal, the subject is governed by rules 75, 76 and 77, as framed by the Supreme Court, and that there is no power in this Court to exempt a particular case from their operation. The rules, having been promulgated under the authority of an Act of Congress, have the authority of statutory regulation. Winter v. Ludlow, 104 Fed. Cas. No. 17,891."

So the Supreme Court of the United States in the Houston case, cited by this court in its opinion, page 6, declined to consider the evidence, which, on issues involving consideration of the evidence, is tantamount to affirmance.

VI

The Appellant did not have the evidence in this cause certified by this District Judge pursuant to the permission granted January 29, 1926. The only action taken by the District Court pursuant to this Court's order was an order entered of record on March 30, 1926, which purports to be shown in a supplemental transcript of record filed April 13, 1926. This purported order of the District Court entered March 30, 1926, is not a certificate, does not authenticate or identify the evidence and is a nullity.

In order to approve and certify the evidence it is necessary for the court to indicate such approval by a certificate signed by him at the end of the evidence itself for the purposes of authentication and identification.

Upon the Appellant's motion to remit the record to the District Court for an additional certificate, which this Court allowed on January 29, 1926, the Appellant, after waiting two months, went before District Judge Fitz Henry on March 29, 1926, and had a purported order entered redocketing the case in the District Court. On the following day, March 30, 1926, another purported order was entered by the District Court purporting to identify the evidence. These

[fol. 5112] proceedings in the District Court are shown by what is called a "Supplemental Transcript of Record," filed in this Court on April 13, 1926, without any order granting or motion asking leave.

The purported order entered of record in the District Court on March 30, 1926, is not and could not, in the nature of things, be a certificate. A certificate of evidence necessarily implies and requires that the evidence itself be signed and certified and thereby identified by the presiding judge.

In the following cases, which we cited and quoted from in our brief filed January 26, 1926, it was expressly held that the approval of the Court must be evidenced by his signature to the evidence itself for the purposes of identification and authentication.

Insurance Co. v. Lanier, 95 U. S. 171.

In Re Jewell Electrical Instrument Co., 283 Fed. (C. C. A. 7th C.) 978.

Wong Keow v. U. S., 215 Fed. (C. C. A.) 7th C.) 95.

Buessel v. U. S., 258 Fed. (C. C. A. 2nd C.) 811, 822, 823.

Carson v. Hurt, 250 Fed. (C. C. A. 5th C.) 30, 33.

That the entry of these two orders of March 29th and March 30, 1926, are judicial acts, there can hardly be any doubt. We can hardly imagine how there can be any question that entering an order, or a purported order, by a court is anything but a judicial act. Certainly no one would contend that the entry of an order by a court is merely ministerial.

As we have shown in our brief filed on the motion to dismiss, and by the authorities cited in this answer, this case is pending in this Court and cannot be pending in the District Court. The District Court lost jurisdiction completely and for all purposes when the term passed and particularly when the appeal was perfected, and the purported orders entered by the District Court on March 29 and March 30, 1926, are nullities. The whole proceeding in which those orders were purported to be entered by the District Court can only be characterized, as they were by the Supreme Court in a case we cited, as coram non judice.

Jennings v. P. B. & W. Ry. Co., 218 U. S. 255.

It is now proposed, by the motions in this cause, to have the District Court go on and continue to perform similar acts and to attempt to function in this cause while the case is pending in this Court. It seems to require no further argument to show the futility of the course proposed by the Appellant's counsel by these motions.

[fol. 5113] Incorrectness of Certain Statements in Petition for Rehearing Pointed Out

We have already referred to and commented on certain statements in the Petition for Rehearing, which, in our view, are based upon a misconception of fact or law. Some of lesser importance we cannot reply to without unduly extending this Answer, but there are others that we do not feel, in fairness to the Appellee, can be ignored.

It is said by appellant (page 2, Petition for Rehearing) that this court after having the record before it ordered it sent down to the Lower Court in order that it might be returned with a Certificate of Evidence without ordering or suggesting that the record ought to be condensed.

Counsel for appellant cannot thus shift the blame upon this court, we submit. It was up to counsel for appellant to obey the rules of this court, especially after the violation of the same had been pointed out and insisted upon by appellee in its brief and argument of January 26, 1926, hereinabove quoted from at length. This court simply allowed counsel for appellant to do whatever they might see fit to protect their record, and expressly provided in its order, submitted by counsel for appellant "that the effect or validity of such certificate, if obtained, shall be reserved for final determination of this cause."

Counsel say (page 5) that "No objection had been made by appellee to this praecipe, although it specified the testimony already printed and in uncondensed form." Appellee was under no obligations to make any objection to the praecipe in question for the reason that the testimony was not and could not be made a part of the record until after it had been approved in the manner prescribed by paragraph (b) of Rule 75, and had been filed and thereby made a part of the record. Section (a) of Rule 75 having to do with the praecipe is not operative upon anything not a part of the record, and the testimony in the cause does not become a

part of the record until it has been approved and filed as provided for in paragraph (b) of Rule 75.

Counsel say (page 5) "Appellee's counsel expressed their readiness to argue the question arising on the accounting on the record as it stood which, of course, could not have been done had appellee insisted that the accounting evidence must be reduced to narrative form."

There is absolutely nothing to justify any such statement.

[fol. 5114] Again counsel say (page 6) that counsel for appellee "had expressed their satisfaction" as to the accounting record.

This statement is not only utterly without foundation or justification, but is contrary to the facts.

On the contrary, we insisted always that Equity Rule 75 had not been complied with in respect to any of the evidence.

Counsel also say (page 6) that both sides appeared before the District Court and a "Certificate of evidence" was obtained. They fail to say that counsel for Appellee appeared before the District Court specially and for the purpose of objecting to the jurisdiction of the court and otherwise did not participate, as the order of the District Court of March 30, 1926, expressly shows.

Again, they say that the District Judge added to the order his direction that all the testimony in the cause be reproduced in the exact words of the witnesses and not in narrative form, and that such an order had not been secured previously because of the acquiescence of Appellee's counsel in the praecipe calling for the entire record and his failure to move for a condensation of the record. In the first place, let it be noted that the praecipe never called for the "entire record" but only for a part of it, particularly omitted 114 exhibits introduced on both the infringement issue and the accounting issue by both sides. In the second place, counsel for Appellee did not acquiesce in the praecipe. The praecipe called for things that were never made a part of the record of the District Court, as we have shown, and counsel for Appellee was under no obligation to do anything, and its failure to do something has not precluded it.

As we have pointed out, counsel for appellant wholly misstate the function of a praecipe and also seem to be labor-

ing under the impression that a præcipe can direct the clerk to incorporate in the transcript of the record something that is not of record, which they attempted to do, as we have pointed out in the case at bar.

Counsel say (page 23):

"The court refers to an apparent duplication of four printed patents in the record. The trouble is that these patents, although handed to the Master as evidence after witnesses had been examined concerning them, were not by him in any way marked. They were filed physically with his report. The printer feared to include them within his printed transcript (which was printed before it was certified) and merely annexed them at the end of Vol. IX [fol. 5115] after the Clerk's certificate. They therefore form no part of the record. When the transcript was returned they were properly certified by Judge Fitzhenry's express direction and therefore form part of Vol. X of the record being before the clerk's second certificate."

It will be difficult to find a more confused statement than this.

In the first place, while the rule is absolute that it is the duty of the Master, when he returns the testimony taken by him by order of the court, to identify and certify it, yet counsel confessedly have sought to file in this cause exhibits that bear no identification or certification of the Master and were never marked by him in any way as exhibits or otherwise. This is fatal. The District Court had no power to determine, in the place and stead of the Master, what evidence was taken before the Master and what exhibits were introduced and considered by him, nor to identify and certify the same in the Master's stead.

In the second place, the District Judge did not identify or certify these exhibits by his certificate and his signature after them, nor were the exhibits filed even in the office of the District Court or in this court with any such identification and certification of the District Court thereto. All that there is is simply an entirely separate and distinct order and a certified copy of the same filed in this court, followed by certain alleged exhibits and the Clerk's certificate at the end. Under no rule of procedure in any court is such a thing as this permissible, or does it amount to anything in the way of certification.

We respectfully submit that the petition for rehearing and the motions to vacate the order of affirmance and to direct condensation of the record should be denied.

Respectfully submitted, Alexander F. Reichmann, Frank L. Belknap, Walter M. Allen, Solicitors for Appellee.

[fol 5116] IN THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

No. 5314

BARBER ASPHALT PAVING COMPANY, a Corporation, Appellant,

vs.

STANDARD ASPHALT & RUBBER COMPANY, a Corporation, Appellee

APPENDIX

Appellee's Exhibits Introduced Re Title and Infringement, and Brought Up

Page in Record	No.	Name	Recorded
53	1	Culmer Process Patent 635,429	1547
53	2	Culmer Product Patent 635,430	1554
53	3	Certified Copy, File Wrapper Culmer Process Patent 635,429	1429
53	4	Certified Copy, File Wrapper Culmer Patent 635,430	1457
53	5	Certified Copy, Papers Relating to Title	1223
53	6	Stipulation as to waiving formal proof, and as to records	1213
207	10	List of Railroads using Sarco	1472
208	11	List of Cities using Sarco	1474
209	12	List of Rubber Companies using mineral rubber	1477
1115	26	Assignment of G. C. K. Culmer to Standard Asphalt	1249
1115	27	Certified copy transcript of Record in Green v. American Hydrocarbon Co. and G. Culmer; and also Culmer v. Green and American Hydrocarbon Co.	1251
1115	28	Certified copy of transcript of record in Guardian Trust Co. and Bird Syndicate v. George Culmer	1383
		Total	12

[fol 5117] Appellee's Exhibits Introduced Re Title and Infringement, and Not Brought Up

Page in Record	No.	Name
126	1 of July 1, 1915	Certified copy of deposition of Forrest in Byerley v. Barber, to be attached to the deposition in the present case.
128	B of July 1, 1915	(Given in response to question 35 in Byerley v. Barber.) To be attached to the deposition of Forrest
128	C of July 1, 1915	(Given in response to Q. 60 in Byerley v. Barber.) To be attached to deposition of Forrest.

Page introduced	No.	Name
271	15-	Sarco stamps for drums.
327-9	15 (a to aiii)	50 exhibits of rubber products.
352	16	Box of Bubbs samples.
390	17 18 19 20	4 boxes of samples.
389	21	Bottle of residuum.
390	22	Can of gilsonite.
613	23 A S	Boxes, bottles and packages of Gilsonite (Culmer).
1175-78		Samples of Byerlyte (Fuller) known as Malory Samples from American Suit.
		Total 14

[fol. 5118] Appellant's Exhibits Introduced Re Title and Infringement

Brought Up on Appeal

Page introduced	No.		Name	Recorded
74		1	Diagram and description Appellee's converter	1479
497		2	Byerley Thesis	1481
497		3	Mayberry Article	1505
500	(547)	4	Pamphlet "Byerlyte, Its Description and Uses"	509 & 1513
622		10	Cummings Patent 528,291	1508
497-8		15	Byerlyte Co. Incorporation papers.	
505	(1004)		Assyrian Asphalt Co. correspondence with East Jersey Pipe Co. (J. A. Nelson)	1514
			1. Letter, Jan. 18, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1521
			2. Jan. 4 1895, A. R. McHenry, Jr., to McKee & Milson	1521
			3. Letter, Jan. 16, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1521
			4. Copy letter Jan. 29, 1895, E. Jersey Pipe Works to Assyrian Asphalt Co.	1522
			5. Letter Feb. 1, 1895, Assyrian Asphalt Co. to E. Jersey Pipe Works	1522
			6. Letter, Feb. 17, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1523
			7. Letter press copy letter Feb. 18, 1895, E. Jersey Pipe Works to A. R. McHenry, Jr.	1523
			8. Letter, Mr. 10, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1524
			9. Letter press copy letter Mar. 11, 1895, E. Jersey Pipe Works to A. R. McHenry, Jr.	1524
			10. Letter, Mar. 24, 1895, William Sloan to Milson	1525
			11. Letter, Mar. 26, 1895, Assyrian Asphalt Co. to A. R. McHenry, Jr.	1525
			12. Letter, Apr. 14, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1526
			13. Letter, Apr. 22, 1895, Assyrian Asphalt Co. to Milson	1527
[fol. 5119]			14. Letter, Apr. 27, 1895, Assyrian Asphalt Co. to E. Jersey Pipe Works	1527
			15. Letter, May 5, 1895, A. R. McHenry, Jr., to E. Jersey Pipe Works	1528

Page introduced	No.	Name	Recorded
		16. Letter, May 14, 1886, A. B. McHenry, Jr., to E. Jersey Pipe Works	1528
1004		Assyrian Company Bankruptcy	1529
1086		Culmer British Patent, 11087 of 1889	1571
1110		Forrest Analysis Cleveland and Madison samples	1211
1110		Analysis Michigan Central samples	1212
1110		Résumé of analysis of Mr. Forrest	1210
		Total	12

Appellant's Exhibits Introduced Re Title and Infringement

Not Brought Up on Appeal

Page introduced	No.	Name
545 (551)	5	McLaughlin's Scrap Book (Samples of work).
563 (571)	6	Michigan Cent. R. R. sample Rice Creek Bridge West Bound Track.
564 (571)	7	Michigan Cent. R. R. Sample Rice Creek Bridge East Bound Track.
566 (572)	8	Michigan Central R. R. sample Little Calumet Bridge.
569 (572)	9	Michigan Cent. R. R. sample 2 Corymbo bridge.
638	11	Bills of Cummings Co. to Edison Ill. Co.
640 (643)	12	Stone's Note Book (re Byerlyte).
695	13	Briordy Book (re Byerlyte).
710		Poore's sample Torsion Proof Roofing.
738		Paste samples of Byerlyte.
853	16	Photograph Byerley Still.
853	17	Photograph Byerley Still.
840		Byerley Products (12).
869	H B	Hydrolene B-4 samples from Byerley v. Sun.
972	18	Samples of Byerlyte produced by F. A. Byerley.
972		Seven record books of Byerley, including four still books, one sales book and two journals.

[fol. 5129]

993	*	Assyrian Asphalt Company Book (Physical Ex.)
1074		Samples of Byerlyte from 28 gravity oil.
1076		Samples of Byerlyte from 28 and 17 gravity oil.
1040		Seven vials of materials obtained by Mr. Forrest from Michigan Cent. samples.
1040		Six cans samples of material produced at Cleveland plant with 17 gravity oil.
1042		Progressive samples from Cleveland product, from 28 gravity tar.
1047		All samples produced by Forrest, including card, etc.
1081		Government Pamphlet, Production of Petroleum.
1081		Pennyman Chart of oil production.
1110 (see also 897)		Byerley v. Sun record.
1110		Byerley v. Standard Asphalt Record.
1110		Byerley v. Barber Asphalt Record.
1110		Standard Asphalt v. Byerley Record.
		Total	29

The following were, on September 30, 1926, attempted to be brought up to the Court certified only by a Certificate of the Clerk of the court below:

Appellant's Exhibit 6, Michigan Cent. R. R. sample
" " 7, " " " " "
" " 8, " " " " "
" " 9, " " " " "
Foote, Samples (Two) boxes; Byerlite 18 and 22.

Appellant's Exhibit Progressive Samples of Cleveland Product from 28 gravity tar.

Uncertified printed copy of record of Byerley v. Sun Company; also of Byerley v. Barber Asphalt Company; and also of Standard Asphalt & Rubber Company v. American Asphaltum & Rubber Company.

[fol. 3121] Appellee's Exhibits Introduced Re Accounting and Brought Up

Page introduced	No.	Name		Recorded
1771	D	Sheets 1 and 2, Statement of Income & costs of Manufacture, separating Maurer and Madison		4776-7
1774	E (1)	Roofing shipped at Maurer not through Sales Dept.	No originals are printed but marked copies by Forrest are at	4778 to 4797
1775	F	Sheets 1 and 2 Miscellaneous compounds sold other than through Sales Department.		
1775	G	Sheets 1 and 2 Miscellaneous compounds sold at Maurer through Sales Department.		
1775	H	Sheets 1 and 2 all Maurer Products sold through Sales Department		
1776	I	Sheets 1 and 2 Roofing Sold at Madison through Sales Dept.		
1776	J	Miscellaneous compounds at Madison, sold through Sales Department		
1777	K (a)	Madison Miscellaneous not through Sales Department.		
	(b)	Madison Roofing products shipped		
	(c)	Sales of roofing not through Sales Dept.		
1777	L	Sheets 1 and 2, Total business of Sales Dept.		4798
2316	E	Marked copy by Forrest		4778
2316	F	Marked copy by Forrest		4780
2316	G	Marked copy by Forrest		4782
2316	H	Marked copy by Forrest. Sheet 1 not marked		4790

[fol. 3122]

2486	H	Sheet 8, marked copy by Forrest	These were not introduced in evidence but were evidently meant to be as were the rest of the set	4790
2486	I	Marked copy by Forrest		4792
2486	J	Marked copy by Forrest		4796
2486	K	Marked copy by Forrest		4797
2487		Supplement to Ex. E to K. Sheets 1 to 6, being data of Chambers, completed by Forrest		4801-6

Page introduced	No.	Name	Recorded
2539	(2988)	O'Neill's Book of Advertising, photographic copy	4740
2584		Plaintiff's tabulations (Kirschbraum) from Pass Book No. 1,250 Road	2593
2584		Plaintiff's (Kirschbraum's) tabulations from Pass Book Road Asphalt 250-251 compound	2594
2711	E	Profit on Road Asphalt made in Fire Stills	4730
2713	A	And Schedules 1 to 21	4689 4691 4692 4731
2713	B		
2713	C		
2714	F		
2736		Kirschbraum's tabulation from Book 2, Sheets 1 to 4	2764
2737		Kirschbraum's tabulation Mex Flux	2768
2738		Kirschbraum's tabulation, 44A flux	2767
3529		Blank form of asphalt contract (Barber Co. and customer)	4741
4352	13A	Chambers Rebuttal Schedule	4869
4365	22	Chambers Rebuttal Schedule	4870
4369	24	Chambers Rebuttal Schedule	4871
4458	13B	Chambers Rebuttal Schedule	4869
		Total	34

[fol. 5123] Appellee's Exhibits Introduced Re Accounting and Not Brought Up

Page introduced	No.	Name
1708-9-10		Barber Forms, A to FFFFF (124 forms)
1735		Darrow letter March 20, 1917, TRP
1750		Fowler letter Apr. 5, 1917, TRP
1748		Bettlin's notes T. R. P.
1780	M	Sheets 1 to 6, Blown products at Maurer
1781	N	Sheets 1 to 14, Trial balances
1921	N	Sheets 1 and 2 (Powers) Miscellaneous asphalt and compounds
1926	O	Specifications as to mastic
1927	P	Specifications as to Barber special Trinidad asphalt roof
1927	Q	Specification Vulcanite Asphalt Mastic
1927	R	Book (Powers) of articles sold (Sales book)
2000	R	Sketch by Robinson as to fire at Madison
2300 1 Jan. 16, 1918		Formula book—Old book
2300 2 Jan. 16, 1918		Formula book—1907-1912
2300 3 Jan. 16, 1918		Formula book—1912-1915
2300 4 Jan. 16, 1918		Formula book—1915-1918
2300 5 Jan. 16, 1918		Formula book—Inactives from Ex. 4
2316		Book No. 1, Jan. 18, 1918, Formula book, old
2318		Book No. 1A, Jan. 18, 1918, Still earlier Formula Book
2318		Old laboratory index book from Maurer
2350		Daily Record of Materials used
2404		Pass Books of Hinkle (for identification) Still books 101-107-141-235-27A20
2422-2450		Laboratory Daily Reports
2482-2000 III		Balances of Barber Co. for identification
2529		Still books 1 to 11—Steam stills
2529		Still books 12 to 16—Fire stills
2539		4 Pamphlets showing advertising
2552		Blue prints of Maurer plant.

[fol. 5124]

Page introduced	No.	Name
2573		Plaintiff's tabulation still runs and penetrations (Chambers).
2594		Copy Pass Book 1 250 Road compound Feb 1914
2594		Copy Pass Book Road Asphalt 250 251 compound
2605		8 Books Barber Annual Reports to Stockholders covering years ending April 30, 1910 to 1917, inclusive.
2607		Form of Still Record of Oct. 1, 1916, found by Darrow.
2680 (2482)	III	Estimate of Earnings of Barber Co.
2701, 2739		Unnis Exhibit Tabulation Still Runs and Penetrations original.
2707	D	Maurer Plant Profits, Feb. 1, to Oct. 24, 1916.
2772		Kirschbraun's Notes on Charges and Penetrations.
2800		Letter—Chambers to Paul
2801		Letter—Paul to Chambers.
2801		Letter—Warren to Paul, forwarded to Chambers.
2806		Warren letter, Aug. 29, 1917.
2807		Letter—Chambers to Warren, Aug. 29, 1917.
3510		Detroit Contract re sale of Bermudez Asphalt
3898		Book of production records 1911
4019		Forrest set No. 2 list of formulæ
4023		Forrest note book
4110		Seven specifications of New York State Roads.
4501	IV	Blue print of Maurer plant, already marked and probably the same one as at p. 2582.
		Total 48

[fol. 5125] Appellants' Exhibits Introduced Re Accounting and Brought Up

Page introduced	No.	Name	Recorded
1581	A	Dietlin's Accounting Schedule	1584
1581	B	Dietlin's Accounting Schedule	1587
1581	C	Dietlin's Accounting Schedule	1594
2717	E to H	These were originally introduced by Mr Belknap at page 2340 but Mr Paul offers them at this point. Substituted copies are used	4778
2982		Chamber's cross-examination No. 1	4758
3067		List of Genesee products sold from Maurer (about 100)	9830
3068		List of Genesee products sold from Madison	9834
3070		List of larger Chicago Gilsonite sales	4808
3081		Allison's Calculations Bermudez Road Asphalt	3960
4017	S	Dietlin's Account	4809
4017	T	Dietlin's Account	4851
4017 Supp.	S	Dietlin's Account	4859
4019	U	Dietlin's Account	4865
4458		Dietlin's computation of percentage of Genesee reading containing Trinidad	4872
		Total 14	

[fol. 5126] Appellants' Exhibits Introduced Re Accounting and Not Brought Up

Page introduced	No.	Name	
3082		Genasco Trade Mark Registration.	
3083		Sheet of Genasco one ply roofing.	
3088		List of Genasco products sold from Madison.	
3078, 3087		Genasco labels, etc.	
3070	(a)	Pamphlet roof specifications.	
3070	(b)	Label-redmargin Genasco Roofing Coating.	
3070	(c)	Buff label, Genasco Stone surface ready roofing.	
3071	(d)	Light blue label, Genasco Model Ready Roofing.	
3071	(e)	Genasco White Stone roofing, red label.	
3073	(f)	Light green label, Genasco Positive Seal fabric.	
3075	(g)	Genasco Positive Seal felt.	
3076	(h)	Brown cover, Genasco Insulite.	
3077	(i)	Light green large label, Genasco perfected gravel roofing.	
3077	(j)	Genasco sanded ready roofing A (label).	
3077	(k)	Genasco sanded ready roofing B (label).	
3078	(l)	White label, black margin, Trinidad Lake Asphalt Roofing Felt. The exhibit evidently contains more than these.	
3144		Genasco Roofing, private brand labels (12).	
	(a)	Kant Leak Kleet	Powers.
	(b)	Trinidad Lake Asphalt	
3148	(c)	Cupex, Extra Superior Roofing, Un. Hardware Co.	O'Neill
	(d)	Flintoid Roofing, Devin & Wing Co.	
	(e)	Atco Roofing, Atl. Hardware Co.	
	(f)	Quality Roofing, Carpenter-Newton Co.	
	(g)	Crusader Roofing, Belknap Co.	
	(h)	Jaccuite, J. A. Crutchfield Co.	
	(i)	Quapaw, Chas. F. Abeles & Co.	
	(j)	Pine Tree, Talbot, Brooks and Eyre.	
	(k)	Paragon, Paragon Plaster Co.	
	(l)	Wilsons, W. A. Wilson & Sons.	

[fol. 5127]

3486		Blue print, Balfour map, 1913 plan Maurer factory.
3486-6		Balfour photograph of steam still.
3760		Refinery sheets of still reports.
3730		Nutt's blue print of steam stills.
3730 (3548)		Nutt's calculations as to capacity of steam stills.
3904 (4164)		Miller's printed matter—2 pamphlets, 2 specifications on Bermudez Road Asphalt.
3920		Allison Saturation Calculation.
3963		Allison Calculation Road Asphalt 1914.
3969		Allison Calculation Block A C.
3969		Allison Calculation Road Asphalt 1913.
4015		Forrest No. 1 (Formula Book). (Identified only, but to be produced before any tribunal.) (A few formulæ are printed at 4752 to 4763 and 4767 to 4771.)
4015		Forrest No. 2 (Formula Book). (Identified only, but to be produced before any tribunal.) (A few formulæ are printed at 4752 to 4763 and 4767 to 4771.)
4015		Forrest No. 3 (Formula Book).

Page in typewrit	No.	Name
		(Identified only but to be produced before any tribunal.) (A few formulæ are printed at 4752 to 4763 and 4767 to 4771.)
4086		Blue Print, N. Y. State Tests Asphalt, 1909
4102		New York State Tests, 1910-1914—five sheets
4124		New Jersey 1915 Tests of Barber Bermudez A C., 2 sheets.
4125		New Jersey 1915 Tests of Barber Bermudez A C 3rd sheet.
4145		Roll of sheets of tabulations of Forrest, showing materials entering into tests upon Block A. C. from 1909 to 1911, 1916.
4171		Bundle of Forrest Certificates of Analysis of Bermudez. One copied into records at 4172.
[folio 5128-5131]		
4173		Several yellow sheets—analysis of flux oil.
4186		Several sheets of tabulations.
4197		Forrest diagram 1, as to how saturations soaked into felt.
4199		Forrest diagram 2, enlargement of cross section, smooth surface roofing.
4229		Bettin Computation of Blown Products in Ex C. (Ident.)
4251		Statement of Sewall re Choctaw Lease.
4324		Figures resulting from Chamlers' Cross-examination, at Chicago, December 9, 1919.
4530		1 column of figures added to Bettin's Schedule H, Sheet 2.
4558		Choctaw lease, certified copy.

Total 33

[folio 5132 & 5133] IN UNITED STATES CIRCUIT COURT OF APPEALS

[Title omitted]

ORDER DENYING REHEARING AND DENYING MOTION TO STAY MANDATE AND VACATE AFFIRMANCE—January 24, 1927

It is ordered by the court that the petition for rehearing in this cause be and the same is hereby denied.

It is further ordered that the motion that the mandate in this cause be stayed, and the order of affirmance vacated, and an order made permitting the District Court for the Southern District of Illinois to now entertain procedure in accordance with Equity Rule 75b to bring about a statement of evidence in this cause in simple and narrative form; and that upon this court being advised that this has been done a writ of certiorari do issue to cause such simple and condensed statement to be certified to this court as a part of

the record on appeal to the end that the appeal may then be determined in accordance with the merits of the controversy, be and the same is hereby denied.

[fol. 5134] In United States Circuit Court of Appeals

[Title omitted]

Motion for Stay of Mandate.—Filed January 25, 1927

Now comes the appellant, the Barber Asphalt Paving Company, by its counsel and respectfully represents:

That it is prepared to perfect the records in this case, and to file its petition for writ of certiorari in the Supreme Court of the United States within the time allowed by law for said petition:

Wherefore the Appellant moves that the issuance of the mandate in this cause be stayed pending the filing of the aforesaid petition for a writ of certiorari in the Supreme Court of the United States until the 19th day of March, 1927, and that if said petition shall be filed in the Supreme Court of the United States on or before that day, the mandate be further held until the Supreme Court of the United States shall act upon the said petition for the writ of certiorari aforesaid.

The Barber Asphalt Paving Company, by Samuel E. Hibben, Counsel for Appellant.

Chicago, Illinois, January 24, 1927.

[File endorsement omitted.]

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fol. 5135 In United States Circuit Court of Appeals

[Title omitted]

Order Staying Mandate.—January 25, 1927

On motion of counsel for appellant, it is ordered by the court that the mandate in this cause be, and the same is hereby stayed until the further order of this court.

[fol. 5136] In United States Circuit Court of Appeals

[Title omitted]

Notice of Motion for Order to Transmit Certain Exhibits —Filed February 23, 1927

To: Messrs. Judah, Willard, Wolf & Reichmann, Attorneys for Appellee, 134 South La Salle Street, Chicago, Illinois.

You are hereby notified that on Thursday, September 9, 1926, at ten o'clock A. M., we shall appear before the United States Circuit Court of Appeals, in the Chambers of his Honor, Judge Alschuler, in the Federal Building, and present a motion for an order directing the Clerk of the District Court for the Southern District of Illinois, Southern Division, to transmit to this Court certain exhibits introduced in evidence in this cause and specified in the motion paper, copy of which is attached hereto and herewith served upon you; at which time and place you may be present if you see fit.

Rector, Hibben, Davis & Macauley, Attorneys for Appellant.

Chicago, Illinois, September 8, 1926.

Receipt of copy of this notice and the motion paper referred to therein acknowledged September 8, 1926.

Judah, Willard, Wolf & Reichmann.

[fol. 5137] In United States Circuit Court of Appeals

[Title omitted]

Motion for Order to Transmit Certain Exhibits—Filed February 23, 1927

Now comes the appellant and moves the Court that an order be entered in this cause directing the Clerk of the District Court for the Southern District of Illinois, Southern Division, to transmit to this Court for the purpose of use at the argument on appeal, the following exhibits now on file:

Defendant's Exhibit 6.
Defendant's Exhibit 7.
Defendant's Exhibit 8.
Defendant's Exhibit 9.
Foote Samples (Two; boxes; Byerlite 18 and 22).
Defendant's Exhibit Progressive Samples of Cleveland Product from 28 Gravity Tar.
Uncertified printed copy of record of Byerly v. Sun Company; also of
Byerly v. Barber Asphalt Company; and also of
Standard Asphalt & Rubber Company v. American Asphaltum & Rubber Company.

Rector, Hibben, Davis & Macauley, Solicitors for Appellant.

[fol. 5138] In United States Circuit Court of Appeals

[Title omitted]

Order to Transmit Certain Exhibits—Filed February 23, 1927

It is hereby Ordered and directed that the Clerk of the District Court for the Southern District of Illinois, Southern Division, shall transmit to this Court the following exhibits introduced in evidence in the above-entitled cause, to-wit:

Defendant's Exhibit 6.
Defendant's Exhibit 7.
Defendant's Exhibit 8.
Defendant's Exhibit 9.
Foote Samples (Two; boxes; Byerlite 18 and 22).
Defendant's Exhibit Progressive Samples of Cleveland Product from 28 Gravity Tar.
Uncertified printed copy of record of Byerly v. Sun Company; also of
Byerly v. Barber Asphalt Company; and also of
Standard Asphalt & Rubber Company v. American Asphaltum & Rubber Company.

Saml. Alschuler, Judge.

[File endorsement omitted.]

[fol. 5139] Clerk's certificate to foregoing transcript omitted in printing.

[fol. 5140] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed April 18, 1927

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

April 18, 1927.

[fol. 5141] IN SUPREME COURT OF THE UNITED STATES

MOTION FOR ORDER AS TO PRINTING RECORD—Filed May 13, 1927

And Now, this 16th day of May, 1927, comes the Petitioner, Barber Asphalt Paving Company, and respectfully shows:

1. That by order made April 25, 1927, this Court, in advancing and assigning this case for argument, directed that no other question be heard than the action of the Court below in dismissing the Appeal because the Transcript of Record did not comply with Equity Rule 75; and that Counsel should govern themselves accordingly in respect to printing in this Court. Your Petitioner interprets this as meaning that this Court expects a Record to be printed containing only those parts of the entire Record necessary for the consideration of the single question to be argued.

2. Your Petitioner, on May 2, 1927, submitted to Counsel for Respondent, a designation (repeated below) of the parts of the Record which it considers necessary for the [fol. 5142] above purpose and requested Counsel for Respondent either to approve such designation or to designate such further parts as Respondent may consider necessary for the above purpose; but such approval or further designation has not been received.

3. Your Petitioner does not find anything in the Rules of this Honorable Court applying specifically to the situation thus presented.

4. Thirty (30) printed copies of the entire Record of the case, which is in ten volumes, have already been filed in this Court in connection with the Petition for a Writ of Certiorari which this Court has granted, but nearly all of this large Record is unnecessary to be considered in connection with the question which this Court has designated as the only one to be argued.

5. Your Petitioner believes that for the purpose of argument it will only be necessary for the Clerk to print and present to the Court the following portions of the Record:

	Printed record pages
1. Interlocutory Decree	1217 to 19
2. Final Decree	4676 to 77
3. Order Allowing Appeal	4684
4. Praecipe for Record	4873 to 75
5. Certificate of Clerk	4876
6. Order of Jan. 29, 1926, Remitting Transcript	4985 to 86
7. Order of Mar. 30, 1926	4913 to 15
8. Certificate of Clerk	4959
9. Entry of April 10, 1926	4987 (Top)
10. Entry of October 6, 1926	4991
11. Opinion	4992 to 98
12. Judgment	4999
[fol. 5143] 13. Petition for Rehearing, and Motion for Condensation including Entry of Dec. 31, 1926	4999-5045
14. Motion and Order of Jan. 4, 1927	5048
15. Order of Jan. 24, 1927, denying Petition and Motion	5132
16. Motion to Stay Mandate	5134
17. Order Staying Mandate	5135

Your Petitioner therefore moves this Honorable Court for an Order directing the Clerk to print only the parts thus above designated by your Petitioner and such further parts as the Respondent, within twenty (20) days, may designate in writing filed with the Clerk of this Court.

Respectfully submitted,

Henry N. Paul, Attorney for the Petitioner.

On behalf of Respondent, I hereby acknowledge receipt of a copy of the above Motion with notice that Petitioner expects to present the same at the opening of the Court on Monday, May 16th, or as soon thereafter as Counsel may be heard.

William F. Hall, Attorney for Respondent.

[fols. 5144 & 5145] [File endorsement omitted.]

[fol. 5146] In Supreme Court of the United States

Answer and Counter-Designation of Parts of Record to be Printed—Filed May 16, 1927

Without waiving any right it may have to urge before this court, and the Circuit Court of Appeals for the Seventh Circuit, that the appeal to the latter court was never perfected so as to give that court, or to this court, jurisdiction to review the final decree of the United States District Court for the Southern District of Illinois, Standard Asphalt and Rubber Company, the above named respondent, in answer to the motion of Barber Asphalt Paving Company, the above named petitioner, noticed for presentation on Monday, May 16, 1927, respectfully shows that respondent believes it will be necessary for the clerk to print and present to this court, in addition to the portions of the record designated in paragraph 5 of the aforesaid motion, other portions thereof as follows:

	Printed record pages
[fol. 5147] 1. Bill of Complaint	1 to 6 inclusive
2. Answer of Defendant	8 to 14 inclusive
3. Amendment to Defendant's Answer	15
4. Opinion of Judge Humphrey on the Issues of Validity, Infringement and Title	1216 to 1217 inclusive
5. Opinion of the District Court (Judge FitzHenry) confirming the Master's Report	4655 to 4676 inclusive
6. Sundry orders on motion of defendant extending time to file transcript	4877 to 4883 inclusive

	Printed record pages
7. Citation	4884
8. Clerk's Certificate	4961
9. Motion of Appellant to have separate hearings in the Court of Appeals on the Issues of Title, Validity and Infringement on on the one hand, and the Accounting Issues on the other	4965
10. Appellee's notice and motion to strike	4966 to 4968 inclusive
11. Appellee's objections to Appellant's motion	4969 to 4971 inclusive
12. Order reserving judgment on Appellee's motion	4972
13. Appellant's motion for order remitting transcript of record to District Court	4978 to 4981 inclusive
14. All of pages	4981 to 4984 inclusive
and also first paragraph of page	4985 which
ends with the figures "4885 to 4907"	
15. Entries of October 5 and 6, 1926	4988
16. Appellee's Suggestions for dismissal of appeal	4989 to 4991 inclusive
17. Two entries of October 6, 1926	4991
18. Entry of December 13, 1926	4991
19. Entries of January 12 and 18, 1927	5050
20. Appellee's Answer to Petition for Rehearing	5051 to 5128 inclusive
21. Entry of February 23, 1927	5135
22. All of pages	5136 to 5139 inclusive

[fol. 5148] Respondent therefore prays that this Honorable Court may direct the clerk to print, in addition to the portions of the record set forth in said motion, the portions thereof above enumerated.

Respectfully submitted.

A. F. Reichmann, Thomas G. Haight, F. L. Belknap, Counsel for Respondent. William F. Hall, Of Counsel for Respondent.

On behalf of petitioner, I hereby acknowledge receipt of a copy of the above answer to motion, with notice that the respondent expects to present the same at the opening of the court on Monday, May 16, 1927, or as soon thereafter as it can be heard.

—— ——, Counsel for Petitioner.

[fol. 5149] In the Supreme Court of the United States

Washington,
District of Columbia, ss:

I, William F. Hall, being duly sworn, depose and say that I am of counsel for the respondent in the above entitled case; that on the fourteenth day of May, 1927, I sent by registered mail to Henry N. Paul, 1815 Land Title Building, Philadelphia, Pennsylvania, and Charles L. Sturtevant, Washington Loan and Trust Building, Washington, D. C., who acted as Mr. Paul's associate in the service of the Motion filed in the above entitled case, copies of respondent's Answer to petitioner's Motion, copy of which answer is attached hereto.

Furthermore affiant sayeth not.

William F. Hall.

Signed and sworn to before me this fourteenth day of May, 1927.

[seal.] Ewd. L. Tolson, Notary Public.

[fol. 5150] [File endorsement omitted.]

[fol. 5151] Supreme Court of the United States

Order Granting Motions for Designated Record

Upon consideration of the motions of counsel designating portions of the record to be printed in this cause,

It is now here ordered by this Court that the said motions be, and they are hereby, granted, and the Clerk is directed to print the record in this case in accordance with the said designations.

Per Mr. Chief Justice Taft.

May 31, 1927.